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DECISIONS
OF THE
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IN
PATENT AND TRADE-MARK AND
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**COMPILED FROM VOLS. 270-281, INCLUSIVE, OF THE OFFICIAL
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A.

	Page.
Abercrombie v. Ringel v. Angier v. Taylor and Hepp-----	80, 82
^d Acme Motion Picture Projector Co. De Vry Corporation v-----	440
^d Eolian Co. v. Schubert Piano Co-----	304
* American Feed Milling Co. v. M. C. Peters Mill Co-----	113
Angier v. Taylor and Hepp. Abercrombie v. Ringel v-----	80, 81
Anglada. Moyer v-----	86
Antoine and Travis v. Grover and Barber-----	18
* Antoine and Travis. Grover and Barber v-----	180
* Area Manufacturing Co. The R. M. Hollingshead Co. v-----	154
* Armsby Co., The J. K. L. Otzen & Co. v-----	118

B.

* Backdahl. Gammeter v-----	209
^d Backstay Machine & Leather Co. v. Hamilton-----	397
* Bader v. Burroughs-----	114
Barber. Ex parte-----	23
^b Barber v. Otis Motor Sales Co-----	106
** Beckwith v. Commissioner of Patents-----	471
* Belch Company, Paul F., v. Kellogg Toasted Corn Flakes Company-----	119
** Beldler v. The United States-----	483
^d Bellows and Slack v. New York Central Railroad Company-----	356
^d Bellows and Slack v. Pressed Steel Car Company-----	362
Berghoff Brewing Ass'n. Popel-Giller Co., Inc., v-----	84
** Berlin Mills Company v. Procter & Gamble Company-----	496
Bethke v. Scannell-----	11
* Bethke. Scannell v-----	150
^d Bisight Co. et al. v. Onepiece Bifocal Lens Co-----	257
* Blaine v. White-----	222
^d Blakeslee & Co., G. S. Imperial Machine Foundry Corporation v-----	368
* Bobblitt. Wegner v-----	164
** Bone v. Commissioners of Marion County-----	457
^d Borgfeldt & Co., Geo., et al. v. Weiss-----	389
* Bower. Day v-----	174
* Braun v. Wiegand-----	141
* Brown v. McIntosh-----	190
* Brown v. Tomlinson-----	178
* Bruckman v. Miller-----	224
^d Bucher & Gibbs Plow Co. Ohio Rake Co. v-----	451

	Page.
* Burroughs. Bader v.....	114
* Bushnell Company, Alvah, In re.....	112

C.

♠ Cammeyer, Inc. Nathan Anklet Support Co., Inc., et al. v.....	427
Caps v. Kennicott.....	6
* Caps. Kennicott v.....	120
** Chain Belt Company and Whitney. New York Scaffolding Company v.....	492
* Chapman and Chapman v. Wintroath.....	465
* Christo Manufacturing Company v. The Christian Moerlein Brewing Company.....	189
Clark. Shenk and Holman v.....	16
* Clark. Shank and Holman v.....	178
Collins v. Owens.....	76
Comey. Ex parte.....	65
** Commissioner of Patents. Beckwith v.....	471
** Commissioners of Marion County. Bone v.....	457
♠ Concrete Appliances Co. et al. v. Meinken et al.....	378
* Conner. Marie E. Scheuerle, Administratrix, v.....	123
♠ Consolidated Window Glass Co. v. Window Glass Mach. Co. et al.....	313
† Construction of Act March 3, 1883.....	92
* Construction of Act of March 19, 1920.....	89
* Cowles v. Rody.....	117
* Cox v. Headley and Thompson.....	183

D.

♠ D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.....	246
* Day v. Bower.....	174
♠ Day Co., J. H., v. Mountain City Mill Co. et al.....	421
♠ Deeds Commercial Laboratories. Rodman Chemical Co. v.....	292
* DeForest v. Richards.....	175
♠ De Vry Corporation v. Acme Motion Picture Projector Co.....	440
* Dement. In re.....	170
♠ Dennis Co., Martin. Rohm et al. v.....	349
* Dickinson v. Swinehart.....	151
* Dorset. Reichel v.....	128
* Doyle and Hedley v. Tomlinson.....	179
Du Rell. Haley v.....	53
* Du Rell v. Haley.....	208
Duncan. Ex parte.....	36
* Duncan. In re.....	197
* Duncan v. Shelly.....	155
♠ Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.....	259

E.

♠ Elmer et al. Kohn v.....	431
♠ Electric Welding Co. Vandenburg v.....	353
* Eney Shortening Company. The Proctor and Gamble Company v.....	239
* Engle v. Manchester and Spooner.....	130
* Erben v. Yardley.....	220

Eynon. Grus, Jr., v.....	Page. 49
* Eynon. Grus, Jr., v.....	213

F.

*Fetzer & Spies Leather Co. v. I. T. S. Rubber Co.....	274
Foss. Ex parte.....	61
* French Battery & Carbon Company v. The Prest-O-Lite Company, Inc....	214

G.

* Gammeter v. Backdahl.....	209
* Gile. Hartsough v.....	187
Grover and Barber. Antoine and Travis v.....	18
* Grover and Barber v. Antoine and Travis.....	180
Grus, jr., v. Eynon.....	49
* Grus, jr., v. Eynon.....	213

H.

Haley v. Du Rell.....	53
* Haley. Du Rell v.....	208
Hall. Ex parte.....	56
* Hamilton. Backstay Machine & Leather Co. v.....	397
* Hartsough v. Gile.....	187
* Headley and Thompson. Cox v.....	183
* Hempy. Jennison-Wright Co. v.....	444
* Hercules Powder Company v. Newton, Commissioner of Patents.....	340
* Higgin Mfg. Co. v. Watson et al.....	403
* Hildreth. Mastoras v.....	414
* Hoenig v. Parker.....	234
* Hoenig v. Kendig.....	241
* Hollingshead Co., The R. M., v. Area Manufacturing Co.....	154
* Honigmann. Wells and Hunter v.....	242
* Hope and Lambert. Lambert v.....	237
* Hopkins v. Riegger.....	126
* Hudnut and Mack. Phillips v.....	164
* Hughes Tool Co. Reed v.....	238
Humphrys. Ex parte.....	70

I.

* I. T. S. Rubber Co. Fetzer & Spies Leather Co. v.....	274
* I. T. S. Rubber Co. v. Panther Rubber Mfg. Co.....	233
* Illinois Brass Mfg. Co. Walker Mfg. Co. et al. v.....	442
* Imperial Machine & Foundry Corporation v. G. S. Blakeslee & Co.....	363

J.

* Jay et al. v. Weinberg et al.....	402
* Jennison-Wright Co. v. Hempy.....	444

K.

* Kellogg Toasted Corn Flakes Company. Paul F. Belch Company v.....	119
* Kendig. Hoenig v.....	241

	Page.
Kennicott. Caps <i>v</i>	6
* Kennicott <i>v</i> . Caps.....	120
* Kimball Co., A., <i>v</i> . Noesting-Pin Ticket Co.....	394
Kitselman <i>v</i> . Reid, Reid, and Kelley.....	26
Kitselman. Reid, Reid, and Kelley <i>v</i>	28
* Kitselman <i>v</i> . Reid, Reid, and Kelley.....	191, 192
* Knight Soda Fountain Co. <i>v</i> . Walrus Mfg. Co.....	254
* Kohn <i>v</i> . Elmer et al.....	431
Kuhn and Shailor. <i>Ex parte</i>	58
* Kuhn & Sons (Inc.), H., <i>v</i> . Letts.....	232

L.

Lacey. <i>Ex parte</i>	83
* Lambert <i>v</i> . Hope and Lambert.....	237
* Lee and Hogan, Jr., <i>v</i> . Vreeland.....	145
* Letts. Kuhn & Sons (Inc.) <i>v</i>	232
** Liebel-Binney Construction Company. New York Scaffolding Company <i>v</i>	437
* Lower. <i>In re</i>	149

M.

* MacIin-Zimmer-McGill Tobacco Company, Incorporated. <i>In re</i>	133
* Macy & Company, R. H. <i>v</i> . New York Grocery Company.....	201
* Manchester and Spooner. Engle <i>v</i>	180
Maremont <i>v</i> . Olson.....	44
* Maremont <i>v</i> . Olson.....	200
* Marshall Field & Co. Minneapolis Knitting Works <i>v</i>	360
* Marshall Ventilated Mattress Co. D'Arcy Spring Co. et al <i>v</i>	246
* Mastoras <i>v</i> . Hildreth.....	414
* Mattullath Aeroplane Company <i>v</i> . Newton, Commissioner of Patents.....	97
* Mayo Radiator Co. Whitlock Coil Pipe Co. <i>v</i>	447
* McIntosh. Brown <i>v</i>	199
** Meccano Limited <i>v</i> . John Wanamaker, New York.....	478
* Meinken et al. Concrete Appliances Co. et al <i>v</i>	378
* Miller. Bruckman <i>v</i>	224
* Minneapolis Knitting Works <i>v</i> . Marshall Field & Co.....	360
* Moerlein Brewing Company, Christian, The. Christo Manufacturing Company <i>v</i>	189
* Molyneux. Seymour <i>v</i>	133, 137
Moolten. <i>Ex parte</i>	63
Moore and Pack. <i>Ex parte</i>	21, 69
* Moore and Pack. <i>In re</i>	182
* Moorhead Knitting Co. Paramount Hosiery Form Drying Co. <i>v</i>	268
* Mountain City Mill Co. J. H. Day Co. <i>v</i>	421
Moyer <i>v</i> . Anglada.....	86

N.

Nash <i>v</i> . Reeder <i>v</i> . Ryan.....	72
* Nathan Anklet Support Co., Inc., et al <i>v</i> . Cammeyer, Inc.....	427
* Newton, Commissioner of Patents. Hercules Powder Company <i>v</i>	340
* Newton, Commissioner of Patents. Mattullath Aeroplane Company <i>v</i>	97
* New York Central Railroad Company, The. Bellows and Slack <i>v</i>	356

	Page.
* New York Grocery Company. R. H. Macy Company v.....	201
** New York Scaffolding Company v. Chain Belt Company and Whitney....	492
** New York Scaffolding Company v. Liebel-Binney Construction Com- pany	487
¶ Noesting Pin Ticket Co. A. Kimball Co., v.....	394

O.

¶ Ohio Rake Co. v. Bucher & Gibbs Plow Co.....	451
Olson. Maremont v.....	44
* Olson Maremont v.....	200
¶ Onepiece Bifocal Lens Co. Bisight Co. et al. v.....	257
† Opinion of the Attorney General.....	92
* Opinion of the Solicitor of the Department of the Interior.....	89
¶ Otis Motor Sales Co. Barber v.....	106
* Otzen & Co., L., v. The J. K. Armsby Co.....	118
Owens. Collins v.....	76

P.

¶ Panther Rubber Mfg. Co. I. T. S. Rubber Co. v.....	283
¶ Paramount Hosiery Form Drying Co. v. Moorhead Knitting Co.....	268
* Parker. Hoenig v.....	234
¶ Peck, Stow & Wilcox Co. H. D. Smith & Co. v.....	373
* Pembroke v. Sulzer.....	218
* Peters Mill Co., M. C. American Feed Milling Co. v.....	113
* Phillips v. Hudnut and Mack.....	164
* Play-O-Lite Company, Inc., The. Prest-O-Lite Company Inc. v.....	231
Popel-Giller Co., Inc., v. Berghoff Brewing Ass'n.....	84
¶ Pressed Steel Car Company. Bellows and Slack v.....	362
* Prest-O-Lite Company, Inc., The. French Battery & Carbon Company v.....	214
* Prest-O-Lite Company, Inc., The, v. Play-O-Lite Company, Inc.....	231
* Procter and Gamble Company, The, v. Eney Shortening Company.....	239
** Procter & Gamble Company. Berlin Mills Company v.....	496

R.

¶ Reed v. Hughes Tool Co.....	288
Reeder v. Ryan. Nash v.....	72
¶ Reform Initial Company Inc., and Gottschalk and Brasch. G. Reis, Inc., v.....	351
* Reichel v. Dorset.....	128
Reid, Reid, and Kelley. Kitselman v.....	26
Reid, Reid, and Kelley v. Kitselman.....	28
* Reid, Reid, and Kelley v. Kitselman.....	181. 192
¶ Reis & Bro., G., Inc., v. Reform Initial Company, Inc., and Gottschalk and Brasch	351
* Richards. DeForest v.....	175
* Riegger. Hopkins v.....	126
Ringel v. Angier v. Taylor and Hepp. Abercrombie v.....	80, 81
* Roberts. In re.....	158
¶ Rodman Chemical Co. v. Deeds Commercial Laboratories.....	292
* Rody. Cowles v.....	117

	Page.
^d Rohm et al. v. Martin Dennis Co.....	349
Ryan. Nash v. Reeder v.....	72

S.

Scannell. Bethke v.....	11
* Scannell v. Bethke.....	150
* Schafer & Company, Geo. H. William Waltke & Company v.....	167
* Scheuerle, Marie E., Administratrix, v. Conner.....	123
Schneider. Ex parte.....	9, 25
* Schneider. In re.....	121
* Scholl Manufacturing Company, Inc. In re.....	206
^d Schubert Plano Co. Æolian Co. v.....	304
^d Seattle-Astoria Iron Works et al. Smith Cannery Machines Co. v.....	296
* Seymour v. Molyneux.....	133, 137
* Shelly. Duncan v.....	155
Shenk and Holman v. Clark.....	16
* Shenk and Holman v. Clark.....	178
Simon. Ex parte.....	59
Smith. Ex parte.....	1, 5
* Smith. In re.....	125, 140
^d Smith & Co., H. D., v. Peck, Stow & Wilcox Co.....	373
^d Smith Cannery Machines Co. v. Seattle-Astoria Iron Works et al.....	296
Smith Wheel, Inc. Ex parte.....	1
* Smithey. In re.....	198
* Sorum. In re.....	193
Stadeker. Ex parte.....	34
* Stadeker. In re.....	190
* Stephens-Adamson Manufacturing Company. In re.....	147
* Sulzer. Pembroke v.....	218
* Swinehart. Dickinson v.....	151

T.

Taylor and Hepp. Abercrombie v. Ringel v. Angler v.....	80, 81
Teale. Ex parte.....	45
* Tomlinson. Brown v.....	178
* Tomlinson. Doyle and Hedley v.....	179
^d Toronto Fire Clay Co. et al. Dunn Wire-Cut Lug Brick Co. v.....	259

U.

** United States, The. Beldler v.....	488
* United States Rubber Company. In re.....	199
^d United States Slicing Mach. Co. Wolf, Sayer & Heller, Inc., v.....	301

V.

^d Vandeburgh v. Electric Welding Co.....	853
^b Van Kannel Revolving Door Co. v. Winton Hotel Co.....	99
* Vreeland. Lee and Hogan, Jr., v.....	145

W.

^d Walker Mfg. Co. et al. v. Illinois Brass Mfg. Co.....	442
^d Walrus Mfg. Co. Knight Soda Fountain Co. v.....	254

	Page.
* Waltke & Company, William, v. Geo. H. Schafer & Company-----	167
** Wanamaker, New York, John. Meccano Limited v-----	478
* Watson et al. Higgin Mfg. Co., et al. v-----	403
* Wegner v. Bobblitt-----	164
* Weinberg et al. Jay et al. v-----	402
* Weiss. Geo. Borgfeldt & Co. et al. v-----	389
* Wells and Hunter v. Honigmann-----	242
* White. Blaine v-----	222
* Whitlock Coil Pipe Co. v. Mayo Radiator Co-----	447
* Wiegand. Braun v-----	141
Wigginton. Ex parte-----	67
* Window Glass Mach. Co. et al. Consolidated Window Glass Co. v-----	313
* Winton Hotel Co. Van Kannel Revolving Door Co. v-----	99
** Wintroath. Chapman and Chapman v-----	485
* Wolf, Sayer & Heller, Inc., v. United States Slicing Mach. Co-----	301
Wright. Ex parte-----	14

Y.

* Yardley. Erben v-----	220
-------------------------	-----

Z.

* Zenk. In re-----	215
--------------------	-----

CASES CITED.

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	Page.
A.	
** <i>Abercrombie et al. v. Baldwin et al.</i> , 245 U. S., 198.....	11
♠ <i>Acme Co. v. Commercial Co.</i> , 192 Fed. Rep., 321.....	263
* <i>Adams v. Murphy</i> , 18 App. D. C., 172.....	189
♠ <i>Ajax Metal Co. v. Brady Brass Co.</i> , 155 Fed. Rep., 409.....	377
* <i>Alaska Packers' Association v. Admiralty Trading Co.</i> , 43 App. D. C., 198.....	215
♠ <i>Albers Bros. Milling Co. v. Acme Mills Co.</i> , 171 Fed. Rep., 989.....	148
♠ <i>Alexander v. De Moulin Bros. & Co.</i> , 199 Fed. Rep., 145.....	442
♠ <i>Allis v. Buckstaff</i> , 13 Fed. Rep., 879.....	55
♠ <i>Aluminum Cooking Utensil Co. v. National Aluminum Works</i> , 226 Fed. Rep., 815.....	2
♠ <i>Ambursen, etc., Co. v. Hydraulic & Co.</i> , 211 Fed. Rep., 982.....	353
♠ <i>American Automotoneer Co. v. Porter</i> , 232 Fed. Rep., 456.....	10, 282
♠ <i>American Casting Machine Co. v. Pittsburgh Co.</i> , 237 Fed. Rep., 590.....	161, 163
* <i>American Circular Loom Co. In re</i> , 28 App. D. C., 446-450.....	345
♠ <i>American Crayon Co. v. Sexton</i> , 139 Fed. Rep., 564.....	419
* <i>American Glue Co. In re</i> , 27 App. D. C., 391.....	199
♠ <i>American Roll Paper Co. v. Weston</i> , 45 Fed. Rep., 686.....	110
♠ <i>American Stove Co. v. Cleveland Foundry Co.</i> , 158 Fed. Rep., 978.....	430
♠ <i>American Washboard Co. v. Saginaw Mfg. Co.</i> , 103 Fed. Rep., 281.....	166
Ams. <i>Ex parte</i> , C. D., 1906, 424; 125 O. G., 347.....	10
* Ams. <i>In re</i> , 29 App. D. C., 91.....	10
* <i>Anderson v. Wells</i> , 27 App. D. C., 115.....	219
* <i>Anglo-American Co. v. General Electric Co.</i> , 43 App. D. C., 385.....	204
** <i>Ansonia Co. v. Electrical Co.</i> , 144 U. S., 11.....	385
<i>Antoine and Travis v. Grover and Barber</i> , C. D., 1920, 18; 274 O. G., 839.....	180
♠ <i>Appert v. Brownsville Plate Glass Co.</i> , 144 Fed. Rep., 115.....	99
* <i>Arbetter v. Lewis</i> , 34 App. D. C., 491.....	136
♠ <i>Arnold-Creager Co. v. Barkwill Co.</i> , 246 Fed. Rep., 441.....	250
♠ <i>Ashley v. Tatum</i> , 181 Fed. Rep., 840.....	392
♠ <i>Ashley v. Tatum</i> , 186 Fed. Rep., 339.....	391, 392
** <i>Ashley v. Tatum</i> , 225 U. S., 707.....	393
♠ <i>Ashley v. Weeks-Numan Co.</i> , 220 Fed. Rep., 890.....	393
** <i>Atlantic Works v. Brady</i> , 107 U. S., 192.....	359
♠ <i>Aunt Jemima Mills Co. v. Rigney</i> , 247 Fed. Rep., 407.....	203, 347
♠ <i>Autopiano Co. v. American Co.</i> , 222 Fed. Rep., 276.....	306, 313
♠ <i>Autopiano Co. v. Amphion Piano Co.</i> , 186 Fed. Rep., 159.....	306

	Page.
* Autopiano Co. v. Claviola Co., 234 Fed. Rep., 314.....	306, 313
* Avery & Sons v. J. I. Case Plow Works, 148 Fed. Rep., 214.....	256

B.

** Baglin v. Cusenier, 221 U. S., 592.....	347
* Baker v. Duncombe Mfg. Co., 146 Fed. Rep., 744.....	442
* Baker Co., Walter, v. Harrison, 32 App. D. C., 272.....	168, 202, 206
* Baltzley v. Spengler Co., 262 Fed. Rep., 423.....	446
** Barbed Wire Patents, The, 143 U. S., 275.....	377
* Barber v. Otis Motor Sales Co., 231 Fed. Rep., 755.....	107, 108
* Barber v. Otis Motor Sales Co., 240 Fed. Rep., 723.....	107, 108, 109
* Barber v. Otis Motor Sales Co., 247 Fed. Rep., 553.....	107
* Barber v. Reo Motor Car Sales Co., 245 Fed. Rep., 938.....	107
* Barnes Co., W. F. & John, v. Vandyck Churchill Co. et al., 213 Fed. Rep., 637.....	444
Barrett v. Hart, C. D., 1918, 62; 256 O. G., 224.....	57
* Barrett Co. v. Ewing, Commissioner of Patents, 242 Fed. Rep., 506.....	342
* Barry v. Harpoon, etc., Co., 209 Fed. Rep., 207.....	377, 397
** Bates v. Coe, 98 U. S., 31.....	112, 287
* Beckwith. In re, 48 App. D. C., 110.....	147, 148
** Bement v. National Harrow Co., 186 U. S., 70.....	418
* Bennett v. McKinley, 65 Fed. Rep., 505.....	346
* Benthall Machine Co. v. National Corporation, 222 Fed. Rep., 918.....	410
* Berger Co. v. Trussed Co., 257 Fed. Rep., 741.....	386
* Berlin Mills Company v. Procter & Gamble Company, 256 Fed. Rep., 23.....	496
* Bickmore Gall Cure Co. v. Karns Mfg. Co., 126 Fed. Rep., 573.....	114
* Blackford v. Wilder, 28 App. D. C., 535.....	172
* Bliss v. Merrill, 33 Fed. Rep., 39.....	110
** Bloomer v. McQuewan, 55 U. S., 539.....	94
* Boldt Co., Chas., v. Turner Bros. Co., 199 Fed. Rep., 139.....	441
* Bone v. Commissioners of Marion County, 249 Fed. Rep., 211.....	458, 461
* Bourn v. Hill, 27 App. D. C., 291.....	201
* Bowers v. San Francisco Bridge Co., 91 Fed. Rep., 381.....	418
* Bradford Dyeing Assn. In re, 46 App. D. C., 512.....	133
* Bradley Mfg. Co., David, v. Eagle Manufacturing Co., 57 Fed. Rep., 980.....	106
* Brammer Mfg. Co., H. F., v. Witte Hardware Co., 159 Fed. Rep., 726.....	300
Briggs v. Lillie v. Cooke v. Jones & Taylor, C. D., 1905, 168; 116 O. G., 871.....	212
* Bronk v. Chas. H. Scott Co., 211 Fed. Rep., 338.....	441
* Brown v. Campbell, 41 App. D. C., 499.....	158
** Brown v. Davis, 116 U. S., 237.....	266
** Brown v. District of Columbia, 130 U. S., 87.....	446
** Brown v. Piper, 91 U. S., 37.....	400
* Brown v. Reed Mfg. Co., 81 Fed. Rep., 48.....	451
* Brown v. Reed Mfg. Co., 96 Fed. Rep., 1005.....	451
* Brown v. Tomlinson, 49 App. D. C., 310.....	178
** Brown Chemical Company v. Myer, 139 U. S., 540.....	476
* Bucher & Gibbs Plow Co. v. International Harvester Co., 211 Fed. Rep., 473.....	456
* Bundy Mfg. Co. v. Detroit Time Register Co., 94 Fed. Rep., 524.....	249, 300
** Burr v. Duryee, 1 Wall., 531.....	419, 420
* Burson v. Vogel, 29 App. D. C., 388.....	221
** Busch v. Jones, 184 U. S., 598.....	268, 273
** Butterworth v. Hoe, 112 U. S., 50.....	43, 90

C.

	Page.
* Cahn, Belt & Co. In re, 27 App. D. C., 173.....	199
** Canal Company v. Clark, 13 Wall., 311.....	476
** Cantrell v. Wallick, 117 U. S., 689.....	291
* Carlin v. Goldberg, 45 App. D. C., 540.....	118
** Carnegie Steel Co. v. Cambria Iron Co., 185 U. S., 403.....	271
Carty v. Kellogg, C. D., 1895, 83; 73 O. G., 285.....	57
* Cazler v. Mackie Co., 138 Fed. Rep., 654.....	253
* Central Consumers' League. In re, 32 App. D. C., 523.....	1,347
* Century Electric Co. v. Westinghouse Electric & Mfg. Co., 191 Fed. Rep., 350.....	95, 412, 419
* Chadeloid Chemical Co. v. Frank S. DeRonde Co., 146 Fed. Rep., 988.....	418
** Chapman v. Wintroath, 252 U. S., 126.....	15, 245
** Chicago & Northwestern Railway Co. v. Sayles, 97 U. S., 554.....	430
* Cimlotti Unhairing Co. v. American Unhairing Co., 115 Fed. Rep., 498.....	371, 450
** Cimlotti Unhairing Co. v. American Unhairing Co., 198 U. S., 399.....	409
* City of Akron v. Bone, 221 Fed. Rep., 944.....	460
* City of Amarillo et al. v. Southwestern Telegraph & Telephone Co., 253 Fed. Rep., 638.....	482
** Cochran v. Deener, 94 U. S., 780.....	291
** Coffin v. Ogden, 18 Wall., 120.....	55
* Collis v. Quenzer, 38 App. D. C., 481.....	189
* Computing Scale Co. v. Sandard, etc., Co., 118 Fed. Rep., 965.....	346
* Consolidated Bunging Apparatus v. Woerle, 29 Fed. Rep., 451.....	112
** Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S., 405.....	94, 259, 291
** Corn Planter Patent, 23 Wall., 181.....	258
* Corrington v. Westinghouse, etc., Co., 178 Fed. Rep., 715.....	396
* Cosper v. Gold, 34 App. D. C., 194.....	118
* Courson v. O'Connor, 227 Fed. Rep., 890.....	152, 213
* Creveling v. Jepson, 47 App. D. C., 597.....	223
** Cromwell v. County of Sac., 94 U. S., 351.....	172
Crossfield. In re, L. R. 1910, 130.....	344
** Crouch v. Roemer, 103 U. S., 797.....	359, 444
* Crown Co. v. Sterling Co., 217 Fed. Rep., 381.....	381
* Curry v. Union Co., 230 Fed. Rep., 422.....	266
* Curtain Supply Co. v. National Lock Washer Co., 174 Fed. Rep., 45.....	157
* Cutler. In re, 48 App. D. C., 444.....	172
* Cutler v. Leonard, 31 App. D. C., 297.....	245

D.

* Dashiell v. Tasker, 21 App. D. C., 64.....	142
* Davenport. In re, 23 App. D. C., 370.....	198
* David v. Harris, 206 Fed. Rep., 902.....	397
** Davids Co. v. Davis, 233 U. S., 461.....	344
* Day Company, J. H., v. Mountain City Mill Co. et. al., 257 Fed. Rep., 561.....	422
* De Laval Co. v. Vermont F. M. Co., 135 Fed. Rep., 772.....	230
* Denning Wire & Fence Co. v. American Steel & Wire Co., 169 Fed. Rep., 793.....	94
* Dennison, etc., Co. v. Thomas, etc., Co., 94 Fed. Rep., 651.....	345
** Denver v. New York Trust Company, 229 U. S., 123.....	481
* Detroit Lubricator Mfg. Co. v. Renchard et. al., 9 Fed. Rep., 293.....	75

CASES CITED.

XIII

	Page.
^d Diamond Match Co. v. Ruby Match Co., 127 Fed. Rep., 341-----	300
** Diamond Rubber Co. v. Consolidated Rubber Co., 220 U. S., 428-----	194, 281
** Dobson v. Dornan, 118 U. S., 10-----	392
^d Dowaglac Mfg. Co. v. Minn-Moline Plow Co., 118 Fed. Rep., 136-----	310
^d Downes v. Teter-Heany, 150 Fed. Rep., 122-----	262
^d Dreckschmidt v. Schaefer, 46 App. D. C., 295-----	158
^d Dueber Watch Case Mfg. Co. v. Robbins, 75 Fed. Rep., 17-----	436
** Dunbar v. Meyers, 94 U. S., 187-----	430
Duncan. Ex parte, C. D., 1920, 36; 276 O. G., 207-----	36, 197
Du Rell v. Haley, C. D., 1920, 53; 276 O. G., 776-----	208
^d Durand v. Schulze, 61 Fed. Rep., 819-----	263

E.

** Eagle Glass & Manufacturing Co. v. Rowe et al., 245 U. S., 275-----	482
Eastman Co. v. Kodak Bicycle Co., 15 Reports Pat. Cas., 105-----	203
* Eastwood. In re 33 App. D. C., 291-----	194
^b Eclipse Mach. Co. v. Harley-Davidson Motor Co., 244 Fed. Rep., 463-----	377
^c Edison Electric Light Co. v. Beacon Vacuum, etc., Co., 54 Fed. Rep., 678-----	373
^d Edison, etc., Co. v. Sawyer, etc., Co., 53 Fed. Rep., 592-----	312
^d Edwards v. Dayton, 257 Fed. Rep., 980-----	386
^d Electric Co. v. Pittsburgh Co., 125 Fed. Rep., 926-----	266
^d Electric Gaslighting Co. et al. v. Fuller et al., 59 Fed. Rep., 1003-----	400
^c Electrical Accumulator Co. v. Julien Electric Co., 38 Fed. Rep., 117-----	110
** Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S., 665-----	476
^d Elliott Co. v. Roto Co., 242 Fed. Rep., 941-----	106
^b Engineer Co. v. Hotel Astor, 226 Fed. Rep., 779-----	418
** Ewing v. Fowler Car Company, 244 U. S., 1-----	147
** Expanded Metal Co. v. Bradford, 214 U. S., 366-----	386

F.

^d Faultless Rubber Co. v. Star Rubber Co., 202 Fed. Rep., 927-----	281
Felbel v. Aguilar, C. D., 1906, 113; 121 O. G., 1012-----	10
^d Ferro Concrete Construction Co. v. Concrete Steel Co., 206 Fed. Rep., 666-----	386, 455
* Field v. Colman, 47 App. D. C., 189-----	118
^d Firestone Co. v. Seiberling, 245 Fed. Rep., 937-----	267
* Fischbeck Soap Co. v. Kleeno Manufacturing Co., 44 App. D. C., 6-----	475
* Flora v. Powrie, 23 App. D. C., 195-----	201
^d Florence Manufacturing Co. v. J. C. Dowd & Co., 178 Fed. Rep., 75-----	1, 170, 346
^d Fonseca v. Suarez, 232 Fed. Rep., 155-----	397
* French Battery & Carbon Company v. The Prest-O-Lite Company, 49 App. D. C., 373-----	214
* Freund Bros. & Co. In re, 37 App. D. C., 109-----	1
^d Frost Co. v. Cohn, 119 Fed. Rep., 505-----	397, 446
* Fullagar. In re, 32 App. D. C., 222-----	118
^d Fulton Co. v. Powers, etc., Co., 263 Fed. Rep., 578-----	450
* Fulton Water Works Co. v. Bear Lithia Spring Co., 47 App. D. C., 438-----	166
* Funk v. Whitely, 25 App. D. C., 313-----	133, 136

G.

* Gammeter v. Thropp, 42 App. D. C., 564-----	201, 221
** Gandy v. Marble, 122 U. S., 432-----	98

	Page.
^d Gas Machinery Co. v. United Gas Improvement Co., 228 Fed. Rep., 684	198, 387
* Geltz v. Crozier, 32 App. D. C., 324	177
^d General Co. v. Electric Co., 243 Fed. Rep., 188	266
^c General Electric Co. v. Wise, 119 Fed. Rep., 922	418
* Getz Bros. & Co. v. Alaska Packers' Association, 49 App. D. C., 54	190
** Godfrey v. Eames, 1 Wall., 317	160
^d Gold v. Newton, 254 Fed. Rep., 824	341, 343, 385
** Goodyear Co. v. Davis, 102 U. S., 222	262
** Goodyear India Rubber Glove Mfg. Co. v. Goodyear Rubber Co., 128 U. S., 598	476
* Gordon v. Wentworth, 31 App. D. C., 150	157, 189
** Gorham Co. v. White, 14 Wall., 511	393
^d Goshen Co. v. Bissell Co., 72 Fed. Rep., 67	248
^d Goss Printing Co. v. Scott, 108 Fed. Rep., 253	150
^d Graff, Washbourne & Dunn v. Webster, 195 Fed. Rep., 522	393
** Grant v. Raymond, 31 U. S., 217	94, 486
* Greenawalt v. Dwight, 49 App. D. C., 82	121, 127, 191
* Griffin v. Swenson, 15 App. D. C., 135	209, 210
^c Griffith v. Shaw, 89 Fed. Rep., 313	419
** Grinnell Washing Company v. Johnson Company, 247 U. S., 426	182, 387
^d Griswold v. Harker, 62 Fed. Rep., 389	188
Grover and Barber v. Antoine and Travis, C. D., 1920, 18; 274 O. G., 839	180
Grus, Jr., v. Eynon, C. D., 1920, 49; 276 O. G., 775	49, 213
* Gueniffet v. Wictorsohn, 30 App. D. C., 432	221
** Gulf, Colorado & Santa Fe Gulf Ry. v. Dennis, 224 U. S., 503	482
* Gutta-Percha & Rubber Manufacturing Company v. Ajax Manufacturing Company, 48 App. D. C., 233	168

H.

Haesler and Taylor, C. D., 1902, 474; 101 O. G., 2826	84
** Halles v. Van Wormer, 20 Wall., 353	125, 126
^c Hale & Kilburn Mfg. Co. v. Oneonta C. & R. S. Ry. Co., 129 Fed. Rep., 598	418
Haley v. DuRell, C. D., 1920, 53; 276 O. G., 776	53, 208
** Hamilton-Brown Shoe Company v. The Wolf Brothers & Company, 240 U. S., 251	345
* Harbeck. In re, 39 App. D. C., 555	194
§ Harburg v. Arnold, 87 Mo. App., 326	15
^d Harder et al. v. United States Piling Co., 160 Fed. Rep., 463	256
** Harriman v. Northern Securities Co., 197 U. S., 244	481
* Hart & Barber v. Wiig, 49 App. D. C., 78	220
* Hathaway v. Field, 48 App. D. C., 370	237
* Hathaway & Lea v. Colman, 46 App. D. C., 40	179
Hefner-Alteneck, Frederick von, C. D., 1883, 33; 23 O. G., 2223	75
Hein v. Pungs, C. D., 1894, 92; 68 O. G., 657	57
Henderson v. Noakes, C. D., 1892, 114; 59 O. G., 1431	8
Henry. In re, C. D., 1909, 40; 140 O. G., 508	83
^b Hercules Powder Company v. Newton, Commissioner of Patents, 254 Fed. Rep., 906	342
* Hercules Powder Company. In re, 46 App. D. C., 52	342
Herman v. Fullman, C. D., 1903, 452; 107 O. G., 1094	20

	Page.
* <i>Herman v. Fullman</i> , 23 App. D. C., 259.....	21
* <i>Herman v. Youngstown</i> , 191 Fed. Rep., 579.....	404, 414
* <i>Heroult. In re</i> , 29 App. D. C., 42.....	10
** <i>Hicks v. Kelsey</i> , 18 Wall., 670.....	368
* <i>Hildreth v. Auerbach</i> , 223 Fed. Rep., 545.....	417
* <i>Hinman v. Visible Milk Co.</i> , 239 Fed. Rep., 896.....	371
** <i>Hobbs v. Beach</i> , 180 U. S., 383.....	259, 377, 385, 386
<i>Hoenig v. Parker</i> , C. D., 1920, 234; 278 O. G., 387.....	241
* <i>Holeproof Hosiery Co. v. Wallach Bros.</i> , 167 Fed. Rep., 373.....	346
* <i>Holeproof Hosiery Co. v. Wallach Bros.</i> , 172 Fed. Rep., 859.....	2, 148, 346
* <i>Hopkins v. Peters</i> , 41 App. D. C., 802.....	171
* <i>Hopkins v. Riegger</i> , 49 App. D. C., 188.....	191
* <i>Houser v. Starr</i> , 203 Fed. Rep., 284.....	256, 454
* <i>Howard v. Bowes</i> , 81 App. D. C., 619.....	158
* <i>Howard v. Hey</i> , 18 App. D. C., 142.....	189
** <i>Hoyt v. Horne</i> , 145 U. S., 302.....	300
* <i>Hubbard v. Burg</i> , 40 App. D. C., 577.....	221
** <i>Hubbell v. United States</i> , 179 U. S., 77.....	430
* <i>Huebner Co. v. Matthews Co.</i> , 253 Fed. Rep., 435.....	386
* <i>Hughes v. Smith</i> , 209 Fed. Rep., 39.....	345
<i>Hull, Stephen, Ex parte</i> , C. D., 1869, 68.....	44
* <i>Hunter v. Stikeman</i> , 13 App. D. C., 214.....	54

I.

* <i>I. T. S. Rubber Co. v. Panther Co.</i> , 260 Fed. Rep., 934.....	275
* <i>Ide v. Trorlicht Carpet Co.</i> , 115 Fed. Rep., 137.....	216, 312
<i>Illinois Seed Co., The, Ex parte</i> , C. D., 1915, 17; 219 O. G., 931.....	474
** <i>Imhauser v. Buerk</i> , 101 U. S., 647.....	299
* <i>Imperial Machine Co. v. American Fruit Machinery Co.</i> , 212 Fed. Rep., 959.....	369
* <i>Imperial Machine Co. v. Jacobus</i> , 212 Fed. Rep., 958.....	368
* <i>Imperial Machine Co. v. Rees et al.</i> , 261 Fed. Rep., 612.....	369
* <i>Imperial Machine Co. v. Reinhold Mfg. Co.</i> , 262 Fed. Rep., 419.....	369
* <i>Imperial Machine Co. v. Smith & McNell</i> , 262 Fed. Rep., 419.....	369
* <i>Imperial Machine Co. v. Streeter & Co.</i> , 214 Fed. Rep., 985.....	369
* <i>Imperial Machine Co. v. Whyte</i> , 262 Fed. Rep., 419.....	369
** <i>Incandescent Lamp Patent, The</i> , 159 U. S., 474.....	351
* <i>Independent Breweries Co. In re</i> , 39 App. D. C., 118.....	84, 85
* <i>International Co. v. Slevert</i> , 213 Fed. Rep., 225.....	386
* <i>International Tooth Crown Co. v. Richmond</i> , 30 Fed. Rep., 775.....	163
* <i>Ireson v. Pierce</i> , 39 Fed. Rep., 795.....	110
** <i>Ives v. Sargent</i> , 119 U. S., 652.....	122

J.

* <i>Jay v. Weinberg</i> , 250 Fed. Rep., 469.....	402, 403
* <i>Jobski v. Johnson</i> , 47 App. D. C., 230.....	201
* <i>Johnson v. Brandau</i> , 32 App. D. C., 348.....	474
* <i>Johnson v. Lambert</i> , 234 Fed. Rep., 886.....	439
* <i>Johnson v. Toledo Traction Co.</i> , 119 Fed. Rep., 885.....	411
<i>Jolliffe v. Waldo v. Vermeer and Schorik</i> , C. D., 1917, 15; 234 O. G., 671.....	73, 75, 76
* <i>Jones v. Cyphers</i> , 126 Fed. Rep., 753.....	442

K.

	Page.
* Kaut-Reith Shoe Co. v. International Shoe Co., 45 App. D. C., 545.....	240
* Kellogg, etc., Co. v. Quaker Oats Co., 235 Fed. Rep., 657.....	345
* Kennicott v. Caps, 49 App. D. C., 187.....	120, 191, 201
** Keystone Co. v. Phoenix Co., 95 U. S., 274.....	250
King Ax Co. et al. v. Hubbard, 97 Fed. Rep., 795.....	259
* Kirby v. Clements, 44 App. D. C., 12.....	177, 185
* Kissinger Co. v. Bradford Co., 123 Fed. Rep., 91.....	267
Kitselman v. Reid, Reid, and Kelley, C. D., 1920, 26; 275 O. G., 623.....	191
** Knapp v. Morss, 150 U. S., 221.....	366, 419
* Krell Piano Co. v. Storey & Clark Co., 207 Fed. Rep., 946.....	441

L.

* Lamb v. Lamb, 120 Fed. Rep., 267.....	263, 287
* Lambert Pharmacal Co. v. Mentho-Listine Chem. Co., 47 App. D. C., 197.....	170, 240
* Lamson, etc., Co. v. Hillman, 123 Fed. Rep., 423.....	450
* Lange v. McGuin, 177 Fed. Rep., 219.....	441
Lawrence v. Dowden Co., 178 Fed. Rep., 73.....	204
** Lawrence Manufacturing Co. v. Tennessee Manufacturing Co., 138 U. S., 537.....	476
* Lecroix v. Tilberg, 33 App. D. C., 586.....	221
** Leeds and Catlin Co. v. Victor Talking Machine Co., 213 U. S., 301.....	263, 482
* Lemley v. Dobson-Evans Co., 243 Fed. Rep., 391.....	380, 406
* Lemp v. Randall and Bates, 33 App. D. C., 430.....	161, 162
* Leonard v. Horton, 40 App. D. C., 22.....	177
* Lewis Machine Co. v. Premium Mfg. Co., 163 Fed. Rep., 954.....	291
* Lindmark v. Hodgkinson, 31 App. D. C., 612.....	223
* Lindsay v. Stein, 20 Blatchf., 370.....	57
* Livingston v. Thompson, 45 App. D. C., 522.....	179
* Loew Supply Co. v. Fred Miller Brewing Co., 138 Fed. Rep., 886.....	403
* Loose Leaf Co. v. Leaf-Binder Co., 230 Fed. Rep., 120.....	455
* Louisville Trust Co. v. Van Kannel Revolving Door Co., 231 Fed. Rep., 166.....	101, 102
* Lourie Implement Co. v. Lenhart, 130 Fed. Rep., 122.....	300
* Lovell v. Seybold, etc., 169 Fed. Rep., 288.....	449
* Ludington, etc., Co. v. Leonard, 127 Fed. Rep., 155.....	347
** Lutcher & Moore Lumber Co. v. Knight, 217 U. S., 257.....	482
* Luten v. Washburn, 253 Fed. Rep., 950.....	444

M.

* Macbeth-Evans Glass Co. v. General Electric Co., 246 Fed. Rep., 695.....	262
MacLay. Ex parte, C. D., 1889, 220; 49 O. G., 1043.....	163
* Macmahan Pharmacal Co. v. Denver Chemical Mfg. Co., 113 Fed. Rep., 463.....	166
** Mahn v. Harwood, 112 U. S., 354.....	9, 469
** Manhattan Medicine Co. v. Wood, 108 U. S., 218.....	476
Manny v. Easley v. Greenwood, C. D., 1890, 73; 51 O. G., 1617.....	55
** Manufacturing Company v. Traimer, 101 U. S., 51.....	476
* Marconi. In re, 38 App. D. C., 286.....	172
* Marconi, etc., Co. v. DeForest, etc., Co., 243 Fed. Rep., 564.....	353
Maremont v. Olson, C. D., 1920; 276 O. G., 405.....	44, 200

	Page.
* <i>Martin</i> . In re, 48 App. D. C., 187.....	173
* <i>Mason v. Hepburn</i> , 13 App. D. C., 86.....	44, 45, 245
** <i>Mast, Foos & Co. v. Stover Manufacturing Co.</i> , 177 U. S., 488.....	481
** <i>Masury v. Anderson</i> , 11 Blatchford, 165; Fed. Cas., No. 9270.....	449
* <i>Mattullath Aeroplane Company</i> . In re, 46 App. D. C., 143.....	98, 99
* <i>Maurer v. Dickerson</i> , 113 Fed. Rep., 870.....	263
* <i>Mausoleum Co. v. Sievert</i> , 213 Fed. Rep., 225.....	454
* <i>Mayo v. Whedon</i> , 47 App. D. C., 138.....	225
** <i>McCarty v. Lehigh Valley R. Co.</i> , 160 U. S., 110.....	256
** <i>McClaim v. Ortmyer</i> , 141 U. S., 419.....	409
* <i>McKay-Copeland Co. v. Copeland Co.</i> , 77 Fed. Rep., 306.....	424
* <i>McKay-Copeland v. Copeland Rapid Laster Mfg. Co.</i> , 80 Fed. Rep., 518.....	424
* <i>McKeen v. Jerdone</i> , 34 App. D. C., 163.....	219
** <i>McLean v. Fleming</i> , 96 U. S., 245.....	303
* <i>McSherry Co. v. Dowagiac Co.</i> , 160 Fed. Rep., 948.....	253
<i>Mead v. Brown</i> , C. D., 1889, 173; 48 O. G., 397.....	162
* <i>Meccano Limited v. Wagner et al.</i> , 234 Fed. Rep., 912.....	479
* <i>Meccano Limited v. John Wanamaker</i> , 250 Fed. Rep., 450.....	481
* <i>Mell v. Midgley</i> , 31 App. D. C., 534.....	221
** <i>Menendez v. Holt</i> , 128 U. S., 514.....	303
* <i>Metallic Co. v. Brown</i> , 104 Fed. Rep., 345.....	249
* <i>Miel v. Young</i> , 29 App. D. C., 481.....	185
* <i>Miller v. Tyler</i> , 58 N. Y., 477.....	15
* <i>Miller & England v. Walker</i> , 188 Fed. Rep., 919.....	74
* <i>Milloy Electric Co. v. Thomson-Houston Electric Co.</i> , 148 Fed. Rep., 843.....	10, 105
* <i>Mills and Conn v. Darlington</i> , 38 App. D. C., 95.....	162
* <i>Miner v. Symington</i> , 229 Fed. Rep., 730.....	111
* <i>Minneapolis Ry. Co. v. Barnett & Record Co.</i> , 257 Fed. Rep., 302.....	373
* <i>Moline Plow Co. v. Omaha Co.</i> , 235 Fed. Rep., 519.....	359
* <i>Monte v. Dunkley</i> , 46 App. D. C., 70.....	177
* <i>Moore v. Hewitt</i> , 31 App. D. C., 577.....	189
* <i>Moore v. United States ex rel. Chott</i> , 40 App. D. C., 591.....	43
<i>Moore and Pack</i> . Ex parte, C. D., 1920, 21; 274 O. G., 840.....	182
* <i>Morgan Co. v. Alliance Co.</i> , 176 Fed. Rep., 100.....	386
** <i>Morley Machine Co. v. Lancaster</i> , 129 U. S., 263.....	300
* <i>Munising Paper Co. v. American Sulphite Pulp Co.</i> , 228 Fed. Rep., 700.....	454
* <i>Murphy v. Meissner</i> , 24 App. D. C., 260.....	223
* <i>Mygatt v. Schaffer</i> , 218 Fed. Rep., 827.....	393

N.

* <i>Nalrn Linoleum Co. v. Ringwalt Linoleum Works</i> , 46 App. D. C., 64.....	473, 475
* <i>Nashville Syrup Co., etc., v. Cocoa Cola Co.</i> , 215 Fed. Rep., 527.....	344
* <i>National Cash Register Co. v. Gratigny</i> , 213 Fed. Rep., 463.....	256
* <i>National Co. v. Aiken</i> , 163 Fed. Rep., 254.....	386
* <i>National Co. v. Leland</i> , 194 Fed. Rep., 502.....	253
* <i>National Harrow Co. v. Quick</i> , 74 Fed. Rep., 236.....	362, 366
* <i>National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.</i> , 106 Fed. Rep., 693.....	310, 371, 450
* <i>National Phonograph Co.</i> In re, 29 App. D. C., 142.....	344, 346
* <i>National Regulator Co. v. Powers Regulator Co.</i> , 160 Fed. Rep., 460.....	442
* <i>Nestlé & Anglo-Swiss Co. v. Baker & Co.</i> , 37 App. D. C., 148.....	133, 206

	Page.
* New Departure Mfg. Co. v. Robinson, 39 App. D. C., 504.....	172
^d New York Belting & Packing Co. v. Sierer, 158 Fed. Rep., 819.....	446
^d New York, etc., Co. v. Sierer, 158 Fed. Rep., 819.....	353
^d New York Mackintosh Co. v. Flam et al., 198 Fed. Rep., 571.....	2
^d New York Scaffolding Company v. Whitney, 224 Fed. Rep., 452.....	488, 493
^d New York Scaffolding Company v. Liebel-Binney Construction Company, 243 Fed. Rep., 577.....	488, 494
^d Ney v. Ney Mfg. Co., 69 Fed. Rep., 405.....	419
* Norling v. Hayes, 37 App. D. C., 169.....	29, 32, 221
^d Norton v. Jensen, 90 Fed. Rep., 415.....	419
^d Novelty Co. v. Buser, 158 Fed. Rep., 83.....	267

O.

* O'Connell v. Schmidt, 27 App. D. C., 77.....	213
^c O'Rourke v. Central City Soap Works, 26 Fed. Rep., 576.....	148
^d O'Rourke Engineering Const. Co. v. McMullen et al., 160 Fed. Rep., 933...	375
^d Ohmer Co. v. Ohmer, 238 Fed. Rep., 182.....	253, 409, 424
^d Onepiece Bifocal Lens Company v. Bislight, 246 Fed. Rep., 450.....	258
^{oo} Opinion of the Judge Advocate General, C. D., 1919, 133; 260 O. G., 733...	98
* Orcutt. In re, 32 App. D. C., 345.....	238

P.

Palmer Pneumatic Tire Co. v. Losler, 90 Fed. Rep., 732.....	68
^b Paramount Hosiery Form Drying Company, 251 Fed. Rep., 897.....	268
^d Paris Co. v. Hill Co., 102 Fed. Rep., 148.....	114
^d Parsons Mfg. Co. v. Coe, 185 Fed. Rep., 522.....	359
** Patterson v. Kentucky, 97 U. S., 501.....	94
Patterson-Allen Engineering Company, 118 MS. Dec., 389.....	1
* Patton Paint Co. v. Orr's Zinc White, Ltd., 48 App. D. C., 221.....	169
^d Pedersen v. Dundon, 220 Fed. Rep., 309.....	300
** Peters v. Active Mfg. Co., 129 U. S., 530.....	366
** Philadelphia & Trenton Railroad Co. v. Stimpson, 14 Peters, 461.....	111
* Phoenix Paint & Varnish Co. v. John T. Lewis & Bros. Co., 32 App. D. C., 285.....	240
Pieper. Ex parte, C. D., 1905, 102; 115 O. G., 1063.....	84
^d Pillsbury v. Flour Mills Co., 64 Fed. Rep., 841.....	114
** Plummer v. Sargent, 120 U. S., 442.....	265
* Podlesak v. McInnerney, 26 App. D. C., 399.....	134, 136, 185, 223
^d Pope Mfg. Co. v. Arnold, Schwinn & Co., 193 Fed. Rep., 649.....	444
** Potts v. Creager, 155 U. S., 597.....	353, 385
** Powder Co. v. Powder Wks., 98 U. S., 126.....	263
^d Pressed Steel Co. v. Brownell & Co., 123 Fed. Rep., 86.....	446
Pringleau and Pringleau, 123 MS. Dec., 164.....	163
^d Procter & Gamble v. Berlin Mills Company, 253 Fed. Rep., 23.....	496
^d Proudft Loosleaf Co. v. Kalamazoo Loosleaf Binder Co., 230 Fed. Rep., 120.....	253, 256
^c Putnam v. Keystone Bottle Co., 38 Fed. Rep., 234.....	419

Q.

* Quaker Oats Co. v. Mothers Macaroni Co., 41 App. D. C., 254.....	120
* Quist v. Ostrom, 23 App. D. C., 69.....	189

R.

Page.

* <i>Rahley v. Columbia Phonograph Company</i> , 122 Fed. Rep., 623	482
** <i>Railway Co. v. Sayles</i> , 97 U. S., 554	430
* <i>Ransome Co. v. United Co.</i> , 177 Fed. Rep., 413	424
* <i>Rawson et al. v. C. W. Hunt Co.</i> , 140 Fed. Rep., 716	10
** <i>Reed v. Cutter</i> , Federal Cases Nos. 11, 645	72, 74
<i>Reid, Reid and Kelley v. Kltzman</i> , C. D., 1920, 28; 275 O. G., 1024	192
<i>Reilly, Edw.</i> , 114 MS. Dec., 330	2
<i>Rinsburger</i> , 128 MS. Dec., 141	475
* <i>Robinson v. McCormick</i> , 29 App. D. C., 98	219
* <i>Rohm and Rohm & Haas Company v. Martin Dennis Company</i> , 263 Fed. Rep., 106	349
* <i>Ross v. Loewer</i> , 9 App. D. C., 563	98
* <i>Roth v. Harris</i> , 168 Fed. Rep., 279	395
* <i>Bowell. In re</i> , 48 App. D. C., 238	150
* <i>Rowntree v. Sloan</i> , 45 App. D. C., 207	15, 242, 245, 467
* <i>Royer v. Coupe</i> , 29 Fed. Rep., 358	418
** <i>Royer v. Coupe</i> , 146 U. S., 524	265
** <i>Rubber Co. v. Goodyear</i> , 9 Wall., 788	233
* <i>Ryan v. Metropolitan, etc., Club</i> , 144 Fed. Rep., 699	451

S.

* <i>Sanitas Co. v. Voigt</i> , 139 Fed. Rep., 551	263
* <i>Sayles v. Chicago & Northwestern R. R. Co.</i> , 1 Bliss., 468; Fed. Cases No. 12, 414	154
* <i>Scandinavian Co. v. Asbestos, etc., Works</i> , 257 Fed. Rep., 951	347
<i>Scannell v. Bethke</i> , C. D., 1920, 1921; 273 O. G., 185	150
* <i>Schiebel Co. v. Clark</i> , 217 Fed. Rep., 760	250
* <i>Schmidt v. Clark</i> , 32 App. D. C., 291	143
<i>Schneider. Ex parte</i> , C. D., 1920, 271 O. G., 360	121
* <i>Schneider v. Driggs</i> , 36 App. D. C., 116	20
* <i>Scott v. Fisher Co.</i> , 145 Fed. Rep., 922	451
* <i>Seamless Rubber Co.</i> , 34 App. D. C., 357	1
* <i>Searchlight Horn Co. v. Sherman Clay & Co.</i> , 214 Fed. Rep., 99	373
* <i>Sendelbach v. Gillette</i> , 22 App. D. C., 168	143, 144, 219
* <i>Seymour v. Molyneux</i> , 49 App. D. C., 216	185
** <i>Seymour v. Osborne</i> , 11 Wall., 516	258
* <i>Sharer v. McHenry</i> , 19 App. D. C., 158	142
<i>Sharpe. In re</i> , 84 L. J., ch. 290	344
<i>Shenk and Holman v. Clark</i> , C. D., 1920, 16; 274 O. G., 405	178
* <i>Shredded Wheat Co. v. Humphrey Cornell Co.</i> , 250 Fed. Rep., 960	347
* <i>Siegert v. Gandolfi</i> , 149 Fed. Rep. 100	346
* <i>Siemens v. Chambers</i> , 51 Fed. Rep., 902	318
* <i>Simplex Heating Company v. Gold Car Heating and Lighting Company</i> , 43 App. D. C., 28	168
* <i>Sirrocco Engineering Co. v. Sturtevant</i> , 220 Fed. Rep., 137	110
** <i>Slawson v. Grand St. Ry. Co.</i> , 107 U. S., 649	430
* <i>Slick v. Hansen</i> , 39 App. D. C., 131	212
<i>Smith. Ex parte</i> , C. D., 1920, 2, 5; 271 O. G., 155, 156	125, 140
** <i>Smith v. Goodyear Dental Vulcanite Co.</i> , 93 U. S., 486	160
* <i>Smith v. Kihlgren</i> , 43 App. D. C., 193	21
** <i>Smith v. Vulcanite</i> , 93 U. S., 486	112
** <i>Smith v. Vulcan Iron Works</i> , 165 U. S., 518	481

	Page.
^b Smith & Co., H. D., <i>v.</i> Peck Stow & Wilcox Co., 258 Fed. Rep., 40.....	374
^d Smith & Co., H. D., <i>v.</i> Southington Manufacturing Company, 247 Fed. Rep., 342.....	374, 376
** Smith & Griggs Manufacturing Co. <i>v.</i> Sprague, 123 U. S., 249.....	466, 470
* Sobey <i>v.</i> Holsclaw, 28 App. D. C., 65.....	185, 221
^d Southern Express Company <i>v.</i> Long et al., 202 Fed. Rep., 462.....	482
^d St. Louis Car Coupler Co. <i>v.</i> National Malleable Castings Co., 87 Fed. Rep., 885.....	419
Stadeker. Ex parte, C. D., 1920, 34; 275 O. G., 1023.....	190
* Stanbon <i>v.</i> Howe et al., 34 App. D. C., 418.....	20
^d Standard Caster & Wheel Co. <i>v.</i> Socket Co., 113 Fed. Rep., 162.....	300
Standard Ideal Co. <i>v.</i> Standard Sanitary Co., L. R., 1911, App. Cas., 78....	346
** Standard Paint Company <i>v.</i> Trinidad Asphalt Manufacturing Company, 220 U. S., 446.....	1, 168, 341, 344, 476
Stapleton <i>v.</i> Kinney, C. D., 1901, 414; 96 O. G., 1432.....	212
* Starkey. In re, 21 App. D. C., 519.....	10, 123
* Stephens-Adamson Mfg. Co. In re, 49 App. D. C., 181.....	167, 168
Stephenson <i>v.</i> Goodell, C. D., 1876, 133; 9 O. G., 1195.....	54
^d Stevenson <i>v.</i> Shalcross, 205 Fed. Rep., 286.....	444
** Stewart <i>v.</i> American Lava Co., 215 U. S., 161.....	429
^d Stillwell-Bierce & Smith Vaile Co. <i>v.</i> Bufaula Cotton Oil Co., 117 Fed. Rep., 410.....	287
* Stone <i>v.</i> Pupin, 19 App. D. C., 396.....	228
^d Streit <i>v.</i> Kalper et al., 143 Fed. Rep., 981.....	444
** Suffolk Co., The, <i>v.</i> Hayden, 3 Wall., 315.....	216

T.

^d Taggart Baking Company <i>v.</i> Green, 257 Fed. Rep., 87.....	426
^d Tate <i>v.</i> Baltimore, etc., R. R., 229 Fed. Rep., 141.....	436
Taylor <i>v.</i> Gilman, C. D., 1910, 167; 158 O. G., 883.....	212
Taylor <i>v.</i> Taylor, 2 Eq. Rep., 290.....	114
^d Texas Traction Company <i>v.</i> Barron G. Collier, Inc., 195 Fed. Rep., 65.....	482
^d Thermogene Co. <i>v.</i> Thermozone Co., 234 Fed. Rep., 69.....	346
Thomas. Ex parte, C. D., 1918, 11; 251 O. G., 839.....	196
* Thomas Mfg. Co. <i>v.</i> Aeolian Co., 47 App. D. C., 376.....	169, 190, 214, 240
* Thompson <i>v.</i> Storrie, 46 App. D. C., 324.....	221
^d Thomson-Houston Co. <i>v.</i> Ohio Brass Co., 80 Fed. Rep., 712.....	412
^d Thomson-Houston Co. <i>v.</i> Sterling-Meaker Co., 171 Fed. Rep., 111.....	412
* Thum Co., O. W., <i>v.</i> Dickinson, 46 App. D. C., 306.....	170
Tilden. Ex parte, C. D., 1912, 265; 182 O. G., 971.....	10
^d Toledo Co. <i>v.</i> Kawneer Co., 237 Fed. Rep., 367.....	412
** Topliff <i>v.</i> Topliff, 145 U. S., 156.....	9, 11, 123, 376, 430
^d Towne Steering Wheel Co. <i>v.</i> Lee, 199 Fed. Rep., 777.....	34, 35
Townsend. In re, C. D., 1913, 55; 188 O. G., 513.....	82, 83
** Trade-Mark Cases, 100 U. S., 82.....	165, 166
^d Travis County <i>v.</i> King Iron Bridge & Mfg. Co., 92 Fed. Rep., 690.....	15
^d Tubular Rivet & Stud Co. <i>v.</i> Standard Finding Co., 231 Fed. Rep., 170.....	401
^d Turner <i>v.</i> Lauter Piano Co., 248 Fed. Rep., 930.....	359
^d Twentieth Century Machinery Co. <i>v.</i> Loew Mfg. Co., 243 Fed. Rep., 373....	212

U.

** Underwood <i>v.</i> Gerber, 149 U. S., 224.....	67, 68
** United Drug Co. <i>v.</i> Rectanus, 248 U. S., 90.....	232

	Page.
** United States v. American Bell Telephone Company, 167 U. S., 224-----	409
** United States Fidelity & Guaranty Co. v. Bray, 225 U. S., 205-----	481
* United States Glass Co. v. Atlas Glass Co., 90 Fed. Rep., 724-----	265
* United States Rubber Co. v. I. T. S. Rubber Co., 260 Fed. Rep., 947-----	276
** United States v. Telephone Co., 167 U. S., 224-----	245

V.

* Van Dorn Co. v. Mathis Co., 260 Fed. Rep., 400-----	386
* Van Kannel Revolving Door Co. v. Revolving Door & Fixture Co., 219 Fed. Rep., 741-----	101, 102
* Van Kannel, etc., Co. v. Strauss, 235 Fed. Rep., 137-----	101, 103, 451
* Van Kannel Revolving Door Co. v. Lyon & Healy, 247 Fed. Rep., 329-----	101, 103
* Van Kannel Revolving Door Co. v. Uhrich, 247 Fed. Rep., 344-----	101, 103
* Vanmannen v. Leonard, 248 Fed. Rep., 939-----	251
* Viele v. Cummings, 30 App. D. C., 455-----	134, 136
* Voightmann v. Perkinson, 138 Fed. Rep., 56-----	442
* Von Recklinghausen v. Dempster, 34 App. D. C., 474-----	466, 470
* Von Schmidt v. Bowers, 80 Fed. Rep., 121-----	111, 112
* Vrooman-Penhollow Case, 179 Fed. Rep., 296-----	251

W.

** Wagner. Ex parte, 249 U. S., 465-----	481
* Wagner v. Meccano Limited, 246 Fed. Rep., 603-----	480
* Walke & Co., William, v. George H. Schafer & Co., 263 Fed. Rep., 650--	240
* Warner v. Smith, 13 App. D. C., 111-----	189
* Warren v. Owosso, 166 Fed. Rep., 309-----	386
* Warren Steam Pump Co. v. Blake & Knowles Steam Pump Works, 163 Fed. Rep., 263-----	287
* Warren Webster & Co. v. Dunham Co., 181 Fed. Rep., 836-----	400
* Washburn & Moen Manufg Co. v. Haish, 4 Fed. Rep., 900-----	55
** Waterman v. Makenzie, 138 U. S., 252-----	363
* Waterman v. Shipman, 55 Fed. Rep., 982-----	434
§ Waterman v. Shipman, 130 N. Y., 301-----	345
Watson v. Thomas, C. D., 1903, 370; 106 O. G., 1776-----	212
* Wayne County Preserving Co. v. Burt Olney Canning Co., 82 App. D. C., 279-----	240
* Weber Electric Co. v. Cutler-Hammer Mfg. Co., 256 Fed. Rep., 81-----	378
* Webster & Co. v. Dunham Co., 181 Fed. Rep., 836-----	400
** Webster Loom Co. v. Higgins, 105 U. S., 580-----	111, 112, 194, 386, 455
* Western Co. v. Northern Co., 135 Fed. Rep., 80-----	253
** Westinghouse v. Boyden Power Brake Co., 170 U. S., 537-----	419, 421
* Westinghouse Co. v. New York Co., 63 Fed. Rep., 962-----	412
* Westinghouse Electric Company v. Ohio Brass Company, 186 Fed. Rep., 518-----	98
* Westinghouse Co. v. Stanley Co., 138 Fed. Rep., 823-----	267
* Westrumite Co. v. Commissioners, 174 Fed. Rep., 144-----	441
** White v. Dunbar, 119 U. S., 47-----	250, 256
* Whitely v. Fadner, 73 Fed. Rep., 486-----	300
* Whitlock Coil Pipe Co. v. Mayo Radiator Co., 257 Fed. Rep. 752-----	447
* Willcox & Gibbs Co. v. Merrow, 93 Fed. Rep., 206-----	412
* Williams v. Mitchell, 106 Fed. Rep., 168-----	345
** Winans v. Denmead, 15 How., 341-----	249

XXII DECISIONS OF THE COMMISSIONER OF PATENTS, 1920.

	Page.
* Wintroath <i>v.</i> Chapman, 47 App. D. C., 428-----	14, 15, 242, 245
** Wollensak <i>v.</i> Reiher, 115 U. S., 96-----	122, 469
** Wood <i>v.</i> Underhill, 5 How., 1-----	351
* Woods <i>v.</i> Poor, 29 App. D. C., 397-----	210, 213
♂ Worcester, etc., Co. <i>v.</i> Rueter, 157 Fed. Rep., 217-----	347
♂ Wright <i>v.</i> Wisconsin Lime & Cement Co., 239 Fed. Rep., 534-----	441
♂ Wrigley, etc., Co. <i>v.</i> Grove Co., 183 Fed. Rep., 99-----	347
* Wyman <i>v.</i> Donnelly, 21 App. D. C., 81-----	21

Y.

♂ Yancey <i>v.</i> Enright, 230 Fed. Rep., 641-----	292
---	-----

SUBJECT-MATTER INDEX.

[Opinions of the Solicitor of the Department of the Interior are indicated by a degree mark (°); of the Attorney General by a double dagger (‡); decisions of the Supreme Court of the District of Columbia by the letter (°); of the Court of Appeals of the District of Columbia by one star (*); of the United States Circuit Court of Appeals by the letter (°); and of the Supreme Court of the United States by two stars (**).]

A.

	Page.
Abandoned experiments, device made, tested, long delay in filing application, although applications filed for other devices, <i>Grus, Jr., v. Eynon</i> ---	49
Long delay in applying for patent and abandonment of experimental device, loses right to assert priority, * <i>Duncan v. Shelley</i> -----	155
Sufficiency of test challenged, no attempt made to prove operativeness, * <i>Hartsough v. Gile</i> -----	187
Abandonment of applications by winning party, losing party not entitled to patent if invention put to public use before abandonment, <i>Nash v. Reeder v. Ryan</i> -----	72
Not warranted where Examiner objects to sufficiency of response after acting on merits of claims. <i>Ex parte Humphrys</i> -----	70
Abandonment of invention, burden of proof on party alleging, not sustained where only evidence period of delay, explained by financial embarrassment. * <i>Hoenig v. Parker</i> -----	234
Question of fact, not to be presumed by mere delay, * <i>Wells and Hunter v. Honigmann</i> -----	242
Affidavits under Rule 75, access to refused, * <i>Erben v. Yardley</i> -----	220
Amendment of claims to meet objection of double patenting binding on patentee, * <i>Higgin Mfg. Co. v. Watson et al.</i> -----	403
Amendments, drawings, entry not to be refused because not making all changes regarded as necessary, unless undoing work done. <i>Ex parte Humphrys</i> -----	70
Anticipation, device described in foreign publication, not patentable even if unknown to patentee, ** <i>Bone v. Commissioners of Marion County</i> ---	457
Not established, affidavits showing distinction between applicant's claims and prior patent. <i>Ex parte Comey</i> -----	65
Without claim to priority relied on as defense, inventor may show prior invention by competent proof, * <i>Barber v. Otis Motor Sales Co.</i> ---	106
Appeal, in determining validity entire prior art considered regardless of claim lower court erred, * <i>Backstay Machine & Leather Co. v. Hamilton</i> ---	397
Licensee joined with owner in suit, patent declared invalid, licensee refusing to appeal owner may prosecute appeal independently, * <i>Bellows and Slack v. New York Central Railroad Company; Same v. Pressed Steel Car Company</i> -----	362
To Circuit Court of Appeals from order granting injunction upon insuperable objection appearing, bill dismissed and litigation terminated, ** <i>Meccano Limited v. John Wanamaker, New York</i> -----	478

	Page.
Applications, abandonment of original, substitute application filed there- after not a continuation of first application. Ex parte Hall-----	56
Continuing, defined. Ex parte Id.-----	56
To change joint to sole when one applicant has admitted that he was not an inventor, but was included by mistake, with no fraudulent intent, no reason seen for refusing amendment eliminating super- fluous applicant. In re Roberts-----	158
Attorney, inventor bound by acts of agent. In re Schneider-----	121

C.

Certiorari, decree made final in Circuit Court of Appeals, may be taken up by Supreme Court and treated as if on appeal, *Meccano Limited v. John Wanamaker, New York-----	478
Reviewing interlocutory order, Supreme Court will not consider con- flict of decisions or merits, review being only on action of lower court upon the order. Id.-----	478
Claims, application for reissue to broaden, filed after unreasonable delay, claims properly refused. Ex parte Schneider-----	9
Construed in light of specification when first made, although originat- ing in application of party dropped out of the case in a three-party interference proceeding, *Cox v. Headley and Thompson-----	183
Duplication, feature specified in one claim omitted in the other, feature must be implied. Ex parte Comey-----	65
For indicator provided with graduation not aggregational when specifying such graduation. Ex parte Duncan-----	36
Multiplicity of, defining simple invention, duty of applicant to point out distinctions. Ex parte Id.-----	36
On appeal to Commissioner of Patents found indefinite, remanded to Primary Examiner. Ex parte Schneider-----	25
Rejection of, for duplication and indefiniteness. Ex parte Duncan--	36
* In re Duncan-----	197
Commissioner of Patents, action not restricted to questions put in assign- ment of errors, may base opinion upon information otherwise obtained. Ex parte Duncan-----	36
Decision, sustained by Court of Appeals of the District of Columbia, on motion within his discretion, where no abuse is shown. * In re Dement -----	170
No jurisdiction to consider claims presented after appeal is perfected. * In re Smith-----	140
Concurrent decisions of the Patent Office not to be disturbed except where error clearly appears, *Blaine v. White-----	222
Construction may be made and sold after expiration of patent which it infringed, ^b Van Kannel Revolving Door Co. v. Winton Hotel Co.-----	99
Construction of claims, duplication of device of prior art not patentable. * In re Lower-----	149
Issue relating to subordinate part of machine, operativeness of ma- chine as a whole not basis for award. * Cox v. Headley and Thomp- son-----	183
Limitations pertaining to inventive step rather than to its environ- ments, ^d D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.-----	246

Construction of claims—Continued.	Page.
Limiting words sufficiently broad to include equivalents. <i>Ohio Rake Co. v. Bucher & Gibbs Plow Co.</i>	451
Prior art shows process unpatentable. <i>Ex parte Foss</i>	61
Refused because objectionable in form. <i>Id.</i>	61
Right to make claims. <i>* Seymour v. Molyneux</i>	137
Specification may be considered in construing claims describing certain elements in general terms, <i>I. T. S. Rubber Co. v. Panther Rubber Mfg. Co.</i>	283
Specifying construction as of a "continuous strip" not restricted to literal terms employed, <i>Whitlock Coil Pipe Co. v. Mayo Radiator Co.</i>	447
Construction of statutes, act of March 3, 1883. † Opinion of the Attorney General	92
Section 4886, Revised Statutes, <i>b Barber v. Otis Motor Sales Co.</i>	106
Section 4888, Revised Statutes, <i>d Rohm et al. v. Martin Dennis Co.</i> ...	349
Section 4897, Revised Statutes, <i>* Wells and Hunter v. Honigmann</i> ...	242
Section 4915, Revised Statutes, <i>c Mattullath Aeroplane Company v. Newton, Commissioner of Patents</i>	97
Section 4920, Revised Statutes, <i>Nash v. Reeder v. Ryan</i>	72
Construction of specifications and patents, Bridge, No. 1,006,995; Chambers, No. 782,880; Hiltner, Nos. 821,361 and 822,452; Lubbers, Nos. 702,013–702,015, 822,678, 886,618, and 914,586, all for window-glass manufacture, valid and infringed, <i>d Consolidated Window Glass Co. v. Window Glass Mach. Co. et al.</i>	313
Certain phrase construed in accordance with intention of patentee, <i>d Concrete Appliances Co. et al. v. Meinken et al.</i>	378
Claim to combination including means, etc., limited to means described, <i>d Mastoras v. Hildreth</i>	414
Patent invalid in part and valid and infringed in part, <i>d Higgin Mfg. Co. v. Watson et al.</i>	403
Constructive reduction to practice, process clearly disclosed in application for apparatus, <i>Bethke v. Scannell</i>	11
Copending applications, two patents granted same inventor, later application covering improvement on earlier application not prior art, though earlier issued, <i>d Higgin Mfg. Co. v. Watson et al.</i>	403
Corporation, suits for infringement, ratification of acts and statements of representative of unincorporated predecessor, <i>d Wolf, Sayer & Heller, Inc. v. United States Slicing Mach. Co.</i>	301
Court of Appeals of the District of Columbia, question of originality, concurrent decisions of tribunals of the Patent Office will be followed unless manifest error is shown, <i>* Hopkins v. Riegger</i>	126

D.

Date of filing, sole application of one of two parties who filed joint application by mistake entitled to date of original, sole application being a continuation. <i>* In re Roberts</i>	158
Decision of appellate court, decree of lower court reversed, injunction, accounting granted, time for filing disclaimer given conditioned on abandonment of invalid claims, <i>d Higgin Mfg. Co. v. Watson et al.</i>	403
Dedication to the public, not the result of act of March 3, 1883, invention can be used only in work for the Federal Government, † Opinion of the Attorney General.....	92

	Page.
Delay of more than two years in filing reissue application to broaden claim unreasonable. * In re Schneider.....	121
Designs, infringement test, whether from the identity of appearance the impression produced is apt to deceive purchaser, ⁴ Geo. Borgfeldt & Co. et al. v. Weiss.....	389
Patent entitles holder to equivalents respecting unessential details, ⁴ Id.....	389
Diligence, test in considering experiments made not whether they benefit public, but whether made in good faith, * Gammeter v. Backdahl.....	209
Divisional application, invention disclosed but not claimed in original application, afterwards claimed in another application, original application constructive reduction to practice, filing date and priority of rights given to later application, ** Chapman and Chapman v. Wintroath.....	405
Double patenting, claims covering invention same as those covering patent granted on divisional application not patentable. Ex parte Wigginton.....	67
Division required between claims not patentably different, no basis for waiving patentable identity, even though Examiner failed to state opinion. Id.....	67
Patent granted for product not bar to same inventor of patent for process new in the art. * In re Zenk.....	215
Question whether claims in application patentable over patent granted same inventor not one of priority. Ex parte Wigginton.....	67

E.

Earlier issued patent prior art, though later patentee carried invention back of issue date but subsequent to filing date, ⁴ Higgin Mfg. Co. v. Watson et al.....	403
Equivalents, substitution of, ⁴ Id.....	403
Estoppel, pending application disclosing an invention not claimed, patent granted on application filed by another, divisional application for such invention may be filed within two years after such patent and claims copied for interference, ** Chapman and Chapman v. Wintroath.....	465
Right to make claims, * Wells and Hunter v. Honigmann.....	242
Evidence conflicting, circumstances and actions to be considered, * Braun v. Wiegand.....	141
Taken in prior interference not admissible in pending interference for the purpose of impeachment unless proper foundation laid, Moyer v. Anglada.....	86
Expert testimony, determination of necessity rests with court, decision not reviewable except in clear cases, ⁴ Kohn v. Elmer et al.....	431

F.

Final fee, payment delayed more than six months by reason of failure to receive notice, application forfeited, notice having been mailed. Ex parte Lacey.....	83
Financial inability, not proven when applicant, with no dependents, employed most of the time, could buy a motorcycle and pay for it in monthly installments, * Duncan v. Shelly.....	155
Foreign patents, British and French, to defeat United States patent must be enrolled before the invention or two years before application, ¹ Barber v. Otis Motor Sales Co.....	106

I.

	Page
Improvement adapted, change made only substitution of material, not invention, <i>d</i> Minneapolis Knitting Works v. Marshall Field & Co.-----	380
Infringement, by corporation, president and general manager not individually liable for damages in official capacity, <i>d</i> D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.-----	246
Knowledge and consent mere parole license, revocable by bringing of suits for infringement, <i>d</i> Wolf, Sayer & Heller, Inc., v. United States Slicing Mach. Co.-----	301
Not avoided by better device unless because of additional function, mode of operation, or change in character, <i>d</i> Smith Cannery Machines Co. v. Seattle-Astoria Iron Works et al.-----	296
What constitutes, <i>d</i> Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.-----	259
Injunction, error to refuse where validity of patent sustained by prior adjudication and infringement clear, <i>d</i> Imperial Machine & Foundry Corporation v. G. S. Blakeslee & Co.-----	368
Interference, abandonment of application by winning party, evidence must show actual completion of invention to bar patent to losing party, Nash v. Reeder v. Ryan.-----	72
Application insufficiently describing machine, refers to earlier application, disclosures taken together enable construction of machine, objection to later application not sustained, Kitselman v. Reid, Reid, and Kelley.-----	26
Application and patent, question of originality, application filed long after patent was granted and device in commercial use, applicant must establish beyond doubt that he was first to conceive, <i>*</i> Braun v. Wiegand.-----	141
Claim not patentably different from issue in prior interference, principle of res adjudicata not applicable, Reid, Reid, and Kelley v. Kitselman.-----	28
Claim not to be limited to suit special conditions, <i>*</i> Seymour v. Molyneux.-----	183
Counts must be construed by disclosure of party first to make claim, <i>*</i> Id.-----	183
Court of Appeals of the District of Columbia, without jurisdiction to review Commissioner's ruling as to public use, <i>*</i> Cowles v. Rody.-----	117
Error not having been discovered, concurrent decisions of the Patent Office, <i>*</i> Brown v. Tomlinson.-----	178
Evidence at former trial of party to proceedings not called to testify admissible as an admission on his part, Moyer v. Anglada.-----	86
Evidence insufficient to establish junior party as first inventor, <i>*</i> Bader v. Burroughs.-----	114
Inadvertently granted patent during pendency of joint application filed by patentee and another, burden of proof heavily on patentee, <i>*</i> Lambert v. Hope and Lambert.-----	237
Inventor refusing to sign preliminary statement, assignee conducting interference not calling him as witness, presumption that inventor would not support claims, <i>*</i> Marie E. Scheuerle, administratrix v. Conner.-----	123

Interference—Continued.

	Page.
Judgment in favor of senior party, reversed on appeal, affidavit showing inoperativeness, and remanded for trial on merits, * Lee and Hogan, Jr., v. Vreeland.....	145
Name in three patents same as applicant's, attorneys same, applicant testifies one patent specifically refers to another taken out by him, considered as all filed by same person, although patents not introduced in evidence, Grus, Jr., v. Eynon.....	49
One contestant disclosing to the other nothing more than result to be accomplished, burden of proof on junior party, * Pembroke v. Sulzer.....	218
Party no right to make claim in prior interference, reopening refused four years later to include earlier application furnishing basis for claim, barred by doctrine of res judicata. * In re Dement.....	170
Priority awarded on certain construction of indefinite claim, winning party required to make definite, Reid, and Kelley v. Kitzelman.....	28
Priority awarded to first to conceive and reduce to practice, losing party can not contend third party was prior inventor, * Erben v. Yardley.....	220
Priority of invention, three parties' evidence shows acquiescence on part of two to claim of third; also fails to overcome burden of proof on junior applicants; * Engle v. Manchester and Spooner; Engle v. Manchester.....	130
Question of originality on appeal, Commissioner's refusal of motion to reopen case to take further proof error, * Bruckman v. Miller.....	224
Reopening not warranted, though decision of the Commissioner, whose ruling was followed, was reversed by Supreme Court. Ex parte Wright.....	14
Reopening to permit filing of preliminary statement, Collins v. Owens.....	76
Right to make claims—	
Shenk and Holman v. Clark.....	16
* Day v. Bower.....	174
* Doyle and Hedley v. Tomlinson.....	179

Invention:

Analogous use only not invention. Ex parte Moolten.....	63
Application of old idea to new machine. Ex parte Smith.....	2
Association of parts from two prior patents accomplishing same results in same way not invention, merely mechanical skill. Ex parte Moore and Pack.....	21
Attributes of, stated, ⁴ A. Kimball Co. v. Noesting Pin Ticket Co.....	394
Combination of old elements without new results not invention. * In re Moore and Pack.....	182
Evidence of, must be more than converting failure into success. Ex parte Schneider.....	25
Measure of, must be pointed out definitely in claims, ⁴ Knight Soda Fountain Co. v. Walrus Mfg. Co.....	254
Mechanical skill becomes invention where mechanic uses insight or foresight to do new things in a new way, ⁴ A. Kimball Co. v. Noesting Pin Ticket Co.....	394
Merely extending operating parts of switch outside of inclosing casing not invention. Ex parte Simon.....	59
Method and product separable inventions, supporting separate patents, ⁴ Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.....	259

Invention—Continued.	Page.
Modification of certain parts, making them reversible, not invention. Ex parte Smith-----	5
Modification of construction without advance in the art not invention. Ex parte Kuhn and Shailor-----	58
Not involved in alleged new relation of printing press and paper web. Ex parte Barber-----	23
Not involved in the specific application of ventilating fans, improvement only analogous use, ^d De Vry Corporation v. Acme Motion Picture Projector Co.-----	440
Presumption of novelty from public use of product of patented machine to be given product, not to machine, ^d Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.-----	259
Something more than bringing together old devices, each working its own effect, producing nothing new. * In re Smith-----	125
Substitution for means employed by earlier patentee of means employed in analogous art not invention, ^d J. H. Day Co. v. Mountain City Mill Co. et al.-----	421
Substitution of equivalents not invention. Ex parte Teale-----	45
Test in assembly of old elements, whether new result produced is in patentable sense, ^d Concrete Appliances Co. et al. v. Meinken et al.-----	378
Test whether the achievement has given the world something of value it did not have, ^d H. D. Smith & Co. v. Peck, Stow & Wilcox Co.-----	373

J.

Joint applicants; two applicants file, and while application is pending one applicant admits having taken no part in inventive act, but was joined in application by mistake, sole application filed by the other is entitled to date of filing of original. In re Roberts-----	158
---	-----

L.

Laches, patents infringed, owner notifies infringer suit will be brought, none was brought for seven years, though infringement continued, acquiescence being practically parole license recovery can be had only for damage accruing after declaration of suit, ^d Wolf, Sayer & Heller, Inc., v. United States Slicing Mach. Co.-----	301
Licensee from unauthorized party not estopped to dispute validity of patent, ^d Kohn v. Elmer et al.-----	431
Limitation of claims, defining form, material, and location, importing substantial function, forms excluded not to be considered as equivalents, ^d D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.-----	246
May be by reference to the specification, ^d Bisight Co. et al. v. One-piece Bifocal Lens Co.-----	257

M.

Mechanical equivalents, protection against use of in combinations under same rule as other patents, ^d Smith Cannery Machines Co. v. Seattle-Astoria Iron Works et al.-----	296
Monopoly can not be prolonged by pioneer patentee subsequently patenting one feature of device, because of broad construction granted originally, ^b Van Kannel Revolving Door Co. v. Winton Hotel Co.-----	99

N.

	Page.
New matter, devices brought into use after filing not to be covered into application by amendment when not shown in original disclosure. <i>Ex parte Smith</i>	2
New use, not anticipated, adaptability described in claims and specifications, description sufficient, <i>d</i> D'Arcy Spring Co. et al. <i>v.</i> Marshall Ventilated Mattress Co.....	246
Novelty not to be asserted for device already described in foreign publications even if unknown in this country, <i>** Bone v. Commissioners of Marion County</i>	457

O.

Operative device not invalidated by non-user, nor can patent be appropriated as basis for improvement, though improvement is patented, without infringement, <i>d</i> Reed <i>v.</i> Hughes Tool Co.....	288
--	-----

P.

Particular patents, Beidler, No. 1,057,397, "photographing and developing apparatus," void for lack of sufficient disclosure, <i>* Beidler v. The United States</i>	483
Bellows, No. 693,218, "Steel car," certain claims void, <i>d</i> Bellows and Slack <i>v.</i> New York Central Railroad Company; Same <i>v.</i> Pressed Steel Car Company.....	362
Same, Nos. 762,796 and 762,858, "metal car-sills," certain claims void for lack of invention. <i>d</i> Id.....	356
Brinkman, No. 843,864, "radiator for motor-cars," valid and infringed, <i>d</i> Whitlock Coil Pipe Co. <i>v.</i> Mayo Radiator Co.....	447
Bone, No. 705,732, "retaining-wall," not infringed, <i>** Bone v. Commissioners of Marion County</i>	457
Burchenal, No. 1,135,351, "lardlike food product," void in view of state of the art. <i>** Berlin Mills Company v. Procter & Gamble Company</i>	496
Callahan, No. 948,719, "apparatus for distributing wet concrete," valid and not anticipated, <i>d</i> Concrete Appliance Co. et al. <i>v.</i> Meinken et al.....	378
Collis, No. 1,204,945, "process of drying and shaping hostery articles," void as covering nothing more than mere function of machine, <i>d</i> Paramount Hostery Form Drying Co. <i>v.</i> Moorhead Knitting Co....	268
Connor, No. 836,486, "bifocal lens," claim 1, limited by reference to specification, not invalid because too broad, infringed, and not anticipated, <i>d</i> Bisight Co. et al. <i>v.</i> Onepiece Bifocal Lens Co.....	257
Dunn, No. 918,980, "paving-brick," valid and infringed, <i>d</i> Dunn Wire-Cut Lug Brick Co. <i>v.</i> Toronto Fire Clay Co. et al.....	259
Faries, No. 779,271, "jar and dipper," claim 3 not infringed, claims 4 and 5 invalid for indefiniteness, <i>d</i> Knight Soda Fountain Co. <i>v.</i> Walrus Mfg. Co.....	254
Griffin, No. 1,195,209, "rotary well-boring drill," not anticipated, valid, and infringed, <i>d</i> Reed <i>v.</i> Hughes Tool Co.....	288
Henderson, No. 959,008, "scaffold-supporting means," void for want of invention, <i>** New York Scaffolding Company v. Liebel-Binney Construction Company</i>	487
<i>** New York Scaffolding Company v. Chain Belt Company and Whitney</i>	492

Particular patents—Continued.

	Page.
Higginson and Arundel, No. 1,067,814, and Jay, Nos. 1,132,273 and 1,134,457, "vacuum suction device for automobiles," anticipated, ^d Jay et al. v. Weinberg et al.-----	402
Hughes, No. 1,124,241, "rotary well-boring drill," not anticipated, valid, and infringed, ^d Reed v. Hughes Tool Co.-----	288
Jennison, No. 1,061,296, "wooden pavement," void for want of invention, ^d Jennison-Wright Co. v. Hempy-----	444
Knudsen, No. 1,221,190, "brace to strengthen radius-rods," void for want of invention, ^d Walker Mfg. Co. et al. v. Illinois Brass Mfg. Co.-----	442
Kohn, No. 983,291, "electric furnace," void for anticipation and want of invention, ^d Kohn v. Eimer et al.-----	481
Marshall, No. 685,160, "mattress," valid, showing invention, limited as to form, not infringed, ^d D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.-----	246
Nathan, No. 873,775, "innersole for shoes," void for want of invention, ^d Nathan Ankle Support Co., Inc., et al. v. Cammeyer, Inc.-----	427
Niesz, No. 13,163 (reissue), new and patentable combination, ^d Ohio Rake Co. v. Bucher & Gibbs Plow Co.-----	451
Ovenshire, No. 800,237, "infant's band" or shirt, void, ^d Minneapolis Knitting Works v. Marshall Field & Co.-----	360
Pfeffer, design No. 51,559, "doll," valid and infringed, ^d Geo. Borgfeldt & Co. et al. v. Weiss-----	389
Robinson, No. 809,582, "vegetable-peeling machine," infringed, ^d Imperial Machine & Foundry Corporation v. G. S. Blakeslee & Co.-----	368
Rodman, No. 1,076,453, "method of making case-hardening material," claim 10 incomplete and vague, omitting reference to essential element, therefore void, ^d Rodman Chemical Co. v. Deeds Commercial Laboratories-----	292
Same, No. 1,076,453, "method of making case-hardening material," not invalidated by prior use nor anticipated, shows invention and is infringed, ^d Id.-----	292
Rohm, No. 886,411, "process for bating hides," void for failure to disclose invention, ^d Rohm et al. v. Martin Dennis Co.-----	349
Schemmel, No. 1,226,600, "finishing-welt," void for lack of invention and anticipation, ^d Backstay Machine & Leather Co. v. Hamilton-----	397
Same, design No. 51,804, "molding or welt," void for lack of invention, ^d Id.-----	397
Smith, No. 948,746, "apparatus for distributing wet concrete," as limited by prior Callahan patent, No. 948,719, void for want of invention, ^d Concrete Appliances Co. et al. v. Meinken et al.-----	378
Same, No. 979,108, "fish-dressing machine," certain claims valid and infringed, ^d Smith Cannery Machines Co. v. Seattle-Astoria Iron Works et al.-----	296
Thompson, No. 1,252,862, "pin-ticket device," valid, ^d A. Kimball Co. v. Noesting Pin Ticket Co.-----	394
Thomson, No. 841,356, "music-sheet guide," fair construction and reasonable range of equivalents given patentable improvement on prior devices, ^d Eolian Co. v. Schubert Piano Co.-----	804
Tufford, No. 1,177,833, "mold for making rubber heels," valid and infringed, ^d I. T. S. Rubber Co. v. Panther Rubber Mfg. Co.-----	283

Particular patents—Continued.

	Page.
Tufford, Reissue No. 14,049, "rubber shoe-heels," claims 5 to 10 valid, infringed, <i>Fetzer & Spies Leather Co. v. I. T. S. Rubber Co.</i> -----	274
Van Berkel, Nos. 806,603 and 895,213, "meat-slicing machine," valid and certain claims in each infringed, <i>Wolf, Sayer & Heller, Inc., v. United States Slicing Mach. Co.</i> -----	301
Vandenburgh, No. 841,741, "reinforcing-bar," limited, not infringed, <i>Vandenburgh v. Electric Welding Co.</i> -----	353
Same, Reissue No. 14,182, "reinforcing-bars," claims 1 and 2 void, not warranted by original patent, <i>Id.</i> -----	353
Van Kannel, Reissue No. 14,255, "revolving door," certain claims invalid as anticipated by earlier patent to same inventor, <i>Van Kannel Revolving Door Co. v. Winton Hotel Co.</i> -----	99
Ward, Design No. 37,213, "screw-driver," void, not ornamental, <i>H. D. Smith & Co. v. Peck, Stow & Wilcox Co.</i> -----	373
Same, No. 737,179, "screw-driver," not anticipated, <i>Id.</i> -----	373
Same, No. 885,461, "improvement in cracker-cutting machines," void for want of invention, <i>J. H. Day Co. v. Mountain City Mill Co. et al.</i> -----	421
Watson, No. 836,475, "rewirable screens," valid in part and infringed in part by the Higgin patent, No. 1,171,952, <i>Higgin Mfg. Co. v. Watson et al.</i> -----	403
Same, No. 956,239, "rewirable screen construction," valid, certain claims not infringed by Higgin patent, No. 1,171,952. <i>Id.</i> -----	403
Patentability. Ex parte Moore and Pack-----	69
* In re Moore and Pack-----	182
Ex parte Teale-----	45
Change readily made not invention. ** New York Scaffolding Company v. Chain Belt Company and Whitney-----	492
Claims construed unpatentable in view of prior art. * In re Stadeker. Combination of two machines effecting new and useful result invention. * In re Sorum-----	190
Construction previously used in repair jobs not invention, <i>Bellows and Slack v. New York Central Railroad Company; Same v. Pressed Steel Car Company.</i> -----	193
Manually-controlled apparatus doing unitary work not an aggregation because involving successive steps, <i>Concrete Appliances Co. et al. v. Meinken et al.</i> -----	362
Mechanical expedient not invention. Ex parte Stadeker-----	378
Must be more than an aggregation of features. * In re Smithey-----	84
Practical result as evidence of. Ex parte Smith-----	198
Substitution of metal for wood not invention, <i>Bellows and Slack v. The New York Central Railroad Company.</i> -----	2
Substitution of old material for material formerly used, without changing result, not invention, <i>G. Reis & Bro., Inc., v. Reform Initial Company, Inc., and Gottschalk and Brasch.</i> -----	356
Patents covering new products give monopoly regardless of variations in methods of making, <i>Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.</i> -----	351
Mode of operation not subject to patent, <i>Mastoras v. Hildreth.</i> -----	260
Patent for inoperative machine not infringed by one that is. <i>Id.</i> -----	414

	Page.
Preliminary statement, amendment carrying date back of proven date of opponent not permitted except to correct unavoidable error, <i>Caps v. Kennicott</i>	6
Amendment not permitted when injury to opponent would be caused, <i>Id.</i>	6
Basis for taking proofs to be relied upon, not mere pleading. <i>Id.</i> ..	6
Priority of invention, award, * <i>Bader v. Burroughs</i>	114
Award—	
* <i>Brown v. McIntosh</i>	199
* <i>Brown v. Tomlinson</i>	178
* <i>Bruckman v. Miller</i>	224
* <i>De Forest v. Richards</i>	175
* <i>Du Rell v. Haley</i>	208
* <i>Gammeter v. Backdahl</i>	209
* <i>Grover and Barber v. Antoine and Travis</i>	180
* <i>Grus, Jr., v. Eynon</i>	213
* <i>Hoenig v. Kendig</i>	241
* <i>Reid, Reid, and Kelley v. Kitselman</i>	192
* <i>Scannell v. Bethke</i>	150
* <i>Scheuerle, Marie E., administratrix, v. Conner</i>	123
* <i>Shenk and Holman v. Clark</i>	178
Action of tribunals of Patent Office not disturbed by court if sustained by evidence, * <i>Kennicott v. Caps</i>	120
Apparatus made on earlier application inoperative, but capable of being made operative by skilled mechanic, * <i>Lee and Hogan, Jr., v. Vreeland</i>	145
Awarded on certain claims with recommendation by Examiners-in-Chief such claims be barred because of prior patents, affirmed, <i>Reid, Reid, and Kelley v. Kitselman</i>	28
Conception of invention, reduction to practice, and diligence prior to entrance in field of opponent shown by evidence, <i>Bethke v. Scannell</i>	11
Decision of the Commissioner of Patents affirmed:	
* <i>Kitselman v. Reid, Reid, and Kelley</i>	191
* <i>Maremont v. Olson</i>	200
Process patent covering function of apparatus under separate patent <i>Held</i> invalid and void, process being sole purpose of apparatus, ^d <i>Paramount Hosiery Form Drying Co. v. Moorhead Knitting Co.</i>	268
Public-use proceedings, oral <i>inter partes</i> hearing, <i>Abercrombie v. Ringel v. Angier v. Taylor and Hepp</i>	82
Reopening to take further testimony, <i>Abercrombie v. Ringel v. Angier v. Taylor and Hepp</i>	80

R.

Reduction to practice, delay in filing application, <i>Maremont v. Olson</i> ..	44
Delay in testing product not excused on the ground that inventor is Government official, * <i>Reichel v. Dorset</i>	128
Device although increasing cost of manufacture and product not readily salable not ground for holding it inoperative, <i>Kitselman v. Reid, Reid, and Kelley</i>	26

Reduction to practice—Continued.	Page.
Evidence that many machines were made and sold proves reduction in absence of controverting testimony, <i>Antoine and Travis v. Grover and Barber</i>	18
Invention covering important step in the art, legal requirements to be met only by successful test, * <i>Reichel v. Dorset</i>	128
Process carried out with experimental model not reduction to practice, doubt existing as to commercial practical working, <i>Haley v. Du Reil</i>	53
<i>Quære</i> : Is it necessary in a certain process case to test the product, * <i>Dickinson v. Swinehart</i>	151
Reasonable diligence under the circumstances only, required, neither concentration of all energies, nor uninterrupted effort necessary, * <i>Id.</i>	151
Simple device, test unnecessary. * <i>Hoenig v. Parker</i>	234
Reissue, delay in filing, nine months not unreasonable, no intervening rights having arisen. <i>Fetzer & Spies Leather Co. v. I. T. S. Rubber Co.</i>	274
Disclosure same as original, new claims making clearer, but not departing from it, slight variations immaterial. <i>Id.</i>	274
Inadequate protection not sufficient excuse for application to broaden claims filed after unreasonable time. * <i>In re Schneider</i>	121
Long delay in filing application evidence of abandonment, fair to presume intervening rights. * <i>Id.</i>	121
Rejection of claims, acquiescence in, immaterial when claim issued does not include defendant's device, <i>Jennison-Wright Co. v. Hempy</i>	444
Renewal of application entitled to benefit of date of original, notwithstanding patent granted another during forfeiture, * <i>Wells and Hunter v. Honigmann</i>	242
Rules of the Court of Appeals District of Columbia, brief not filed in time (Rule 8, sec. 4) motion to dismiss appeal, * <i>Wegner v. Bobblitt</i>	164

S.

Scope of patent, determination by the court may include consideration of mode of operation and beneficial results not stated by patentee, <i>I. T. S. Rubber Co. v. Panther Rubber Mfg. Co.</i>	283
Specifications, not necessary to specifically point out all inaccuracies of English construction. <i>Ex parte Humphrys</i>	70
Substitute claims, petition for rehearing, refused by Commissioner, not to be considered by the court in appeal already perfected. * <i>In re Smith</i>	140
Suits for infringement, answer alleging prior patents, publications including specific patent, sufficiently pleaded as anticipation, <i>Higgin Mfg. Co. v. Watson et al.</i>	403
Corporation, president and general manager in active control may be made defendant and personally responsible, <i>D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.</i>	246
Damages not recoverable for time when owner of patents acquiesced in infringement, but may be from time of bringing suits for infringement, <i>Wolf, Sayer & Heller, Inc., v. United States Slicing Mach. Co.</i>	301
Evidence may be introduced by defendants after an interlocutory decree on payment of expenses of another trial, <i>Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.</i>	259

Suits for infringement—Continued.

	Page.
Findings of anticipation and priority of invention not inconsistent, <i>J. H. Day Co. v. Mountain City Mill Co. et al.</i> -----	421
Notice of defense of prior invention not insufficient, although in- ventor's address omitted. <i>Id.</i> -----	421
On appeal from interlocutory order, motion for final decision before determination of appeal denied, held such denial proper, <i>** Mec-</i> <i>cano Limited v. John Wanamaker, New York</i> -----	478
Party conducting defense for defendant not required to become party of record, but is bound by and entitled to benefit of judgment, <i>* Van Kannel Revolving Door Co. v. Winton Hotel Co.</i> -----	99
Though the defendant's goods had been on market appellant not barred by laches from bringing suit, <i>*Eolian Co. v. Schubert</i> <i>Piano Co.</i> -----	304

T.

Term "mechanical equivalents" to be given broad and generous inter- pretation where a marked advance has been made in the art, <i>*Smith</i> <i>Cannery Machines Co. v. Seattle-Astoria Iron Works et al.</i> -----	296
Terminology, "air-draft." Ex parte Teale-----	45
Trade-marks, alcoholic cereal beverage and near-beer beverage goods of the same descriptive properties, <i>* Christo Manufacturing Company v.</i> <i>The Christian Moerlein Brewing Company</i> -----	189
Cereal breakfast foods and candy not same class of merchandise, <i>* Paul F. Belch Company v. Kellogg Toasted Corn Flakes Company.</i>	119
Certain phrase construed and held registrable if accompanied by proper disclaimer, <i>* Beckwith v. Commissioner of Patents</i> -----	471
Certain words and phrases defined, <i>* Hercules Powder Company v.</i> <i>Newton, Commissioner of Patents</i> -----	340
Class of goods, beer and nonalcoholic cereal beverages of same de- scriptive properties, <i>Popel-Giller Co. (Inc.) v. Berghoff Brewing</i> <i>Assn.</i> -----	84
Composite marks, registration not prohibited, though descriptive words may form a part, requirement to remove such words im- proper, <i>* Beckwith v. Commissioner of Patents</i> -----	471
Construction of trade-mark statistics, act of March 19, 1920, ° Opinion of the Solicitor of the Department of the Interior-----	89
<i>* Hercules Powder Company v. Newton, Commissioner of Patents.</i> Section 5, trade-mark act, 1905. <i>* In re United States Rubber</i> <i>Company</i> -----	199
Descriptive mark not registrable, disclaimer of integral part of mark not permissible. <i>* In re Scholl Manufacturing Company (Inc.)</i> ---	206
Disclaimers, practice of allowing, though no provision in the statute, approved by court, in view of statement by Commissioner, <i>* Beck-</i> <i>with v. Commissioner of Patents</i> -----	471
Evidence of interstate use insufficient, denial of request to take fur- ther testimony to prove such use error, <i>* H. Kuhn & Sons (Inc.)</i> <i>v. Letts</i> -----	232
Exclusive use of terms merely descriptive or geographical, ten years not expiring until after passage of act of 1905, no property rights acquired, <i>* Hercules Powder Company v. Newton, Commissioner of</i> <i>Patents</i> -----	340
Fees paid on applications filed under act of February 20, 1905, trans- ferable to applications filed under act of March 19, 1920, ° Opinion of the Solicitor of the Department of the Interior-----	89

Trade-marks—Continued.

	Page.
Identity of mark tested not by meaning of the words but by the sound and appearance, * William Waltke & Company v. Geo. H. Schafer & Company	167
Interstate use, evidence of prerequisite to registration, * H. Kuhn & Sons (Inc.) v. Letts	232
Not made registrable by being written in a foreign language. * In re Maclin-Zimmer-McGill Tobacco Company, Incorporated	133
Nothing which others may use for the same purpose with equal truth and right can be a valid trade-mark, * Hercules Powder Company v. Newton, Commissioner of Patents	340
Opposition proceedings, showing only confusion or mistake by public necessary, establishment of damages not required, * William Waltke & Company v. Geo. H. Schafer & Company	167
Origin of mark no bearing on question of identity with another mark, * The Procter and Gamble Company v. Eney Shortening Company	239
Priority of adoption and use, evidence sufficient to prove, * The R. M. Hollingshead Co. v. Area Manufacturing Co.	154
Property rights established by use, not by mere adoption, mark must be applied to some vendible commodity and put upon the market, * Phillips v. Hudnut and Mack	164
Property rights recognized or created by 10 years' exclusive use doubtful or nonexistent prior to act of 1905, * Hercules Powder Company v. Newton, Commissioner of Patents	340
Public insignia, "U. S." refused registration, meaning too clearly established. * In re United States Rubber Company	199
Registrable mark not defined by act of 1905, though certain rules are laid down by which descriptive and geographical terms are barred, * Hercules Powder Company v. Newton, Commissioner of Patents	340
Registration denied, Commissioner's refusal of application to strike out descriptive word erroneous. * In re Stephens-Adamson Manufacturing Company	147
Registration, question of descriptiveness purely legal, * Beckwith v. Commissioner of Patents	471
Refused, continued use not prevented, but benefits of statute withheld. * Id.	471
Right to register doubtful by reason of previously acquired rights, decision should be against the later comer, who had an unlimited field from which to select, and has therefore no excuse for encroaching upon prior rights, * William Waltke & Company v. Geo. H. Schafer & Company	167
Soap and shaving cream goods of same descriptive properties. * Id.	167
Suit under section 4915, brought in district in which neither party is resident, jurisdiction exists where defendant consents to suit, * Hercules Powder Company v. Newton, Commissioner of Patents	340
Term, while containing element of descriptiveness, is merely suggestive and registrable. * In re Stephens-Adamson Manufacturing Company	147
The words "Big Chief," with representation of a man on horseback, refused registration on the word "Arab," with similar mark, * American Feed Milling Co. v. M. C. Peters Mill Co.	113

Trade-marks—Continued.

	Page.
The words "El Gallo" (The Rooster), for tobacco, refused registration on the words "Our Rooster" and the picture of a rooster for the same class of goods. * In re Macklin-Zimmer-McGill Tobacco Company, Incorporated	133
"Esco" refused registration on the word "Crisco," for the same goods. * The Procter and Gamble Company v. Eney Shortening Company	239
"Everlasting," for vehicle wheels, refused registration as descriptive term. Ex parte Smith Wheel, Inc.	1
"From the Land of Sunshine," for dried fruits, not deceptively similar to words "Blossom and Sunshine," * L. Otzen & Co. v. The J. K. Armsby Co.	118
"Infallible," for smokeless powder, refused registration as descriptive term, * Hercules Powder Company v. Newton, Commissioner of Patents	340
"Krumbles" and "Golden Crumbles," for candy, sufficiently similar to confuse the public, * Paul F. Beich Company v. Kellogg Toasted Corn Flakes Company	119
"Lava," for soap, not descriptive of properties, * William Waltke & Company v. Geo. H. Schafer & Company	167
"Play-O-Lite," for electric lamps, opposed on the mark "Prest-O-Lite," for gas tanks and storage batteries, * The Prest-O-Lite Company, Inc., v. Play-O-Lite Company, Inc.	231
"Ray-O-Lite," for storage batteries, refused registration on the word "Prest-O-Lite," for same goods, but registrable for electric lamps, * French Battery & Carbon Company v. The Prest-O-Lite Company, Inc.	214
"SafeTseal," for envelopes, refused registration as descriptive mark. * In re Alvah Bushnell Company	112
"U-Lavo," for shaving cream, conflicts with the word "Lava," for toilet soap, * William Waltke & Company v. Geo. H. Schafer & Company	167
"Unit Carrier" refused registration as descriptive term, action reversed by court. * In re Stephens-Adamson Manufacturing Company	147
"White Lily," for coffee, canceled because of similarity of the words "Lily White," * R. H. Macy & Company v. New York Grocery Company	201
Three parties to interference proceedings, priority awarded to one, another appealing not entitled to question award as between the other two, * Phillips v. Hudnut and Mack	164
What constitutes is defined by common law and not by trade-mark statutes, * Id.	164

V.

Validity of patent, prior application for another patent affecting, * Concrete Appliances Co. et al. v. Meinken et al.	378
Sufficiency of disclosure necessary, so public will receive benefit of invention after expiration of patent, ** Beldler v. The United States	483

DECISIONS
OF THE
COMMISSIONER OF PATENTS
FOR
THE YEAR 1920

EX PARTE SMITH WHEEL, INC.

Decided December 19, 1919.

270 O. G., 479.

TRADE-MARKS—"EVERLASTING," FOR VEHICLE-WHEELS—DESCRIPTIVE.

The word "Everlasting" *Held* descriptive, and therefore not registrable as a trade-mark for vehicle-wheels. This word expresses aptly the idea that applicant's wheels will last a very long time, and therefore cannot be monopolized.

ON APPEAL.

TRADE-MARK FOR CAST-METAL WHEELS.

Mr. Howard P. Denison for the applicant.

NEWTON, *Commissioner*:

This is an appeal from a decision of the Examiner of Trade-Marks refusing to register "Everlasting" in what may be termed the ordinary stencil lettering, arranged in the arc of a circle, as a trade-mark for vehicle-wheels, on the ground that the word is descriptive, citing *Patterson-Allen Engineering Company* (118 MS. Dec., 389,) where, in passing on the same word as a trade-mark for valves, it was held that "Everlasting" should be refused registration in view of the *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, (C. D., 1911, 530; 165 O. G., 971; 220 U. S., 446;) *in re Freund Bros. & Co.*, (C. D., 1911, 405; 169 O. G., 206; 37 App. D. C., 109;) *in re Seamless Rubber Co.*, (C. D., 1910, 342; 153 O. G., 547; 34 App. D. C., 357;) *Florence Mfg. Co. v. J. C. Dowd & Co.*, (178 Fed. Rep., 73;) *in re Central Consumers Co.*, (C. D., 1909, 329; 140 O. G., 1211; 32 App.

D. C., 523,) all of which hold words similar in character to "Everlasting" descriptive. Indeed, this same word "Everlasting" had also been previously held descriptive in *Edw. Reilly*, (114 MS. Dec., 830.)

Applicant contends that, inasmuch as "Everlasting" is apparently such an exaggeration as to be absurd, the mark should be registered, since no one would be misled and the word was not necessary to describe any quality or property that others might wish to describe, and cites *Holeproof Hosiery Co. v. Wallach Bros.*, (172 Fed. Rep., 859,) holding "Holeproof," for hosiery, a valid mark; *Aluminum Cooking Utensil Co. v. National Aluminum Works*, (226 Fed. Rep., 815,) upholding "Wearever," for aluminum ware; *New York Mackintosh Co. v. Flam et al.*, (198 Fed. Rep., 571,) upholding "Bestyette," for waterproof capes, etc.

It is undoubtedly true that applicant's wheels are not technically or strictly speaking everlasting, and no one would be led to believe that they were; but "Everlasting" has another meaning—viz., continuing indefinitely (see *Webster's Collegiate Dictionary*, 1902 edition)—and is the only single word I know of that expresses the idea that applicant's wheels last a very long time, and it is useful to advertisers in describing this quality of continuing indefinitely and cannot be monopolized.

The decision of the Examiner of Trade-Marks must accordingly be affirmed.

EX PARTE SMITH.

Decided June 21, 1918.

271 O. G., 155.

1. PATENTABILITY—EVIDENCE OF—PRACTICAL RESULTS.

A patent should not be granted on a flying-machine on the ground that it was the first device built on correct principles where admittedly it was never successfully operated and the only basis for the claim rests upon assumption and an affidavit of one who attempted a flight that it was put out of commission only through lack of skill on his part and not through any inherent defect.

2. SAME—FLYING-MACHINE—APPLICATION OF OLD IDEA TO NEW TYPE OF MACHINE.

Where the prior art taught the necessity of maintaining lateral and longitudinal stability in a flying-machine adapted to fly from the land and showed means for doing it and the prior art also showed flying-machines intended to be launched from the water, it did not involve invention to substitute the means found in the former in a machine of the latter type.

8. APPLICATION—AMENDMENTS—NEW MATTER.

Amendments attempting to cover up practical devices brought into use after the filing of the application held to be without foundation in the original disclosure.

APPEAL from Examiners-in-Chief.

FLYING-MACHINE.

Mr. C. C. Hines for the applicant.

WHITEHEAD, *First Assistant Commissioner*:

This is an appeal from the decision of the Examiners-in-Chief affirming the action of the Primary Examiner rejecting the claims of this application, forty-one in number, of which 1, 6, and 34 are illustrative:

1. The combination with a motor-driven flying machine capable of free and sustained aerial flight, and provided with means for maintaining longitudinal and lateral equilibrium in the air, of means for supporting said machine upon a body of water, said means being operative to adapt the machine to be launched from the water for aerial travel.

6. The combination, with a flying machine, of a hydroplane connected therewith.

34. An aero-hydroplane including an aerial supporting surface, and floating means for supporting the machine on the water having a slightly inclined bottom surface extending well forward of the center of gravity of the machine, whereby the machine is adapted to rock upon said surface in the planing action of the machine upon the water and to ascend and descend from and toward the surface of the water at an angle to the normal line of flight of the machine, and propelling mechanism for driving the machine at such speed as to adapt it to rise from the water and to be propelled in free aerial flight.

The references are: Wright, No. 821,393, May 22, 1906; Wondra, No. 876,125, January 7, 1908; Suter, No. 941,896, November 30, 1909; Gammeter, No. 968,931, August 30, 1910; Forlanini, No. 1,024,067, April 23, 1912; Pressey, No. 1,077,750, November 4, 1913; Dyer, No. 1,108,891, September 1, 1914; Forlanini, No. 1,112,405, September 29, 1914; Curtiss, No. 1,142,754, June 8, 1915; German patent to Kress, No. 8,706; English patent to Roeper, No. 9,390 of 1895; Italian patent to Forlanini, No. 71,869 of 1904; French patent No. 111,574, to Pennaud and Gauchot, delivered April 8, 1876, (unpublished,) a copy of which is to be found in Division 23, Patent Office; *The Aeronautical Journal*, No. 79, Vol. XX, July-September, 1916, published in England.

The Examiner divided the claims into three groups—namely, group 1, containing claims 1 to 5, 28, 39, 40, and 41; group 2, containing claims 6 to 27, 29 to 33, and group 3, containing claims 34 to 38.

The broadest claims are those of the second group, which cover merely the combination of a flying-machine with a hydroplane. The claims in the first group include means for maintaining longitudinal and lateral stability while in the air. The claims of the third group were admittedly drawn to cover the device shown in the patent to Curtiss and contain limitations with reference to the shape of the floats and their location relative to the center of gravity of the machine.

It is contended that the prior art does not show the complete combination set out in any of the claims, since the hydroaeroplanes described in certain of the patents are inoperative; that this application discloses a pioneer invention, the machine disclosed being the first hydroaeroplane designed on correct principles; that the application should therefore be liberally construed and the applicant allowed to amend his specification so as to describe the structure set out in the last group of claims.

It has by no means been established that this is an epoch-making machine. Admittedly it has never been successfully operated. There is an affidavit of record of the man who attempted to fly with it to the effect that the accident that took place at that time was due to lack of skill on his part and not to any inherent defect in the machine.

These statements of course do not establish the fact that the machine was built on correct principles, and there is nothing to show that the work done on this machine has in any way advanced the art or that this applicant taught the world to fly from the water, as the Wrights taught it to fly from the land.

When this application was filed, the Wrights had shown the necessity of maintaining lateral and longitudinal stability and how to maintain it. It is not seen, therefore, that it required invention to use such means in connection with the hydroplane of Dyer or Forlanini. No reorganization was required beyond the mere substitution of the arrangement of supporting-wings, guiding means, and equilibrium devices of the Wrights for the flying means disclosed in those patents.

The broader claims disclose no details of structure not shown in the references and have set forth nothing novel in the mutual arrangement of the substructure and the superstructure.

Claims 34 to 38 include float-surfaces arranged in specified relation to the center of gravity of the machine. There is nothing in the specification with relation to this arrangement and it is certainly not disclosed in the drawing. How far applicant has gone in attempting to cover up the device of the Curtiss patent is shown by the fact that claims 36 and 37 include the "step or projection" fully shown and described in the Curtiss patent, but in no way suggested in this application.

Applicant has submitted certain claims as substitutes for some (it is not stated for which) of the claims of group 2. These claims all contain and lay emphasis on the feature of inclined planing-surfaces for the floats, the function of which is to raise the structure to the surface of the water as the speed is increased, and it is alleged that the floats will tilt under this action and be freer to leave the water when sufficient speed is attained. These features are also set out more or less broadly in claims 33, 39, 40, and 41.

The floats are not so described in the specification, and the only basis to be found, if at all, for these claims is in the drawing. The specification merely describes the floats as air-tight bodies secured to the under side of the frame-bars, the lifting action being ascribed only to the hydroplane 47.

As fully pointed out in the decision of the Examiners-in-Chief, while the floats have inclined ends they are not clearly shown as having flat bottoms, or, if there is any flat portion, how far it extends. The proposed claims describe the floats as "scow-shaped pontoons."

The Forlanini patent shows a boat-shaped float with inclined ends that doubtless have a tendency to rise in the water. Furthermore, catamarans with scowl-like bows were known prior to applicant's invention, (see the patent to Hewitt, No. 1,088,226, February 24, 1914, application filed October 21, 1905,) and the purpose of such construction was the same as that claimed for the construction alleged to be shown in this application—namely, to raise the floating structure and to reduce friction and resistance.

The drawing does not so clearly show the construction now claimed as to justify the proposed amendment to the specification or the allowance of the claims.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE SMITH.

Decided October 4, 1918.

271 O. G., 156.

PATENTABILITY—INVENTION—MAKING PARTS SYMMETRICAL FOR REVERSAL.

The modification of a fluid-motor piston shown in one patent, which consisted in making certain parts symmetrical, so that it could be reversed, *Held* to be without invention in view of another patent which showed this feature.

APPEAL from Examiners-in-Chief.

MOTOR.

Mr. B. G. Foster for the applicant.

NEWTON, *Commissioner*:

This is an appeal from the decision of the Examiners-in-Chief affirming the action of the Primary Examiner in the final rejection of claims 1 to 5, of which claims 1 and 4 are examples:

1. In a motor of the character set forth, the combination with a cylinder member having a head chamber and opposite neck chambers extending therefrom, of a piston in the cylinder member, comprising a head operating in the

head chamber and oppositely extending necks operating in the said neck chambers, said piston being reversible to permit either neck to operate in either neck chamber, means for supplying motive fluid alternately to opposite sides of the piston head, and means for permitting a portion of such motive fluid supplied to one side of the head to pass into one of the neck chambers behind the neck therein.

4. In a motor of the character set forth, the combination with a cylinder member having a head chamber and opposite neck chambers extending therefrom, of a piston in the cylinder member, comprising a head operating in the head chamber, necks operating in the opposite neck chambers, said piston being reversible to permit either neck to operate in either neck chamber, and means for supplying motive fluid alternately to opposite sides of the piston head, said means being controlled by the piston necks.

The references are: Joy, No. 80,550, August 4, 1868; Walker, No. 1,114,075, October 20 1914.

The appealed claims cover a fluid-motor specially adapted for operating a pneumatic hammer. Of course it is desirable in such motors to have as few members to wear out and get out of order as possible. Hence applicant's motor is of the valveless type and additionally is adapted to drive the hammer by a quick forward blow and a slow backward stroke, and the piston in the cylinder member being subjected to hard wear is made reversible, so that when one end is worn out it can be turned end for end.

As pointed out by the Examiners-in-Chief, the Joy patent, particularly Figure 8, shows applicant's arrangement of passages and the control thereof by the piston-neck. It is true the piston is shown as an integral part of the rock-drill; but to make the opposite necks symmetrical with respect to the piston, so that it can be reversed, would not involve invention in view of Wakfer, which shows exactly this structure. Nor is the provision of means for permitting a portion of the motor fluid supplied to one side of the head to pass into one of the neck-chambers behind the neck thereof patentable in view of Wakfer's channels 16 and 17, which, while not described as performing this function, would undoubtedly perform it.

For reasons more fully set forth in the decision of the Examiners-in-Chief it is held that their decision refusing the claims was correct, and it is affirmed.

CAPS v. KENNICOTT.

Decided May 14, 1918.

271 O. G., 359.

1. INTERFERENCE—PRELIMINARY STATEMENT—AMENDMENT.

A party to an interference will not be allowed, in order to correct an alleged error in his preliminary statement, to amend such statement to carry his date of conception and disclosure back of the dates proved by his rival, after such proofs are in, unless the utmost care would apparently have failed to avoid the alleged error.

2. SAME—SAME—SAME—EXCUSE INSUFFICIENT.

Where a preliminary statement is made upon one understanding of the issue, an amendment thereof which would result in distinct injury to a rival will not be permitted because of another understanding of the issue suggested by other parties.

3. SAME—SAME—NATURE OF PRELIMINARY STATEMENT.

A preliminary statement is not a mere pleading. It is the basis for taking proofs upon which opposing parties have a right to rely.

APPEAL from Examiners-in-Chief.

WATER-SOFTENING APPARATUS.

Mr. Rudolph W. Lutz and Messrs. Bacon & Milans for Caps.

Messrs. Dyrenforth, Lee, Chritton & Wiles for Kennicott.

CLAY, *Assistant Commissioner:*

Kennicott appeals from the affirmance by the Examiners-in-Chief of an award of priority of invention to the junior party, Caps, on an issue defined as follows:

In a water-softening apparatus, a reagent drum, means for passing water to be softened through the reagent in said drum, a water meter for measuring the water flowing through the said drum, a valve for shutting off the flow of water through the drum, and means operable by said meter for actuating the said valve.

The Examiner of Interferences refused Kennicott's motion to amend his preliminary statement, and, taking the case on the basis of Kennicott's original statement, held that Caps was the first to conceive and was diligent from a time before Kennicott entered the field. The Examiners-in-Chief, after a critical examination of the testimony, affirmed and also approved the refusal to allow amendment to the preliminary statement.

The invention in controversy is an automatic shifting device for a certain valve in a water-purifying apparatus. The water flowing through a treatment vessel is measured as it flows out, and, upon the passage of a given adjusted amount of water through the meter, the meter operates to shift the inlet-valve and stop flow through the vessel. Incidentally and in the particular operation of the apparatus of both parties there is an alternate use of two treatment vessels, the inflow being shifted to first one and then the other. The Kennicott disclosure is the simpler and involves little besides the invention for automatically shifting the feed-valve from one vessel to another when the meter at the outlet registers the proper amount. It operates by an electric device to move the valve. The apparatus of Caps, it should be noted, is more complicated and involves much besides the specific invention in issue, although the extra matter is intimately associated with the invention in issue. His is an apparatus which would require much time and thought to design and would not

be a completed apparatus for practical use without the various parts. Kennicott was the first to file. Neither party actually reduced to practice. Whether there be any indefiniteness in Caps's proofs otherwise, it is at least clear to me that he conceived and disclosed the invention here in issue prior to December, 1915, when Kennicott originally alleged conception and shows disclosure. It is also clear, I think, that Caps was diligent at the time his rival entered the field and must prevail unless Kennicott can show an earlier conception.

Kennicott sought to amend his preliminary statement and prove conception in 1914, prior to the conception alleged by Caps. His main argument is in favor of this attempted amendment. His proposition that if the proofs clearly showed the senior party to be the first inventor he should be allowed to amend his statement unless under some extraordinary condition might be admitted; but not only do the proofs fail to so show, but the effect of amendment would be to entirely change the whole case and distinctly injure his rival. The preliminary statement cannot be considered a mere pleading. As originally filed it gave Caps the right to make certain presumptions in taking his proofs. He assumed and had right to assume that it was necessary only to show disclosure before December, 1915, and diligence thereafter. He need not have mentioned anything he did prior to that time. When Caps took his proofs, in view of Kennicott's statement it is quite possible that he omitted or neglected items of proof which he had not been apprised were necessary by the statement of his rival. There must always be a mutual understanding as to the issue before taking proofs, and this is particularly true here, because the matter of conception and proof of conception is generally known only to the inventor and is a very difficult matter to prove. Kennicott could not be allowed to state his case differently after his rival's proofs had been taken unless the utmost care would apparently have failed to avoid the alleged error. (*Henderson v. Noakes*, C. D., 1892, 114; 59 O. G., 1431.)

Kennicott seems to have made his original preliminary statement upon one understanding of the issue and to seek now to amend it on another understanding of the issue suggested by other parties. This is evidence of negligence rather than otherwise.

I am not satisfied either that Kennicott's proofs would sustain him if he did amend his statement as proposed nor that he has any sufficient excuse for having omitted to make the statement right in the first place. I agree with the view of the proofs taken by the Examiners-in-Chief. Whatever was incomplete in Caps's drawing of the blue-print in April, 1916, it was not the essential invention of the valve shifted by the outflow-meter. The disclosure of that invention was made in the previous year to Cross (Q. 22) and to Fee, (Q. 14,) who could understand it from his rough sketches, even if some of the

details of the apparatus were omitted. The invention is broad—not confined to details. He explained an obviously-operable means which could have been built by a skilled mechanic from the information he then gave. He should not be defeated because he took time to work out further useful details. He was diligent enough under the circumstances. The tangible result in the contract with the McCoy Laundry in March, 1916, was about contemporaneous with Kennicott's application, which was the only practical and effective step taken by Kennicott before Caps filed.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE SCHNEIDER.

Decided June 18, 1918.

271 O. G., 360.

REISSUE—BROADENED CLAIMS—DELAY IN FILING.

Broadened claims in a reissue application *Held* properly refused where the application was filed two years and eight months after the issuance of the patent and the only explanation given by the patentee was that he had no occasion to review the patent from its date of issue until shortly before the application for reissue was filed and that the insufficiencies of the original specification and claims came to his attention through others and that he did not delay after he had knowledge of those insufficiencies.

APPEAL from Examiners-in-Chief.

GEARING.

Messrs. Fay, Oberlin & Fay for the applicant.

NEWTON, *Commissioner*:

This is an appeal from the decision of the Examiners-in-Chief affirming the action of the Primary Examiner refusing this reissue for broadened claims.

The essential facts in this case are that applicant delayed two years and eight months after the issue of his patent to ask for claims admittedly broader than are the claims of the original patent.

Since the decision of the Supreme Court in *Topliff v. Topliff et al.* (C. D., 1892, 402; 59 O. G., 1257; 145 U. S., 156) it has become settled law that a reissue applied for more than two years after the issue of the original patent merely to broaden the claims should not ordinarily be allowed.

Justice Brown in that decision, after a most careful review of the authorities on this point, and particularly the case of *Mahn v. Harwood*, (C. D., 1885, 144, 151; 30 O. G., 657; 112 U. S., 354,) in which the Supreme Court had held void a reissue for broader claims

granted nearly four years after the issue of the original patent and which discusses the reason why a period of more than two years is ordinarily fatal, held as follows:

That due diligence must be exercised in discovering the mistake in the original patent, and that, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.

This decision has been followed in practically all of the recently-decided cases. See, for example, *Felbel v. Aguilar*, (C. D., 1906, 113; 121 O. G., 1012,) which held the delay of three and one-half years fatal; *Rawson et al. v. C. W. Hunt Co.*, (140 Fed. Rep., 716,) holding a delay for two years and three months fatal; *ex parte Tilden*, (C. D., 1912, 265; 182 O. G., 971;) *in re Starkey*, (C. D., 1903, 607; 104 O. G., 2150; 21 App. D. C., 519;) *in re Ams*, (C. D., 1906, 424; 125 O. G., 347, and C. D., 1907, 532; 127 O. G., 3644; 29 App. D. C., 91;) *Milloy Electric Co. v. Thomson-Houston Electric Co.*, (148 Fed. Rep., 843,) and *American, etc., Co. v. Porter*, (232 Fed. Rep., 456, 463.)

It is true that in *in re Heroult* (C. D., 1907, 521; 127 O. G., 3217; 29 App. D. C., 42) there was a delay of slightly more than two years; but the record of that case shows that this matter of delay was never raised and presumably never considered. The point in the case was that Heroult, having originally been granted a patent for an apparatus, should be allowed to reissue and cover a process.

Applicant in his brief seems to have assumed that the Office has taken the position that it would never allow a reissue where there had been a delay of two years; but this is not true. The Supreme Court in *Topliff v. Topliff*, *supra*, only held that the lapse of two years—

will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public.

This necessitates a close scrutiny of applicant's reason for his delay to see if applicant's excuse for delay is "ordinary."

Applicant's reasons for delay are as follows:

Affiant further deposes and says that the original specification and claims of his patent do not cover an important feature of his invention and his patent is therefore narrower than it should be to properly cover the invention.

Affiant further deposes and says that he had no occasion to review his patent from the date of its issue until the present time, and that the insufficiencies in his original specification and claims only came to his attention through others; namely, Mr. Burton W. Sweet, who is employed by him, and his attorneys, Messrs. Fay, Oberlin and Fay, within the past few weeks, and that he did not delay after he had knowledge of the insufficiency of his original patent.

These reasons are not unusual. They are the ordinary reasons for asking a reissue. These are the reasons given by four-fifths of the applicants for reissue—namely, that after receiving their patent they relied on their attorney's skill and there was nothing to call their attention to the limited nature of the claims until some circumstance, like the sale of the patent or a charge of infringement or something of that nature, awakened the patentee to the fact that his patent was unnecessarily limited.

To grant this reissue to broaden the claims after the two years' delay under such circumstances as outlined by applicant in his reissue oath would be to ignore the Supreme Court decisions in *Topliff v. Topliff* and *Mahn v. Harwood*, *supra*.

Applicant at the hearing seemed to rely on the decision of the Supreme Court in *Abercrombie et al. v. Baldwin et al.*, (decided December 10, 1917; C. D., 1918, 829; 246 O. G., 567; 245 U. S., 198;) but that decision rather affirms than modifies *Topliff v. Topliff*, since the pertinent part of the decision turns on whether the original and reissue were substantially the same invention. The arguments in that case were that the reissue should be held invalid under *Topliff v. Topliff* because it broadened the invention; but the Court in effect said the invention was not broadened, their holding being:

In the reissue after the words "comparatively large size" it added "extend the tube which forms the duct downward so that its end will be always embedded in the carbid."

In other words, the tube is explicitly described as extending to and its end embedded in the carbid, and this, it is contended was an enlargement of the original patent.

The contention is untenable if there was in the original patent an implication of such length and termination of the tube, and we think there was.

This decision therefore does not modify *Topliff v. Topliff*. Indeed, the trend of recent decisions is that "intervening rights will be presumed after a delay of two years." (*American, etc., Co. v. Porter*, *supra*.)

I find no error in the decision of the lower tribunal, and it is affirmed.

BETHKE v. SCANNELL.

Decided October 17, 1918.

273 O. G., 185.

1. PATENTS—INTERFERENCE—APPLICATION FOR APPARATUS CONSTRUCTIVE REDUCTION TO PRACTICE OF PROCESS.

An application for an apparatus clearly disclosing a process is a constructive reduction to practice of the process.

2. SAME—SAME—EVIDENCE OF PRIORITY.

Evidence considered and *Held* that B. was the first to conceive the invention in issue and the first to reduce it to practice; also, that he was diligent just prior to S.'s entry into the field and up to the time when he constructively reduced it to practice.

APPEAL from Examiners-in-Chief.

PHOTOGRAPHIC-PLATE HOLDER.

Messrs. Morsell, Keeney & French for Bethke.

Mr. Charles S. Wilson for Scannell.

NEWTON, *Commissioner*:

This is an appeal from the decision of the Examiners-in-Chief affirming the action of the Examiner of Interferences awarding priority to Bethke, the junior party, on the following issue:

The herein described method of placing an inscription upon a sensitive medium, which consists in forming the desired inscription in light obstructing characters upon the surface of a medium provided with an actinic ray emitting coating, and placing said inscription bearing medium adjacent said sensitive medium in position to print the inscription upon said sensitive medium by the action of the emitted rays.

The invention covered by this issue, roughly speaking, is the production of one's autograph on a negative in light lines on a dark surface instead of dark lines on a light surface, as heretofore, so that when the negative is used for printing the final picture will be autographed in dark lines on a light surface, instead of being in light lines on a dark surface. In order to do this, these applicants have painted one side of a glass with luminous paint and left the other side rough and suitable to be marked with a pencil. It appears that luminous paint has the property of acting on a sensitive sheet by reason of the luminous rays that emanate from it, and the luminous paint if exposed to the sunlight will become recharged, as it were, with power to give off these luminous rays, and when periodically exposed to the sunlight will last indefinitely. It is not expensive, so the process in controversy seems to be a practical one.

Bethke filed his application included in this interference December 11, 1916, but it has been held that he disclosed the invention in an application filed May 10, 1915, wherein he claimed the apparatus for carrying out the involved process instead of the process covered by the issue.

Scannell filed March 22, 1915. Bethke is therefore the junior party and must establish his dates by a preponderance of evidence.

Scannell took testimony, but acknowledges (p. 8, Scannell's brief) that he should be restricted to his filing date for conception, disclosure, and reduction to practice.

There is no question but that Bethke has proven conception and disclosure as far back as April, 1914. This case turns, first, on whether Bethke has proven reduction to practice prior to March 22, 1915, Scannell's filing date, or, if not, whether he was diligent from just prior to March 22, 1915, Scannell's filing date, to the filing of his (Bethke's) apparatus case May 10, 1915.

Much has been said about the efficacy of the filing of the apparatus case May 10, 1915, as a constructive reduction to practice for the process of the issue. There is no doubt but that the invention was disclosed in the May 10, 1915, case and that it might have been claimed therein. This being so, there is no doubt but that the May 10, 1915, case is a constructive reduction to practice. There is no reason whatever why it should not be. Indeed, the claim of the issue is somewhat anomalous in that while it is in the form of a process claim it is about as much an article or apparatus claim as it is a method claim, since "an actinic ray emitting coating" is more of a *thing* than it is a process.

The Examiner of Interferences has held that Bethke did not prove reduction to practice prior to his filing date. The Examiners-in-Chief have held that he did prove reduction to practice as of January 1, 1915, and for reasons given by them I concur in their decision holding that Bethke has proven reduction to practice in January, 1915. Indeed, the proof is satisfactory to me that Bethke reduced to practice in July or August, 1914.

Bethke's testimony concerning Exhibits 7 and 11 is quite complete, (Bethke's record, Qs. 90, p. 34, *et. seq.*) but of course he must be corroborated. Pressentin testifies (Bethke's record, Qs. 35 to 52, pp. 154 and 155) that with Exhibit 7 Bethke took his picture, (Exhibit 10,) and it was the only picture that he ever took of him. Pressentin autographed this negative July 1, 1914. He states that the negative was taken with Exhibit 7, that it was in the same condition then as it is now, and that the writing on Exhibit 10 was his own handwriting. Putting these facts together and taking into consideration the circumstances surrounding Pressentin when he was giving his deposition, it is equivalent to saying that the invention of the issue was successfully operated in July, 1914.

Schroeder says (Bethke's record, pp. 112 and 113) in corroboration that Bethke in the beginning of August, 1914, wrote on the rough side of the glass which was painted with luminous paint on the other side and inserted it in the brass container of Exhibit 11. He then went in his dark room, pressed it up against a strip of film, pulled out the cover of this container so that the glass was in contact with the film that exposed it by means of this luminous paint, then slid back this cover and developed the film. This is the process of the issue. Keeping in mind the exhibits that Schroeder was talk-

ing about, it is held that this is a fair statement of reduction to practice, especially when taken in connection with the depositions of Bethke, Pressentin, and Strassman. It is true that Strassman says (Q. 8) that this happened the last two weeks in August, but since this testimony was taken practically three years afterward the discrepancy in time does not discredit the witness.

These witnesses, it is true, all seemed to be friends of Bethke's, but Scannell does not contend that they were untruthful. They appear unskilled as to what comes within the technical rules of reduction to practice, and the depositions must be read in connection with the exhibits they were talking about. There is nothing to indicate that the results they were describing were obtained in any other way than by the process of the issue. Indeed, the indications are all to the contrary, and the results obtained and disclosed in the exhibits were certainly reductions to practice.

It is held that the finding of the Examiners-in-Chief and the Examiner of Interferences, for reasons fully pointed out by both lower tribunals and which will not be further discussed here, was correct, that from just prior to the 22d of March, 1915, Scannell's filing date, to May 10, 1915, Bethke's filing date, Bethke was not lacking in diligence in perfecting his invention.

It is therefore held that there was no error in the decision of the Examiners-in-Chief, and their decision awarding priority to Bethke is affirmed.

EX PARTE WRIGHT.

Decided April 26, 1920.

274 O. G., 405.

INTERFERENCE—REOPENING—CHANGE IN PRACTICE.

Where in an interference involving an applicant and a patentee priority was awarded to the patentee on the ground that under the ruling in *Wintroath v. Chapman* (C. D., 1918, 154; 248 O. G., 1004; 47 App. D. C., 428,) the applicant was estopped to make the claims and no appeal was taken from that decision, *Held* that the fact that the decision in the case cited was subsequently reversed by the Supreme Court does not warrant the reopening of the interference.

ON PETITION.

TELEPHONE-EXCHANGE SYSTEM.

Mr. Joseph L. Wright pro se.

NEWTON, *Commissioner*:

Applicant petitions from the action of the Primary Examiner refusing to enter an amendment seeking to reinsert claims canceled after an adverse decision in an interference.

It appears that applicant copied claims from a Stanton patent more than a year after the patent issued. The Examiner of Interferences awarded priority to Stanton, and his decision was affirmed by the Examiners-in-Chief. Both decisions were based on the ground that applicant was estopped by his delay of more than a year in copying the claims, under the rule laid down in *Rowntree v. Sloan* (C. D., 1916, 192; 227 O. G., 744; 45 App. D. C., 207) and *Wintroath v. Chapman and Chapman* (C. D., 1918, 154; 248 O. G., 1004; 47 App. D. C., 428).

No appeal was taken from the decision of the Examiners-in-Chief, which was rendered March 11, 1919, and thereupon the interference was terminated, and Wright's claims involved in interference were finally rejected April 23, 1919, as provided in Rule 132, and on March 11, 1920, the claims corresponding to the issue of the interference were canceled.

In the amendment and in the petition attention is called to the decision of the Supreme Court of the United States in *Chapman and Chapman v. Wintroath*, (*post*, 465; 272 O. G., 913,) and it is argued that in view of the ruling therein the amendment should be entered and the interference again declared, since the claims were copied from the patent within two years of the issuance thereof.

It is well settled, however, that the reversal of a decision does not warrant the reopening of cases which had been meantime finally disposed of under the authority of the original decision. (*Miller v. Tyler*, 58 N. Y., 477; *Travis County v. King Iron Bridge & Mfg. Co.*, 92 Fed. Rep., 690; *Harburg v. Arnold*, 87 Mo. App., 326.)

In the first of these cases the court said:

By the consent, or, which is the equivalent of a consent, by the default of the appellants and their voluntary act in omitting to oppose the motion, the judgment was modified so as to entitle the plaintiffs to coin at their option, instead of legal tender notes, in payment of the mortgage debt. This was in conformity to the legal rights of the parties, as then well understood, and as they had been adjudicated by the highest court of the nation. The reconsideration of the question by the Supreme Court of the United States, with a result adverse to its first judgment, did not affect the existing judgments of State courts, or call for a modification and change of their records to meet the changed views and judgment of that court. A contrary doctrine would lead to the absurd necessity of correcting and modifying all judgments, whether existing and in force or satisfied and fully executed, upon the enunciation by a court of superior authority of a doctrine in conflict with and legally subversive of the principles upon which they were rendered. If judgments are erroneous they can only be reviewed and reversed or modified by error or appeal in the mode prescribed by law.

The petition is denied.

SHENK AND HOLMAN v. CLARK. .

Decided November 4, 1918.

274 O. G., 405.

PATENTS—INTERFERENCE—RIGHT TO MAKE CLAIM.

The disclosure of Clark considered and *Held* that he has a right to make the count in issue, which was directed to a refractive screen for headlights having a reflector comprising surfaces of variant vertical distributive dispersion and surfaces of variant lateral distributive dispersion.

APPEAL from Examiners-in-Chief.

HEADLIGHTS.

Mr. Ralph H. Holman and Messrs. Spear, Middleton, Donaldson & Spear for Shenk and Holman.

Messrs. Hull, Smith, Brock & West for Clark.

CLAY, *Assistant Commissioner*:

The junior party, Shenk and Holman, jointly appeal from an affirmation of an award of priority to Clark on an issue worded as follows:

A refractive screen for use with a headlight having a reflector comprising surfaces of variant vertical distributive dispersion and surfaces of variant lateral distributive dispersion at and beyond the intercept of the roadway.

The case comes up on a judgment after rule to show cause on the junior party, Shenk and Holman having moved to dissolve on the ground that Clark did not disclose the invention in issue.

The issue is a claim in Patent No. 1,224,421, granted May 1, 1917, to Shenk and Holman inadvertently without interference. In this patent they set forth their purpose to redistribute the beam of light emerging from the automobile-headlight so as to make it strike the roadway uniformly and prevent glare. They use one set of prisms arranged horizontally and one set arranged vertically. Both sets of prisms are intended to distribute the light with varied angularities at different parts of the beam. In their appeal they insist that this claim must be so construed as to be valid in view of the state of the art and that when so construed the Clark construction does not respond to it. They say specifically that—

Clark's depressor prisms are merely different, while Shenk and Holman's are graded and variant.

They say it was not patentable to merely provide some prisms at different angles from some others in order to diffuse the light and that Clark did not have means for a "distributive dispersion."

Clark's application shows a clear understanding of the problem and the difference between this problem and the ordinary functions of lenses. He aims to prevent waste of light above the focal line and throw it below the focal line by producing a beam which is at a maximum intensity at the top and below the horizontal is spread upon the roadway. He uses horizontal prisms for downward refraction and for "lateral spreading" elements he uses ribs or grooves—

or they may be prismatic elements set at a variety of angles so as to give a spread instead of a mere deflection of the beam, (p. 2.)

Farther on he says that the light is to have a graded spread according to its dispersion, (p. 3.) This antithesis is also expressed in the last sentence of his original claim 2.

The appellants insist that in view of the prior art their construction of the claim must prevail, and call attention to an apparent statement in the Saulsbury British patent, No. 28,187 of 1908, which they say meets the claim in issue if construed as the Examiners-in-Chief have construed it. But this British patent says at page 2, line 49, that the prisms have all the same inclination. The claim also specifies this. When, therefore, at page 3, line 22 of the patent, he says the inclination may be varied "at the top and bottom of the lamp and or at the sides" for divergence, he clearly means only a different inclination at the edges, as shown. The invention could not reside in the gradual variation of the prisms, for this is shown in the Macbeth patent, No. 1,189,848, of December 8, 1914. It must reside in the combination of the elements, as Clark says at the bottom of page 3 of his specification. (See also Churchill patent, No. 1,081,210, of December 9, 1913.)

It is true that since the issue of the interference is assumed to be patentable, it should be so read as to describe a patentable construction, but whatever way it is read it describes the invention Clark disclosed on June 11, 1915, six months before it was disclosed by Shenk and Holman. Not only are the surfaces of Clark's prism variant in the sense that one group is thicker or more inclined than another, but they are necessarily variant within the group because of their position with respect to the source of light and the axes of the parabolic reflector behind the source. The claim can not be confined, as Shenk and Holman contend, but even if it were confined it would not fail to find support in the Clark disclosure. The only inventive idea presented is found as well in Clark's as in the appellant's specification.

The decision of the Examiners-in-Chief is affirmed.

ANTOINE AND TRAVIS v. GROVER AND BARBER.*Decided October 24, 1918.*

274 O. G., 839.

1. PATENTS—INTERFERENCE—REDUCTION TO PRACTICE—MACHINES SOLD, BUT NO DIRECT EVIDENCE OF SUCCESSFUL OPERATION.

Where a party to an interference proves the construction of a device embodying the issue and the testimony is to the effect that a large number of machines of the same construction were made and sold prior to the reduction to practice of the opposing party, names and addresses of persons to whom they were shipped being given, *Held* that the testimony proves a prior reduction to practice in the absence of controverting evidence showing that the machines so alleged to have been sold were not reductions to practice.

2. SAME—SAME—ABANDONED EXPERIMENT—SUBSEQUENT CHANGE OF CONSTRUCTION ALONE DOES NOT ESTABLISH.

The making of improved machines after an alleged reduction to practice and after commercial production of such machines is not alone sufficient to discredit the claim of successful operation and warrant a holding that the earlier construction was merely an abandoned experiment.

APPEAL from Examiners-in-Chief.**CHECK-DETECTOR FOR CHECK-ACTUATED MACHINES.**

Mr. J. H. Jochum, Jr., for Antoine and Travis.

Mr. A. Alexander Thomas for Grover and Barber.

NEWTON, Commissioner:

This is an appeal from a decision of the Examiners-in-Chief awarding priority to Antoine and Travis, the junior parties, thus reversing the decision of the Examiner of Interferences, on four counts, of which count 4 is probably the most limited, and which is as follows:

4. In a coin controlled machine, a casing having a coin slot or passage, a coin carrier normally free to rotate in a direction to carry the deposited coin into operative position within the machine, an upwardly extending yieldable member supported at its lower end and provided at its upper or free end with a head projecting normally into said coin slot or passage, whereby said head is adapted to enter the opening of a washer on said coin carrier, said head having a beveled surface and an abrupt surface so arranged that said abrupt surface unyieldingly engages the inner edge of the washer and thereby positively locks said washer and coin carrier against further movement, said beveled surface permitting reverse rotation of the coin carrier for removal of the inserted washer through said coin slot, and a hand-operable member on the front wall of said casing for operating said coin-carrier.

The invention is an improvement in a coin-controlled machine—that is, a machine into which if a coin, usually in this class of machines a nickel or penny, is dropped into a slot and a handle turned it will release a package of chewing-gum or peanuts, etc.

This art has been well worked over by inventors, and the improvements now are in details. The counts are limited, and must be so construed to avoid the prior art.

The novel feature of the invention is in the mechanism for preventing operation of the machine with a slug or washer having a hole in the middle, as such washers are ordinarily made. These parties, however, are not the first to produce such machines. Indeed, Antoine and Travis have a patent, No. 1,043,374, November 5, 1912, and the patent to Davis, No. 753,961, March 8, 1904, shows another form of a very similar coin-controlled device, the main difference being that in both the Davis and Antoine and Travis patents the yieldable member has a button or knob (numbered 33 in Davis's patent and 37 in the Antoine and Travis patent) which is projected into the hole in the slug or washer, thus allowing a projection 28 of the Davis patent and 38 of the Antoine and Travis patent to arrest the coin-disk.

Antoine and Travis found this knob or button wore a groove in the disk, the button being made of hard metal and the disk of soft metal, and it was to obviate this difficulty that the present inventions were designed, the characteristic feature being a spring-actuated lever having a dog or projection at the free end, which contacts with the coin-disk, and if a washer were to be used with a hole in its middle the projection will be projected into the hole and prevent further turning of the disk in a direction to operate the mechanism, the projection having a beveled surface to permit a reverse rotation of the disk to allow the removal of the washer.

It is admitted that Grover and Barber conceived in April, 1912, and reduced to practice in January, 1913. Nothing further need be considered as to their dates.

Antoine and Travis unquestionably conceived in 1911. This case turns on whether Antoine and Travis have proven reduction to practice in the early part of 1912.

The Examiners-in-Chief have held that Antoine and Travis have proven reduction to practice in February, 1912, and awarded priority to them. The Examiner of Interferences has held that the testimony was not sufficient to establish a reduction to practice for Antoine and Travis prior to December, 1913, the date of filing of their application for patent.

The decision of the Examiners-in-Chief and that of the Examiner of Interferences have been carefully considered in connection with the evidence. Little can be said additional to what those two decisions have set forth.

I have concluded to adopt the views of the Examiners-in-Chief for reasons set forth in their decision.

Exhibits A and E are the storm-centers of this contest. Antoine (*Q. 71 et seq.*) testifies that Exhibit A was put on a coin-controlled

vending-machine, tried out in the month of September, 1911, and that the test proved satisfactory. Exhibit A discloses every feature of the invention called for by the counts. It is true that the coin-disk of Exhibit A was not on that exhibit in 1911; but these coin-disks were old and common and had long been used in machines made by Antoine and Travis. Hagan, who made the casing of Exhibit A, sufficiently establishes its construction in October or November, 1911. (Q. 11 *et seq.* and XQ. 42 *et seq.*) Indeed, as I understand this case there is no dispute as to the date when the casing of Exhibit A was made or that the casing, together with the dog, was different from what is now shown in Exhibit A. Antoine (Q. 40 *et seq.*) described Exhibit A as it was at the time testimony was taken; but he states (Q. 27) that he saw it in the fall of 1911. His testimony is frank and without dissimulation. Indeed, a careful reading of it convinces me that the defects are in too much conciseness rather than in overstatements in his favor. He has been criticized for stating (Q. 65) that three of the casings only were made in the first lot and later that six casings were made, while the invoice shows there were probably ten; but it is immaterial whether there were three or ten so far as the merits of this case go. At best it is only a reflection on Antoine's accuracy; but reading the testimony as a whole I think it only fair to him to attribute some unexplained matters that caused him to make the error.

The point which seems to me to be conclusive as bearing on the Antoine and Travis reduction to practice is that a large number of machines were made like Exhibit A. Antoine (Q. 68) says 2,000, and Exhibit E, Gebert says, was made from the same mold as Exhibit A. Gebert's testimony, fortified by Antoine and Travis's Exhibits G, H, I, and J, clearly shows that many machines like Exhibit E were shipped to customers—2,000, Gebert says in answer to Q. 59. Many in the early part of 1912 and the names of the parties to whom they were shipped are given, and such machines are still being sold. The pertinent parts of this testimony are accurately set forth in the decision of the Examiners-in-Chief and will not be repeated here.

I know of no case wherein machines had been sold and put into use as extensively as the testimony shows these machines have been sold and used in which a holding of reduction to practice has failed. In *Stanbon v. Howe et al.* (C. D., 1910, 349; 153 O. G., 823; 34 App. D. C., 418) there was no better reduction to practice proven than in the instant case; yet since the machines relied upon were sold for actual use that of itself establishes reduction to practice, especially where the other party might have easily seen the machines to determine whether or not they were successful reductions to practice. To the same effect is the decision in *Schneider v. Driggs* (C. D., 1911, 276; 162 O. G., 1000; 86 App. D. C., 116,) and *Herman v. Fullman*

(C. D., 1903, 452; 107 O. G., 1094, affirmed by the Court of Appeals of the District of Columbia; C. D., 1904, 625; 109 O. G., 1888; 23 App. D. C., 259.)

Indeed, where a party has, as Antoine and Travis, given the other side the names and addresses of purchasers of the machines it is the practice to hold it incumbent on the other side, if they controvert reduction to practice, to see those machines that have been sold and to show that they were not reductions to practice. This was the effect of the holding of the court of appeals in *Smith v. Kihlgren* (C. D., 1915, 131; 215 O. G., 324; 43 App. D. C., 193.) The proofs of reduction to practice in that case were much more meager than they are in the present case.

Grover and Barber contend, in effect, that the making of improved machines subsequently to the production of the Exhibit E machine tends to discredit the claim of successful reduction to practice of that machine, or at least indicates that Antoine and Travis were not satisfied with the machine of the Exhibit E type, and it should be regarded as an abandoned experiment; but they are not sustained in their contention by the trend of decisions. In *Wyman v. Donnelly* (C. D., 1903, 556; 104 O. G., 310; 21 App. D. C., 81,) for example, the Court of Appeals of the District of Columbia held that where after making and testing one form of ejecting mechanism for match-machines Donnelly made an improved form and showed the second form in his application, but made broad claims covering both forms, the first machine was a reduction to practice. Furthermore, Antoine and Travis have shown that they are constantly putting out new and improved forms of machines; but this in no way discredits the reduction to practice of their Exhibit E machine or indicates that it was an abandoned experiment.

It must be held that the Examiners-in-Chief were correct in their holding that Antoine and Travis have proven a reduction to practice in February, 1912, and must therefore prevail as against Grover and Barber, who did not conceive until April, 1912, and their decision is affirmed.

EX PARTE MOORE AND PACK.

Decided November 18, 1918.

274 O. G., 840.

PATENTS—PATENTABILITY—INVENTION—ASSOCIATION OF OLD MEANS.

Where one prior-art patent disclosed a portable cleaning-machine of the vacuum type in which the vacuum-creating means is mounted on the device and another patent disclosed such a machine having two compartments in the casing, one connected with the machine-nozzle and the other containing

a rotary brush, but in which the vacuum-creating means was separately mounted and connected to the device by a pipe, *Held* that it involved no invention to make a separate compartment in the casing of the former and place a rotary brush therein in view of the latter.

APPEAL from Examiners-in-Chief.

COMBINED SUCTION AND BRUSH CLEANING-MACHINE.

Mr. Edward E. Longan and Mr. John S. Barker for the applicants.
WHITEHEAD, First Assistant Commissioner:

Applicants appeal from the decision of the Examiners-in-Chief affirming the decision of the Primary Examiner finally rejecting the claims of this application, eleven in number, of which claims 1 and 8 are illustrative:

1. In a portable cleaning machine, the combination of a suction nozzle, a suction creating device connected therewith, a sweeping device, a supporting casing for said parts, a drive wheel carried by said casing, an energy-storing device operatively connected with the suction creating device and with the sweeping device, and means for operating said energy-storing device from the said drive wheel.

8. A portable carpet-cleaning machine comprising a casing divided into two separate compartments, a dust-collecting nozzle carried at the front end of the casing and positioned to lie in close engagement with the carpet being cleaned and operating to collect the lighter particles of dust and discharge them into one of the compartments of the casing, a suction-creating device carried by the casing and in communication with the nozzle through the last mentioned compartment, a drive wheel located at the rear of the casing, connections between the drive wheel and the suction creating devices for operating the latter as the casing is moved over the surface being cleaned, and a rotary driven brush located in the other compartment of the casing and situated between the nozzle and the said drive wheel.

Auberlin, No. 444,683, January 13, 1891; Dunaway *et al.*, No. 779,773, January 10, 1905; Sturgeon, No. 996,810, July 4, 1911; Rowbotham, No. 1,007,799, November 7, 1911; Rowbotham, No. 1,007,800, November 7, 1911; Seeger, German, No. 70,688 of 1893; British patent to Nicholson, No. 14,455 of 1906; British patent to Behringer *et al.*, No. 11,413 of 1908; French patent to Martini, No. 380,336 of 1907.

The application discloses a portable cleaning-machine of the vacuum type provided with two compartments in the casing, one of which is connected to the nozzle and in the other of which is placed a brush. This brush is driven by the same wheels that operate the bellows, and there is no connection between the compartment in which it is located and the compartment which is connected to the nozzle. The shaft connected to the driving-wheels is provided with a flywheel, and there is provided an overrunning clutch, so that when the cleaner is stopped the bellows will continue to be operated for a time.

Applicants argue that they have done something more than merely add together a vacuum-cleaner and a carpet-sweeper, since by arranging the parts as shown upon moving the device backward the dust stirred up by the brush can be drawn up through the nozzle and since by placing the brush between the nozzle and the drive-wheel the device can be made light and compact.

The British patent to Behringer *et al.* shows a vacuum-cleaner in which a brush is placed in a similar relation to the suction-nozzle of a vacuum cleaning-machine. It is true that this device does not carry the suction-creating means, as in applicants' case, but is connected to a pump, which in the patent is shown as being operated by a rocking-chair. The hose 56 could, however, be connected to an air-pump, no matter where located. The patent to Sturgeon shows a vacuum-cleaner having a bellows operated from the traction-wheels. It is not seen that there would be any invention in making a separate compartment in the casing of such a machine and placing a brush therein in view of the disclosure of the British patent, where it has the same function as in applicants' device. It is argued that the machine of the British patent is not a vacuum-cleaner in the sense in which that term is generally used. The operation of the device, as described in the specification, is that of the ordinary vacuum-cleaner, and there is nothing in the drawing to show that it would not work as described.

Attention is called to a number of patents issued since this application was filed showing brushes associated with vacuum-cleaners. The claims of these patents are, however, all devoted to details of construction, and the fact that these patentees thought it advantageous to use a brush with the cleaner does not show that merely to bring them together in one machine was invention.

Nor would there be any invention in the use of a flywheel or, as expressed in the claims, an energy-storing device, in view of the common use of fly wheels for a similar purpose. An example of such use in a vacuum cleaning-machine is shown in the British patent to Nicholson, and an overrunning clutch between the traction-wheels and the fan is shown in the patent to Rowbotham, No. 1,007,799.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE BARBER.

Decided November 29, 1918.

275 O. G., 201.

PATENTS—INVENTION—ALLEGED NEW RELATION OF PRINTING-PRESS AND PAPER-WEB.

No invention is involved in leading the web through a printing press in a specified way where no change in the construction is necessary to accomplish it.

[NOTE.—This application has resulted in Patent No. 1,812,151, dated August 5, 1919.]

APPEAL from Examiners-in-Chief.

PRINTING-PRESS.

Messrs. Brown & Seward for the applicant.

WHITEHEAD, First Assistant Commissioner:

Appeal is taken from the decision of the Examiners-in-Chief affirming the decision of the Primary Examiner finally rejecting claims 1 to 8, inclusive, of which claims 1 and 5 are illustrative:

1. A printing press comprising two multicolor printing mechanisms operable to print a plurality of colors on each side of one web or one color on each side of two separate webs without the use of turners.

5. A printing press comprising two multicolor printing mechanisms operable to print a plurality of colors on each side of one web or a plurality of colors upon one side and one color on the other side of one web, or one color on each side of two separate webs without the use of turners.

The reference cited is Spalckhaver, No. 742,248, Oct. 27, 1903.

The invention is directed to a multicolor rotary web-printing press in which either a single product or two separate products may be obtained. As shown, the press includes two printing mechanisms, each mechanism consisting of two printing-couples. By appropriate adjustments, the webs may be printed as stated in the appealed claims.

The rejection is based on the ground that similar printing can be done on the press of the patent to Spalckhaver. In his brief, applicant says that in order to anticipate the appealed claims, leads must be provided for the web disclosed in the Spalckhaver patent which that patent neither shows nor describes, and that—

this is an instance therefore where a prior art patent, namely, the Spalckhaver patent, is reconstructed by the primary examiner and also by the Board of examiners-in-chief in the light of Appellant's disclosure, in the attempt to anticipate Appellant's claims.

It is perfectly obvious that the webs can be led through the Spalckhaver press so as to print them in the manner set out in the appealed claims, as fully pointed out both by the Primary Examiner and the Examiners-in-Chief. No reconstruction whatever of the press is necessary. The Spalckhaver patent points out certain ways in which the web can be led through the press, but it is not seen how it can be argued that it would require invention to lead them through in another manner. The case is analogous to a case where process claims are rejected on an apparatus which is clearly capable of carrying out that process. It is well settled that such a rejection is proper where either the process is described in the apparatus patent or

where it is obvious to any one skilled in the art that the process can be carried out by the mechanism of that patent.

While the appealed claims were properly rejected on the Spalckhaver patent, applicant has disclosed a simpler mechanism than that of Spalckhaver in that he accomplishes the desired result by the use of only two printing mechanisms, each of which consists of only two printing-couples, and it is thought that applicant is entitled to claims on such a mechanism. If within forty days from the date hereof claims are presented limited to a press consisting of only two multicolor-printing mechanisms, each of which consists of only two printing-couples, the Examiner is authorized to enter the amendment and allow claims in the absence of better references.

The decision of the Examiners-in-Chief on the appealed claims is affirmed.

EX PARTE SCHNEIDER.

Decided October 3, 1918.

275 O. G., 419.

1. PATENTS—PRACTICE—CLAIMS PRESENTED ON APPEAL INDEFINITE—CASE REMANDED TO PRIMARY EXAMINER.

Where on appeal to the Commissioner it is found that the appealed claims are so indefinite that it is impossible to determine what they cover, the application will be remanded to the Primary Examiner for immediate action indicating the objections thereto.

2. SAME—EVIDENCE OF INVENTION—CONVERTING FAILURE INTO SUCCESS.

The argument that applicant has converted an unsuccessful machine into a successful one is not always convincing, since success may have resulted from reasons other than in the changes over the prior art specified in the claims.

[NOTE.—This application resulted in patent No. 1,308,766, dated July 8, 1919.]

ON PETITION.

APPEAL from Examiners-in-Chief.

CATCHING DEVICE FOR CLOTH-PILING MACHINES.

Mr. Arthur C. Eckert for the applicant.

NEWTON, *Commissioner*:

This is a petition in effect to remand this case to the Primary Examiner for further consideration and an appeal from the decision of the Examiners-in-Chief affirming the action of the Primary Examiner in his final rejection of claims 1, 4, and 5, of which claim 1 is an example:

1. In a catching device for cloth piling machines comprising a pair of brackets adjustably mounted on a table, supporting arms pivotally mounted on the brackets, means for operating the same when contacted with by the cloth

piling machine, a catch for cloth mounted on the table, means for adjusting the brackets vertically, and means for adjusting said catch horizontally to accommodate various widths of cloth, substantially as specified.

The references are:

Bendien, April 7, 1908, No. 883,687; Shapera, July 12, 1910, No. 964,124; Dauvergne, May 5, 1903, No. 727,304.

The rejected claims if properly drawn would cover a cloth-piling machine, the novel element of which seems to be the adjusting means to accommodate various widths of cloth.

It has been difficult to intelligently consider the appealed claims because they do not correctly set forth any legitimate combination, the "catch," for example, of claim 1 and "supporting arms" seem to be the same elements. Hence it is impossible to determine what the claim covers, and for that reason this case is remanded to the Primary Examiner that he may immediately and without further action on the part of the applicant indicate the various objections to the claims, since it would be wrong to allow this case to be appealed in its present condition to the Court of Appeals of the District of Columbia.

While the case is before me, however, it may save time for me to express my opinion on the point on which the lower tribunals and applicant have mainly based their contention—viz., would it involve invention to make the catching devices of Bendien adjustable on the table to accommodate various widths of cloths, especially in view of the fact that Bendien's "bracket is adjustable along the tables but not for the purpose of accommodating various widths of cloth?" I agree with the lower tribunals that it would not as broadly as claimed, and in coming to this conclusion I have not taken into consideration applicant's statements to the effect that he has transformed an unsuccessful machine into a successful one. Such an argument is not convincing in the present case. Applicant's success may have been for reasons other than the adjustable features included in the appealed claims. Ordinarily such features of adjustability are unpatentable.

To the extent indicated the petition is granted, and the decision of the Examiners-in-Chief is affirmed.

KITSELMAN v. REID, REID, AND KELLEY.

Decided January 27, 1919.

275 O. G., 628.

1. PATENTS—INTERFERENCE—SUFFICIENCY OF DISCLOSURE IN SPECIFICATION.

Where the specification of an application does not describe all the parts of a complete machine, but refers to an earlier application, and the dis-

closures taken together are sufficient to enable one skilled in the art to construct a complete machine, *Held* that the objection that the specification of the later application is insufficient is not sustained.

2. SAME—SAME—REDUCTION TO PRACTICE—ALLEGED LACK OF ADVANCE OVER PRIOR ART.

That the device disclosed by one of the parties increases the cost of manufacture and produces a product not readily salable is not sufficient to justify a holding that such device is inoperative.

APPEAL from Examiners-in-Chief.

WIRE-FABRIC MACHINE.

Mr. Chas. W. La Porte for Kitseleman.

Mr. Julian C. Dowell for Reid, Reid, and Kelley.

NEWTON, *Commissioner*:

This is an appeal by Kitseleman from a decision of the Examiners-in-Chief affirming the decision of the Examiner of Interferences awarding priority of invention of all counts to Reid, Reid, and Kelley.

The subject-matter here in controversy is closely related to that of the companion interference post, 28, which involved the same parties and which came on for hearing at the same time. The wire fence construction as set forth in each of the six counts of this interference differs from that of the companion interference, in that it includes mechanism for severing the wire fabric into two parts whereby two complete strips of fencing may be simultaneously produced by a single machine.

Kitseleman, upon whom the burden of proof rests as junior party, has taken no testimony. He contends, however, that he is entitled to an award of priority because the counts of the interference relate to structure which is not sufficiently disclosed in the application of Reid, Reid, and Kelley, and, further, that the machine disclosed by Reid, Reid, and Kelley is inoperative.

The drawings of the Reid, Reid, and Kelley application are somewhat diagrammatic, and the specification does not describe all the parts of a complete machine. However, the specification makes reference to an earlier application, No. 262,966, of Reid, Reid, and Kelley which illustrates the same type of machine, but arranged to produce only a single roll or strip of fencing. I am of the opinion that from the disclosure of the Reid, Reid, and Kelley application here involved and of said earlier application No. 262,966, a mechanic skilled in this art would be able to construct a complete machine of the character called for by the counts of this interference.

In the specification of the Reid, Reid, and Kelley application the timing of the operation of the central cutter and the twist-ers is described as follows:

n is a middle cutter which may or may not be used to sever the stay wire in two either before or after the operation of the twist-ers. If used before, the two middle or innermost twist-ers (Nos. 1) would be merely end twist-ers each rotatable in a reverse direction to the succeeding twist-ers of the same series. If used after, or if not used at all, the said middle twist-ers would be loopers and twist-ers as shown. (P. 4, lines 10-16, Reid, Reid, and Kelley specification.)

From the above it is clear that Reid, Reid, and Kelley contemplated alternative forms of mechanism, in one of which the action of the "middle cutter" would occur prior to the operation of the twist-ers. In the other it would occur subsequently thereto.

Counts 3 and 4 when considered in connection with the disclosure of Reid, Reid, and Kelley would be limited to the mechanism wherein the cutter was brought into operation subsequently to the twist-ers. Kitselman points out that the machine of Reid, Reid, and Kelley when arranged and operated in the manner specified in counts 3 and 4 would produce fencing of the character illustrated in Kitselman's brief opposite page 26 and contends that the machine when built and used in this manner is inoperative because of the projecting portions of the stay-wires which not only results in increased cost of manufacture, but also renders the product unsalable. However, even admitting that the cost of manufacture is greater and that the fencing is not readily salable this in itself is not sufficient to justify a holding that the machine of Reid, Reid, and Kelley is inoperative.

It is urged on behalf of Kitselman that the testimony taken by Reid, Reid, and Kelley shows that they are not joint inventors. I agree with the lower tribunals that a proper basis for such contention is not disclosed in the evidence.

The decision of the Examiners-in-Chief awarding priority to Reid, Reid, and Kelley as to the subject-matter of all the counts in issue is affirmed.

REID, REID, AND KELLEY v. KITSELMAN.

Decided January 27, 1919.

275 O. G., 624.

1. PATENTS—INTERFERENCE—EFFECT OF PRIOR ADJUDICATION.

A contention that a count of an interference is not patentably different from the issue in a prior interference between the same parties which had been finally determined does not form a proper basis for invoking the principle of *res adjudicata*, as it is, in effect, merely a denial of the patentability of the count.

2. SAME—SAME—COUNT INDEFINITE—CONSTRUED AND PRIORITY AWARDED—SUBSEQUENT AMENDMENT.

A count of the interference *Held* indefinite in language, but construed to have a certain meaning. Priority thereon awarded to K., but the Primary Examiner directed to require, after the final adjudication, that such claim be made more definite.

3. SAME—SAME—COUNTS BARRED TO ONE OF THE PARTIES, BUT PRIORITY AWARDED TO THEM.

Decision of the Examiners-in-Chief awarding priority to R., R., and K. as to certain counts, but recommending that the counts were barred by a prior patent to them, affirmed, following the practice authorized by the Court of Appeals of the District of Columbia in *Noring v. Hayes*, (C. D., 1911, 347; 166 O. G., 1282; 37 App. D. C., 169.)

APPEAL FROM EXAMINERS-IN-CHIEF.

WIRE-FABRIC MACHINE.

Mr. Julian C. Dowell for Reid, Reid, and Kelley.

Mr. Chas. W. La Porte for Kitseiman.

NEWTON, *Commissioner*:

This case comes before me upon appeal from the decision of the Examiners-in-Chief. The interference comprises fifty-seven counts. Priority of invention of the subject-matter of counts 19, 37, 46, 47, 53, 56, and 57 has been awarded to Reid, Reid, and Kelley by the Examiners-in-Chief, and Kitseiman has been adjudged the prior inventor of the subject-matter of the remaining counts. Both parties have appealed from such parts of said decision as are unfavorable to them.

The invention in issue concerns a loom for producing woven-wire fencing, and the counts appear in full in the decision of the Examiner of Interferences.

In the production of fencing, as disclosed by both parties, the wires forming the longitudinal strands of the fence are given an intermittent motion in their travel through the machine. Suitable feeding and guiding means is provided for projecting the stay-wires across the longitudinal wires. The longitudinal wires pass through apertures axially located in certain rotary looping and twisting mechanisms. During the period that the longitudinal wires are stationary the stay-wire is brought in contact with the loopers and twisters, which grip the stay-wire and twist it about the longitudinal wires.

The manner in which the loopers and twisters operate to form a loop in the stay-wire and to twist it about the longitudinal wires is well illustrated in Figs 18-21 of the Kitseiman application. The twisters provided for attaching the stay to the top and bottom longi-

tudinal wires of the fence do not form a loop, but merely coil the projecting end of and twist it about the longitudinal wires.

This controversy is principally concerned with the order of operation of the twisters. In both the machine illustrated in the application of Kitselman and the one disclosed in the application of Reid, Reid, and Kelley the two center twisters begin to operate first and operate simultaneously or in coincidence. The twisters operate in succession in each direction from the center of the machine, corresponding pairs in each direction being timed to operate simultaneously.

Kitselman has taken no testimony and relies upon his filing date—September 17, 1906—as his effective date of conception and constructive reduction to practice. The junior party's application was not filed until February 15, 1910.

The junior party contends that the evidence which he has submitted relative to conception prior to Kitselman's filing date and the building and operation of a machine in 1908 is sufficient to establish priority. This evidence has been fully considered by both the Examiner of Interferences and the Examiners-in-Chief in their decisions, both tribunals holding that Reid, Reid, and Kelley were lacking in diligence in reducing the invention to practice and that because of such lack of diligence the actual reduction to practice of the invention by Reid, Reid, and Kelley, as evidenced by the construction and operation of 1908 machine, will not avail to overcome the earlier filing date of Kitselman. With this conclusion I agree.

Reid, Reid, and Kelley were involved in interference proceedings Nos. 29,457, 34,829, and 36,722, all with Kitselman. These interferences concerned machines for producing wire-fencing, and all said interferences were finally determined in favor of Reid, Reid, and Kelley. These interferences involved application Serial No. 262,966, of Reid, Reid, and Kelley now matured into Patent No. 1,160,089, which does not disclose the subject-matter of the counts of the present interference, with certain exceptions, which will be later taken up. Reid, Reid, and Kelley contend that priority of the subject-matter of this interference is *res adjudicata* by reason of the judgments in the prior interferences, basing their argument on the contention that the mechanisms defined by the counts of this interference, while differing in detail from that disclosed in their Patent No. 1,160,089, do not in fact involve anything beyond ordinary mechanical skill. This contention therefore is, in effect, merely a denial of the patentability of the claims, and accordingly does not form a proper basis for invoking the principle of *res adjudicata*.

That Reid, Reid, and Kelley were not joint inventors was urged below, (see decision of Examiners-in-Chief, par. 1, p. 12;) but no

reference is made to this point on appeal. I have therefore made no reference to it in this decision.

Reid, Reid, and Kelley have placed in evidence their Patent No. 721,605, issued February 24, 1903, and their Patent No. 1,160,089, granted November 9, 1915, upon application Serial No. 262,966, filed May 29, 1905. The Examiners-in-Chief have awarded priority of invention to Kitselman because of the junior party's failure to overcome Kitselman's filing date except in the case of the subject-matter of certain counts which were held to be disclosed in the above patents. Said counts will now be taken up and considered in detail.

The Examiner of Interferences awarded count 7 to Reid, Reid, and Kelley, holding that the subject-matter was disclosed in their Patent No. 1,160,089. Said count reads as follows:

7. A wire fabric loom, including a complement of wire connecting devices arranged to connect the same stay to a series of wires, and operating means serving to cause certain of the wire connecting devices to operate in complete coincidence with each other but in non-coincidence with certain other of said devices.

In order to satisfy this count an operation of at least two twistors in perfect or complete coincidence is necessary. In the specification of Patent No. 1,160,089 (p. 9, lines 20-26) the operation of the two twistors most remote from the stay-wire-feed rolls is described as follows:

And the first and second twistors may act practically or nearly simultaneously it being only necessary for the stay wire to be engaged and held on the outermost or first strand when the looping pin of the second twister draws the loop over the second strand.

The term "complete coincidence" is construed to call for twistors whose operation is isochronous, and such a mechanism is disclosed by the applications involved in this interference. While the statement above quoted describes the action of "the first and second twistors" of Patent No. 1,160,089 as "practically or nearly simultaneous," there is no definite statement that the operation of both these twistors is or could be initiated and completed at exactly the same time. From the disclosure in said patent it would appear necessary that the twistors most remote from the stay-feed rolls rotate sufficiently to grip the wire before the looping-pin of the adjacent twister begins to exert pressure upon the stay-wire. Otherwise a portion, at least, of the stay would be withdrawn from the first twister. I am therefore inclined to agree with the view taken by the Examiners-in-Chief that the subject-matter of count 7 is not disclosed in the Patent No. 1,160,089 of Reid, Reid, and Kelley and that priority as to said count should be awarded to Kitselman.

A certain lack of indefiniteness as to the language of count 13 has been indicated in both the decision of the Examiner of Interferences and that of the Examiners-in-Chief. Said count is as follows:

18. A wire fabric loom, including two series of twistors arranged to twist the same stay around a series of wires, corresponding twistors of said series operating in pairs.

The statement that corresponding twistors operate in pairs, when viewed in the light of the machines in controversy, suggests but does not specify that all pairs do not operate simultaneously. Otherwise a structure such as shown in Patent No. 721,605, issued to Reid, Reid, and Kelley, would apparently satisfy this count. The award of this count to Kitselman by the Examiners-in-Chief is affirmed. Also the recommendation of said tribunal as to this count is approved, and the Primary Examiner is directed, after the final adjudication of priority, to require said claim to be made more definite, to bring out the idea that the pairs of twistors operate successively.

The award of priority to Kitselman by the Examiner of Interferences as to count 19 was reversed by the Examiners-in-Chief, the latter tribunal holding that Reid, Reid, and Kelley were entitled to priority as to this count, but recommending that the issue of a patent for such subject-matter to Reid, Reid, and Kelley was barred by the disclosure in their Patent No. 721,605. I find no error in this ruling, and therefore affirm the decision of the Examiners-in-Chief as to said count 19, following the practice authorized by the Court of Appeals of the District of Columbia in *Norling v. Hayes*, (C. D., 1911, 347; 166 O. G., 1282; 37 App. D. C., 169.)

The subject-matter of count 37 was also found by the Examiners-in-Chief to be disclosed in the machine of the Patent No. 721,605, granted to Reid, Reid, and Kelley. Count 37 is as follows:

37. A wire fabric loom, including a series of rotary twistors all arranged to twist the same stay upon all of the longitudinal wires of the fabric, and means for operating certain of said twistors simultaneously in opposite directions.

The twistors as described in said patent are arranged to be operated simultaneously by the rack J, one of the outermost twistors or coilers rotating in a direction opposite to that of the adjacent twister. (See p. 4, lines 107-118, of the specification of Patent No. 721,605.) I am therefore of the opinion that the language of this count is satisfied by the structure illustrated and described in said Patent No. 721,605, and therefore affirm the Examiners-in-Chief in their award of this claim to Reid, Reid, and Kelley. After the final determination of priority the Primary Examiner is directed to reject this claim, as barred by the grant of said Patent No. 721,605.

Count 53 is also found to be satisfied by the machine of Patent No. 721,605 when said machine is arranged to produce a plurality of lines of fencing at one time, which is clearly contemplated, as indicated by

the language found on page 1, lines 45-50, and pages 4 and 5, lines 119-134 and lines 1-10, respectively. The award of this count to Reid, Reid, and Kelley is affirmed and the recommendation that this claim be rejected after the final adjudication of priority is approved.

The Examiner of Interferences and the Examiners-in-Chief differ as to the meaning to be given certain language in count 22. This count is as follows:

22. A wire fabric loom, including a series of combined loopers and twisters arranged to form a series of loops in a stay and to twist said loops about a series of line wires, and means for bringing a plurality of said devices into action simultaneously and for subsequently bringing other of said devices into action.

It is to be noted that this count by express terms is limited to combined twisters and loopers, which excludes a mere twister or coiler such as is found at the end of the series most remote from the stay-feed rolls in Reid, Reid, and Kelley's Patent No. 1,160,089. Moreover, the limitation—

means for bringing a plurality of said devices into action simultaneously—

is not satisfied by a mere disclosure of means for starting the operation of successive twisters before the operation of others has been completed. This count is not found to read upon the machine of said Patent No. 1,160,089, and the award of priority as to count 22 to Kitzelman is affirmed.

I agree with the conclusions reached by the lower tribunals as to counts 44 and 45 and affirm the award of these counts to Kitzelman.

The Examiners-in-Chief in their decision have discussed quite fully the subject-matter of counts 46, 47, 56, and 57, pointing out the structures disclosed in Patent No. 1,160,089, granted to Reid, Reid, and Kelley, which are regarded as satisfying these counts. No error is found in the award of these counts to Reid, Reid, and Kelley, and such holding is affirmed. The recommendation of the Examiners-in-Chief that these claims are not allowable to Reid, Reid, and Kelley because barred by the grant of their former Patent No. 1,160,089 is deemed to be well founded, and after final decision on priority allowance of these claims to Reid, Reid, and Kelley should be refused.

Count 48 is as follows:

48. A wire fabric loom including a series of combined stay loopers and twisters, and operating means arranged to bring certain of said combined loopers and twisters into action successively beginning with a looper and twister located at an intermediate point of the series, to cause the formation of loops in the stay and the twisting of said loops about line wires.

Count 48, as heretofore pointed out in regard to count 22, is limited to combined twisters and loopers, and thus eliminates twisters which

do not embody the looping mechanisms. I agree with the Examiners-in-Chief that this count is not readable upon the machine of Patent No. 1,160,089, and priority as to this count is awarded to Kitselman

The decision of the Examiners-in-Chief awarding priority of invention to Kitselman of the subject-matter of counts 1-18, inclusive; 20-36, inclusive; 38-45, inclusive; 48-52, inclusive; and counts 54 and 55 and awarding priority of invention of the subject-matter of counts 19, 37, 46, 47, 53, 56, and 57 to Reid, Reid, and Kelley is affirmed.

EX PARTE STADEKER.

Decided March 7, 1919.

275 O. G., 1023.

PATENTS—INVENTION—HANDLE MADE OF METAL ROD HAVING SERIES OF LATERAL BENDS.

Claims for a windshield-wiper in which the feature relied upon for patentability is a handle to be grasped in the palm of the hand, consisting of a wire or rod provided with a series of lateral bends extending from side to side in zigzag manner to form a wide flat vertical handle arranged in a plane parallel to the windshield, *Held* devoid of invention in view of a patent for a similar device which disclosed but a single bend, it appearing that the idea of forming a rod in a series of bends was a well-known mechanical expedient, (citing *Towne Steering Wheel Co. v. Lee*, 199 Fed. Rep., 777.)

(Affirmed by the Court of Appeals of the District of Columbia, *post*, 190; 275 O. G., 1023.)

APPEAL from Examiners-in-Chief.

WINDSHIELD-WIPER.

Mr. A. Miller Belfield for the applicant.

NEWTON, *Commissioner*:

This is an appeal from the decision of the Examiners-in-Chief affirming the action of the Primary Examiner in his final rejection of claims 1 to 5, inclusive, of which claims 1 and 5 are examples:

1. A wind shield cleaner comprising a metallic rod bent upon itself to form cleaning and handle portions, the handle portion being provided with a series of lateral bends forming a substantially flat vertical handle lying in a plane substantially parallel with the wind shield.

5. A device of the class specified consisting of a metallic rod bent upon itself to form a cleaning portion and a handle portion, the latter portion being provided with a series of lateral bends extending from side to side in zigzag manner to form a wide, flat, vertical handle to permit the device to be firmly grasped and to rest flatwise against the palm of the operator's hand.

The references are: Parsons, No. 523,004, July 17, 1894; Devore, No. 525,189, August 28, 1894; Wolfe, No. 1,171,377, February 8, 1916; Goodrich, No. 1,211,698, January 9, 1917; German patent to Preus, No. 269,319, January 17, 1914.

The invention covered by the rejected claims is a windshield-wiper, and the claims are all substantially met by the German patent, with the exception of a series of lateral bends in the handle. The Examiners-in-Chief have found a similar construction—that is, lateral bends—in the screw-driver handle of the Devore patent. The handle of the German patent includes a single bend. It is lateral or side-wise of the rod. Applicant contends that the disadvantage of the single bend in the handle of the German patent is that it can not be readily grasped in the palm of the hand, whereas applicant's may be.

The statement in claim 1—

lying in a plane substantially parallel with the wind shield—

has been objected to as embodying new matter not originally disclosed; but the showing in the drawing, together with the statement in the specification (pp. 2 and 3)—

* * * by bending the same into a series of *lateral* bends, a substantial handle is formed which may be grasped and firmly held and will not slip or turn in the hand,

is held to be a sufficient foundation for this limitation. But to zig-zag the rod to form a handle that will not turn in the palm of the hand is such an old mechanical expedient that it is not believed sufficient to sustain a claim, even though it be limited to being in the plane of the windshield.

The case has many features similar to those discussed by the circuit court of appeals in *Towne Steering Wheel Co. v. Lee*, (199 Fed. Rep., 777,) in which it was held:

It is common knowledge that the expedient of roughening and corrugating the surfaces of handles of various implements is very old, and instances may be found in the handles of tennis rackets, fishing rods and baseball clubs, and that the handles of swords and knives from time immemorial have been indented on the inner side so as to render more firm the grasp of the fingers,

and while it was new to indent the inner surface of a steering-wheel with scallops or indentations to prevent the hand from slipping the court sustained a demurrer and held the patent void on its face.

Applicant has filed some exhibits indicating that his windshield-wiper has gone into extensive use; but this may be on account of his superior business management or in the cheapness of construction of his device. At any rate the change over the prior art will not, in my opinion, support the claims.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE DUNCAN.

Decided November 30, 1918. Petition for rehearing, decided January 8, 1919.

276 O. G., 207.

1. PATENTS—CLAIMS—AGGREGATION—RECORD-TAPE.

Claims for a record-tape for guidance in running a train provided with a standard-speed line and a maximum-allowable-speed line and perforations *Held* not objectionable as aggregations, as they enable the engineer to so regulate his speed as to keep an indicator between the two lines and so indicate at a glance that his instant speed is between the normal and maximum.

2. SAME—SAME—DUPLICATE OR REDUNDANT—INDEFINITENESS.

Where an applicant defines the same invention in numerous ways, he not only fails to secure his invention, but he fails to comply with the provision of the law that "he shall particularly point out and distinctly claim the part, improvement * * * which is his invention," and the claims are therefore indefinite. If an applicant writes two claims which define the same invention, then by that very fact he fails to point out his invention.

3. SAME—SAME—SAME—REJECTION FOR DUPLICATION AND INDEFINITENESS.

Duplication of claims invariably leads to indefiniteness, and an entire set of claims should be rejected as indistinct whenever by reason of duplication it is made uncertain what the invention is. The different claims must be on their face obviously different in substance.

4. SAME—SAME—INDEFINITENESS.

Claims which are confused by reciting numerous unnecessary limitations and using indefinite terms, making things appear of essence which are not of essence, are indefinite.

ON PETITION for rehearing.

5. PATENTS—CLAIMS—DUTY OF APPLICANT TO POINT OUT DISTINCTIONS.

Where an applicant presents a multiplicity of claims to define a simple invention and many are substantial duplicates of others, it is applicant's duty rather than that of the Examiner to point out how each claim patentably differs from every other one.

6. SAME—APPEAL TO COMMISSIONER—REVIEW NOT RESTRICTED TO QUESTIONS PUT IN ASSIGNMENT OF ERRORS.

On appeal to the Commissioner he is not bound to decide merely the specific questions put to him by the assignments of error, because it is his duty to refuse a patent whenever he has an opinion that the patent ought not to be granted, and it is immaterial how he gets the information upon which he bases his opinion.

(Affirmed by the Court of Appeals of the District of Columbia, *post*, 197; 276 O. G., 211; 49 App. D. C., 372.)

APPEAL from Examiners-in-Chief.

SPEED AND DISTANCE INDICATOR RECORD.

Mr. Harry L. Duncan pro se.

CLAY, *Assistant Commissioner:*

The applicant appeals from the affirmance by the Examiners-in-Chief of a rejection of claims 1 to 12, inclusive, and 16, 18, and 21, drawn to a form of record-tape for guidance in running a train, for example. The rejection was on the ground that the claims define aggregations, both tribunals below apparently assuming that the invention is new and patentable. Examples of claims are as follows:

1. The distance feed combined tape record, adapted to cooperate with the distance feed device of a speed or distance indicator or recorder, and having thereon time scale, speed scale, distance scale and route indications, and having a standard speed schedule and a cooperating maximum speed schedule adapted to indicate the maximum allowable speed for the various parts of the route in connection with an actual speed marking indicating the corresponding actual momentary speed of the vehicle, and having oscillatory distance schedule adapted to cooperate with an actual distance marking and indicate the relation of the actual distance traveled by the vehicle to the scheduled distance for the same time, and having perforated aligning devices at regularly spaced distance intervals and adapted to periodically control the feeding of the record and align the same in connection with aligning devices actuated by correspondingly spaced route members along the route of the vehicle.

20. The record, adapted to cooperate with a speed or distance indicator or recorder, and having thereon a maximum speed schedule adapted to indicate the maximum allowable speed for the various parts of the route.

21. The record, adapted to cooperate with a speed or distance indicator or recorder, and having thereon a standard speed schedule and a cooperating maximum speed schedule adapted to indicate the maximum allowable speed for the various parts of the route.

In the applicant's divisional application, Serial No. 137,446, which is simultaneously up on appeal, the applicant has set forth more fully an apparatus for the guidance of a locomotive operator in running a train. Substantially he provides a continuous recorder of the speed and distance, and the records being made upon a moving paper in the form of a tape or a disk. This recording-paper is provided with guiding data, so that the engineer may know his position and condition with respect to prearranged schedule. In this case the applicant is claiming the paper record itself, it being provided with a line showing the normal or standard speed and the distance from one station to another, and also another line showing the maximum allowable speed. Various markings to show tunnels, curves, and stations along the track are provided, and the paper record also has a series of perforations, which engage mechanism at intervals to stop the normal feed of the paper record until the motion of the train causes a readjustment of the ideal and actual records being made. This is accomplished by running the paper record normally at a

slightly excessive rate, so that the actual record being made tends to run ahead of the ideal or standard, and then the speed of the tape is checked at intervals to readjust so that the actual and the ideal are brought to coincide. What he is claiming is the paper record itself, with the various markings thereon.

I am unable to agree with the Examiners-in-Chief or the Examiner on the question of aggregation. It seems to me perfectly plain that the tape represented in Figure 1, having the standard-speed line 52 and the maximum-speed line 53 and the perforations 80, is thus defined by features which clearly coöperate with the actual-speed indicator 40. The engineer has only to so regulate his speed as to keep the indicator 40 between the lines 51 and 53 in order to know that he is running his train between the standard speed and the maximum allowable speed. The lines 52 and 53 as clearly coöperate in function as the two blades of a pair of shears, and as plainly the perforations 80 coöperate with these record-lines, because they are the means by which the record-lines are kept in the proper relation to the actual position of the indicator 40. Conceding that the line 52, which shows the standard speed, performs exactly the same function when it is on the tape by itself as it does when it is on a tape together with a maximum-allowable-speed line 53, it nevertheless in the latter case coöperates with the line 53, because it is the two lines together that show the engineer at a glance that his instant speed is between the normal and the maximum. Without the maximum-line 53 the engineer certainly could know whether he was running above or below the normal; but he could not know at a glance how much below or above the normal nor what relation his excess of speed was to the limit of excessive speed.

I think in this case, as I have also remarked in my decision of even date in the other case, the applicant has confused the issues by reason of indefiniteness of claim, caused both by indistinct language and by duplicating claims. When a simple invention is claimed over and over in mere variations of language, the necessary result is to confuse and to fail to point out the invention as the statute requires. The sole and clear meaning of the word "definite" is the state of standing out clearly, and alone, different, and separated from other things. If one points out the same thing twice, he does not point out that thing distinctly. The very fact that the same structure is claimed twice renders the set of claims indistinct, because there is no justification in a patent for two claims to the same thing, and when the reader finds two claims he necessarily looks for them to be drawn to different things. The applicant has a simple invention which could not possibly be defined in more than ten or a dozen claims without repetition. He has a tape with (1) a normal-speed curve, with

(2) a maximum-allowable-speed curve, with (3) speed-correction perforations, with (4) an actual-speed record, with (5) a normal-distance record, with (6) an actual-distance record. These six features are all the features there are to the tape, and it is impossible to work out of this structure in definitions as many as twenty inventions, as the applicant has done.

Again, he has confused his claims, as in claim 1 above, by reciting numerous unnecessary limitations and using indefinite terms, making things appear of essence which are not of essence. To mention only a few in claim 1, it is not material whether the record is a tape or disk. If the record is a distance-record, it must of necessity have a distance-scale. If there is a coöperating maximum-speed schedule, this must inevitably indicate the maximum allowable speed for various points of the route in connection with the actual-speed marking. This speed-marking must necessarily indicate the actual momentary speed. The applicant has left out any positive statement that there is an actual-speed record, but has made all sorts of intimations about its presence. And, again, if there is a coöperating distance-marking it must inevitably indicate the relation of the actual distance to the scheduled distance for the same time. The claim contains a description of an invention, but it obscures rather than distinguishes it. This claim would cover exactly the same structure if it were worded as follows:

A continuous record adapted to coöperate with speed and distance indicators, provided with time and speed scales, a standard-speed-schedule line, a maximum-allowable-speed-schedule line, and having also alining perforations at intervals, adapted to coöperate with a feed control for the record and at intervals reset the record to correspond with the actual movements of a vehicle on which the record is used.

The Examiner was right in rejecting the applicant's claims 1, 2 3, 7, 11, 12, etc., as aggregations if he must assume that all the verbiage describes structure; but the fact is that the claim is merely indistinct, including immaterial things, repetitions of language, and indefinite expressions. The most emphatic and important requirement of the patent law is that the patentee shall distinctly point out his invention. He has no right to a patent which contains any claim or set of claims which for any reason fail to do this thing. Duplicating claims invariably brings this about, and an entire set of claims should be rejected as indistinct whenever by reason of duplication it is made uncertain to the reader what the invention is. The different claims must be on their face obviously different in substance.

The claims in this case are all rejected because, taken as a whole, they fail to point out the invention; but the applicant has an invention and is entitled to a reasonable number of claiming-clauses cover-

ing it, and upon revision of the claims as herein suggested the patent will be allowed.

The decision of the Examiners-in-Chief is reversed in the holding that the claims cover aggregations by including the several features of the paper record. The case is returned to the Primary Examiner with directions to admit a proper amendment within thirty days hereof containing a small set of claims each of which is clearly distinguished from every other in a patentable sense. The present claims 14, 17, 20, and 21, for example, are allowable.

ON PETITION for rehearing.

CLAY, Assistant Commissioner:

By petition for rehearing the applicant insists that my decision of November 30 herein went farther than the assignments of error called for, and, moreover, that in deciding certain points not raised and argued by the applicant on appeal I have fallen into error on the merits of the case. Notwithstanding the petitioner's full and careful brief I see no occasion for a rehearing; but it is apparently opportune to treat the merits more fully and to call more particular attention to the necessity of the Commissioner's discretion to review the whole case before him, especially for the purpose of insisting upon applications for patent fulfilling the requirement that they distinctly point out the invention.

The Examiners-in-Chief discovered no aggregation in claims 13, 14, 15, 17, 19, 20, and thereupon said that "in their opinion these claims should be allowed;" but otherwise they agreed with the primary Examiner. The essence of my decision was that while several other claims also were erroneously held to be for aggregations and, so far as that ground alone was concerned, should be allowed, yet as to all the claims they should be rejected for another reason. That other reason was explained rather fully, and it was concluded that—

the several claims must be on their face obviously different in substance.

I did not then consider it necessary to say that the Examiners-in-Chief had overlooked or not discussed a fault in the claim which is probably worse than aggregation.

The Examiners-in-Chief allowed, for example, claims 19 and 20, which as a matter of fact are two claims to identically the same substantial thing and by their very presence together interfere with the pointing out of the invention. These claims are worded as follows:

20. The record, adapted to coöperate with a speed or distance indicator or recorder, and having thereon a maximum speed schedule adapted to indicate the maximum allowable speed for the various parts of the route.

19. The (distance feed) record, adapted to coöperate with (the distance feed device of) a speed or distance indicator or recorder, and having thereon a maxi-

mum speed schedule adapted to indicate the maximum allowable speed for the various parts of the route.

The only difference is in the words in brackets.

Claim 20 covers simply a speed-record having a maximum-speed line thereon. Claim 19 describes this record as a "distance feed" record, which apparently means nothing, but is in any case a mere name and not an element of the claim, and, further, instead of saying that the record is to coöperate with a recorder, as in claim 20, it specifies that it is to coöperate "with the distance feed device of" a recorder, which expression, if it defines anything at all, defines the only thing in a recorder with which the record in claim 20 could coöperate. The thing claimed is the same. No one could infringe one of these claims and not infringe the other. Yet they pretend to claim different things.

I did not consider it necessary to point out specifically which of the claims were duplicates, since the crux of the decision was that the pointing out of essential differences was the applicant's duty. In effect, the applicant insists upon the right to have a patent with several claims to the same thing. As a matter of fact the twenty-one claims in the case had been previously carefully analyzed and found to contain many duplicates, as is obvious from a mere reading of them. Claim 17 covers nothing whatever except the tape with a maximum-speed marking, in substance the same as claims 19 and 20 above. Moreover it differs from claim 18 in just the same point as 20 differs from 21. The same features cannot be patented over and over again.

Claims 13 and 15 differ only in the single word "perforated" occurring before the term "alining devices" in claim 15. Since there is no suggestion of any possible form of alining devices other than a perforation in the tape, it is not invention to make the alining device in the most obvious way. Claim 11 differs from claim 12 only in specifying that the record is a "tape" record and that the alining devices are perforations at regular intervals. Putting the record on the tape is not part of the invention, and as to the alining devices they must be assumed in claim 12 to be regularly spaced to operate at all. Even the long detailed claims 1 and 2, which are the narrowest claims, differ in nothing except that claim 2 omits to say that the distance-schedule is "oscillatory" and that the alining device is a perforation at regular intervals. This is not material. In the first place there is nothing to suggest that the actual distance-marking itself is to oscillate, without which there would be no function in the schedule-line being oscillatory. If the limitation is material in claim 1, then claim 2 is incomplete and when completed would be the same as claim 1. Similarly the alining devices of claim 2 must be assumed to be perforations, as specified in claim 1, or their

pure equivalents, since no possibility of anything else is suggested. Beyond this if the structure defined in claim 2 were patented there would be no room for an additional invention based on the slight differences claim 2 recites over the structure recited in claim 1. Meanwhile the two claims pretend to set forth substantially different inventions.

The applicant undertakes by analysis to say that claim 1 includes essential features not included in the claim proposed in my prior decision; but as a matter of fact the distance-scale is included in the time-scale or else the time-scale is included in the distance-scale, while it is immaterial that the distance-schedule is oscillatory or even that it is present at all, because the tape itself is a distance-schedule. "Route indications" mean nothing. Several of the claims (as claim 15) seem to include in this term the speed-schedule, etc. The applicant has played extensively upon the terms "speed," "time," and "distance," as if he ignored the fact that there can be no speed-scale or speed-schedule without involving both a time and distance scale or schedule. Speed is merely the relation between time and distance. Claims 4 and 5 differ only in specifying that the distance-schedule is oscillatory, which is the same respect in which other claims differ, as claims 1 and 2. The same new idea can not form several inventions.

My decision was intended to prevent the result the applicant has actually brought about in this case—namely, that of setting forth the particular invention in a manner so indefinite and obscure that claims to the same thing may be supposed, even by experts, to be claims to different things. I think this is strikingly illustrated by the allowance of claims 17, 19, and 20 by the Examiners-in-Chief.

The applicant seems to insist that he has a right to avoid a distinct pointing out of his invention, for while he asks a rehearing on the ground that the Commissioner did not understand his invention he makes no attempt to explain the invention or wherein the claims differ in inventive substance. Walker in his work on patents says at page 226, (5th edition:)

In contemplation of law each claim of a patent is considered as setting forth a complete and independent invention, and so where a patent contains two claims which are alike, except that the narrower one of them calls for an unpatentable addition to what is called for by the other, the narrower claim is void. But two claims which may appear to be alike, will, if practicable, be construed to differ rather than agree, because there is a presumption that no applicant will do so useless and inexpedient an act as to repeat a claim.

Letters Patent which contain a needless multiplication of nebulous claims, calculated to mislead the public, are void for that reason, if for no other.

Undoubtedly a patentee may claim his invention in several scopes—that is, in its broad aspect and also in its narrow aspect—and he may

also separately claim several related inventions; but there is no authority for the Commissioner to issue a patent with several claims to the same thing. It is the primary duty of the Commissioner to see that the patentee delimitates his invention and each of his inventions distinctly. This for the guidance of others and in order to definitely fix the patentee's rights.

This is the reason for the well-settled rule that—

It belongs exclusively to the Commissioner to decide the question for himself, whether a patent ought to issue,

as was said by the Supreme Court in *Butterworth v. Hoe*, (C. D., 1884, 429; 29 O. G., 615; 112 U. S., 50, at p. 68.) All the facts of the Patent Office are in legal force and effect the acts of the Commissioner, and specifically it has been settled that the Commissioner may deny a patent in the form in which the Examiners-in-Chief have allowed it. (*Moore v. United States, ex rel. Chott*, C. D., 1913, 427; 192 O. G., 520, 40 App. D. C., 591.)

The applicant in insisting, as he does, that his appeal raised the single clear and sharp issue as to whether certain specified claims were drawn to aggregations, and that this was the only point involved, supports a vicious doctrine and one that finds no support in the best court decisions. The exact question raised in the Chott case above was whether the applicant could have a mandamus to compel the Commissioner to enforce a decision in his favor which had been rendered by the Examiners-in-Chief. The court below had erroneously held that there was no method by which the favorable judgment of the Examiners-in-Chief could be reviewed or reversed by the Commissioner. In view of the nature of the patent system it is remarkable that any such view could ever have been held. The responsibility of issuing patents is upon the Commissioner, and while of course the Commissioner may not dictate an opinion to the Examiners-in-Chief (nor for that matter to the newest Fourth Assistant Examiner) this is a very different thing from reviewing the question whether a given proposed patent should be issued or not. The power to grant the patent is as closely bound up with the power to refuse it as is the obverse to the reverse side of a coin.

By section 481 of the statute the Commissioner is to superintend or perform—

all duties respecting the granting and issuing of patents directed by law,

but he has no authority to issue a patent not directed by law. The law does not direct the issue of a patent with claims such as those the applicant insists upon having, being a set of claims having the effect, if not the design, to confuse rather than to distinctly point out

the invention. Section 4893 of the statute provides that the Commissioner shall cause an examination to be made—

and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor.

It would be absurd if the Commissioner, who is to issue the patent under these conditions, could under any circumstances be debarred from forming and expressing an opinion as to whether these conditions exist. It is the manifest duty of the Commissioner, under guidance of the court, to instruct the Examiners-in-Chief as to the proper form of the papers constituting Letters Patent. As will be clear from a consideration of the history of the Board of Examiners-in-Chief and the appellate practice (see *ex parte Stephen Hull*, C. D., 1869, 68,) there is not a close parallel between the relations of the Board of Examiners-in-Chief and the Commissioner and the relations between an inferior and superior court. The Commissioner could not be bound to decide merely the specific questions put to him by the assignment of error upon taking an appeal, because it is his duty to refuse a patent whenever he has an opinion that the patent ought not to be granted, and this entirely irrespective of how the case comes to his attention or how he gets the information upon which he forms his opinion. His review is more like that of a court which under writ of certiorari orders up a record on its own motion and review whatever part of it it sees fit.

The applicant's claims have been considered twice, and so far as this Office is concerned they are finally rejected and patent refused in the present form of the claims. In view of the obvious good faith of the petition for rehearing the time for the applicant to submit a small set of claims each of which distinguishes from every other in patentable substance is extended an additional thirty days. Otherwise the petition is denied.

MAREMONT v. OLSON.

Decided November 7, 1918.

276 O. G., 405.

PATENTS—PRIORITY—DELAY AFTER ALLEGED REDUCTION TO PRACTICE.

Delay to file an application or practice an invention for more than two years after a doubtful reduction to practice, while not a deliberate abandonment under *Mason v. Hepburn*, C. D. 1898, 510; 84 O. G., 147; 13 App. D. C., 86; indicates such laches as to avoid any advantage flowing from an earlier conception.

(Affirmed by the Court of Appeals of the District of Columbia, *post*, 200; 276 O. G., 406; 49 App. D. C., 369.

APPEAL from Examiners-in-Chief.

MOTOR-VEHICLE.

Messrs. Brown & Phelps for Maremont.

Messrs. Barthel & Barthel for Olson.

CLAY, Assistant Commissioner:

The junior party, Maremont, appeals from the affirmance of an award of priority to Olson in an invention defined as follows:

1. A spring structure for attachment to a vehicle having axle flanges, comprising a spring supporting yoke having a face portion arranged for attachment to an axle flange, a spring parallel to the yoke face portion, and means securing the spring to the yoke.

2. A spring structure for attachment to a vehicle having axle flanges, comprising a spring supporting yoke having a face portion for attachment to an axle flange and an upstanding portion carrying an extension outstanding at right angles thereto, a spring parallel to the yoke face portion, and means securing the spring to the outstanding portion of the spring supporting yoke.

The Examiners-in-Chief have well and correctly discussed the proofs, and I find no error in any of their rulings.

I doubt whether Maremont fully conceived the invention in 1913; but, whether he did or no, I am satisfied that if he did he was not diligent thereafter before his rival Olson entered the field and proceeded diligently to give the public the benefit of his invention. Maremont could have known of Olson's activities in 1915, and ought to have known of them if he was interested. He presents no good excuse for omitting to at least file an application for patent sooner.

While, as Maremont's brief contends, this case is not exactly parallel to *Mason v. Hepburn* (C. D., 1898, 510; 84 O. G., 147; 13 App. D. C., 86) in the matter of signs of deliberate abandonment, yet Maremont's two attempts at reduction to practice, one of which was a mere experiment and the other of which probably proved nothing, because there was no load used on Wolfson's car, were not pursued or followed by any practice for more than two years and indicate such laches as to avoid any advantage Maremont had, even if his was the earlier conception. He "waited for an opportune time to place it on the market" at his peril, and he lost.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE TEALE.

Decided May 1, 1919.

276 O. G., 595.

1. PATENTS—PATENTABILITY—ANALOGOUS USE.

The use of a device for separating parts of ground ore is so remote from that of separating the heavier and lighter parts of ground tobacco that the latter might not be suggested by the former.

2. SAME—CLAIMS—TERMINOLOGY—"PROPELLING MEANS."

The objection that an air-draft is not a "propelling mechanism" *Held* to be not well taken, as an air-draft is a well-known propelling means and is recognized as an equivalent of a strictly structural propelling means.

3. SAME—PATENTABILITY—SUBSTITUTION OF EQUIVALENTS.

Where a prior-art patent disclosed a device to produce a shower of tobacco and direct it onto a separating means and another patent disclosed a separator to act on granulated tobacco having elements of different specific gravities in which the tobacco was fed from a hopper onto a rapidly-moving belt, which propelled the tobacco against opposing air-currents, the heavier particles being thrown through the current and the lighter ones being deflected by the current, *Held* that it involved no invention to substitute the shower-producing means of the former for the hopper of the latter combination.

[NOTE.—This application has resulted in Patent No. 1,326,547, dated December 30, 1919.]

APPEAL from Examiners-in-Chief.

TOBACCO-CLEANER.

Mr. Sydney I. Prescott for the applicant.

NEWTON, *Commissioner*:

Appeal is taken from the decision of the Examiners-in-Chief affirming the decision of the Primary Examiner rejecting claims 1 to 4, 6, 7, 21, 22, 23, and 26 to 30, inclusive, of which the following serve as examples:

1. The combination with means for producing a shower of tobacco, of cleaning means including propelling mechanism positioned to intercept and adapted to act upon the shower of tobacco to drive its heavier and lighter parts along different trajectories and thereby effect their separation.

21. The combination with an automatic cigarette machine feed, of cleaning means associated therewith and including propelling mechanism positioned to intercept and adapted to act upon the tobacco within said feed to drive its heavier and lighter parts along different trajectories and thereby effect their separation.

26. The combination with means for producing a shower of cut tobacco leaf, of mechanism positioned to intercept and act upon said shower to separate the heavier and lighter parts of said leaf.

The references cited are: Drummond, 384,565, June 12, 1888; Drummond, 384,566, June 12, 1888; Stuckey *et al.*, 518,082, April 10, 1894; Bonsack, 589,116, August 31, 1897; Raymond, 629,604, July 25, 1899.

The invention is an improvement in devices for cleaning tobacco for use in cigarettes and comprises a chamber containing means for feeding and picking the tobacco to pieces and distributing it in a "shower." In this falling shower is positioned a rotating vaned drum for propelling the tobacco lengthwise of the chamber, the

heavier particles including bits of the stems and small lumps of leaf being thrown farthest and into a receptacle, while the lighter particles fall short and onto a moving belt carrying them to a hopper, which may be attached to a cigarette-machine.

Emphasis is laid on the character of the material acted on. It is described as being tobacco-leaf, with a part of the stem left therein, the whole being sliced and shredded into a fineness suitable for cigarettes. By the use of applicant's particular cleaning or propelling means the bits of stems remaining are said to be removed and a preliminary shredding operation obviated. The appealed claims, however, define the material specifically only by the words "cut tobacco leaf."

Most of the claims recite that the tobacco falls in a shower and that the propelling means intercepts and acts on the shower, presumably for proper distribution and separation of the light and heavier particles.

It is noted that sixteen claims have been allowed, covering the general organization of applicant's machine and details, including the specific construction of the propelling mechanism.

The question presented for review is on the patentability of broader definitions of the structure whereby separation of the heavier and lighter parts of the tobacco is secured.

It is concededly old to take cigarette-tobacco more or less in a mass and pick it to pieces and cause it to fall in a shower upon a revolving separating means. Bonsack (figure 7) shows a machine doing this, as applicant admits. He contends, and correctly, that Bonsack's scattering-roll *F*^s would not separate bits of stems from small fragments of leaf; but this is clearly due to the character of said roll. Bonsack's roll is described as separating heavy foreign matter, such as nails and stones, from the disintegrated tobacco; but it is also described as separating and distributing the tobacco by throwing it away from its surface.

The patent to Stuckey and Arthur shows a distributing-wheel very much like applicant's propelling device, for use with ground ore, but the disclosed use in so remote an art as ore concentration might not suggest its use in cleaning tobacco. The applicant is not claiming merely a distributing-wheel.

The Drummond patents show drying means for the tobacco, shredding and breaking means for the stems and portions of leaf attached thereto, and air-draft separating means to carry off the leaf fragments. The material acted on here differs from applicant's material in the different proportions of broken stems and leaf fragments contained in each. One has a large proportion of stem fragments and a small proportion of leaf fragments, being derived from to-

bacco-leaf waste, while the other is mostly leaf particles, with probably only a small percentage of broken-up stems. The air-draft is in the path of the falling tobacco; but the latter is not, in my opinion, in the form of a "shower."

The applicant objects to an air-draft being considered "mechanism;" but I do not consider the objection well taken. It is a well-known propelling means and is recognized as an equivalent of a strictly structural propelling means.

It is true, as applicant states, that the air-draft of Drummond does not project the stem and leaf fragments along different trajectories; but I do not regard this as important. To move one variety away from the other is equivalent to moving both into different positions so far as a separating action is concerned.

The patent to Raymond is for a separator to act on material having elements of slightly-different specific gravities. Granulated tobacco is given as an example, which has fragments of fiber to be separated from fragments of leaf—a material very similar to applicant's material.

It is fed down a hopper upon a rapidly-moving belt, which propels the material against an opposing air-current, the heavier particles being thrown through the current and the lighter ones being deflected by the current, so that the desired separation follows.

Here there seems to be the same problem applicant faced and an equivalent solution by the selection of means. The material is said to be projected with great velocity and obviously would be shot along different trajectories and the varieties effectively separated, with the air-current omitted. The material is not fed to Raymond's belt in a shower; but the action of the belt would not be changed if it were. Shower-producing means anticipatory to a separating operation are admittedly old, and while the same may be especially advantageous where leaf and fiber fragments in specific proportions are acted on and when applicant's particular propelling means are employed yet in the combinations to which the appealed claims are directed the presence of shower-producing means is not imperative.

Upon carefully examining all the claims in this case it is noted that claims 2 and 3 cover "rotary propelling mechanism," define the function thereof, and include means for producing a shower of tobacco. It is thought this combination, since the reference Stuckey *et al.* is eliminated, is properly patentable. The remainder of the appealed claims are well met in Bonsack, taken with Raymond.

It is noted that claims 16, 17, and 18 are not limited to rotary propelling mechanism. They appear to have been allowed because they include means for collecting one part of the material and delivering the other part to a cigarette-machine; but this involves nothing novel

over Bonsack, and I recommend that these claims be rejected by the Primary Examiner when the case is returned to him.

The decision of the Examiners-in-Chief is reversed as to claims 2 and 3 and affirmed as to the remaining claims.

GRUS, JR., v. EYNON.

Decided March 17, 1919.

276 O. G., 775.

1. PATENTS—INTERFERENCE—ABANDONED EXPERIMENT.

A party must be judged by his conduct rather than by what he says afterward were his intentions. Where G. alleges that he constructed a device in March, 1913, and tested it shortly thereafter by placing it in a car for a week, after which it was removed and taken to a party for the purpose of having dies made, where it remained until 1917, and that this test was so satisfactory that he did not think it necessary to test two other devices made in August, 1914, and August, 1915, respectively, but he further testifies that three other devices were made in 1916, and that several thousand devices constructed in accordance with these models were made and sold, but no application for the invention was filed until June, 1916, although three other applications were filed which were not within the issue, *Held* that the evidence indicates that what was done in 1913 amounted only to an abandoned experiment.

2. SAME—SAME—EVIDENCE.

Where three patents were granted to a party whose name is the same as that of an applicant involved in interference, and the name of the attorneys in each is the same, and the applicant in the interference testifies that one of these patents was taken out by him, and the description thereof contains a reference to another of these patents, *Held* that it may properly be concluded that the applications were all filed by the same person, although the patents were not introduced into evidence.

Affirmed by Court of Appeals, District of Columbia, *post*, 213, 276 O. G., 780.)

APPEAL from Examiners-in-Chief.

SPRING-OILER.

Messrs. Brown, Nissen & Sprinkle and Messrs. Brown & Nissen for Grus, Jr.

Messrs. Hull, Smith, Brock & West for Eynon.

WHITEHEAD, *First Assistant Commissioner:*

The junior party, Grus, appeals from the decision of the Examiners-in-Chief affirming the decision of the Examiner of Interferences awarding priority of invention to Eynon.

The invention in issue is a lubricator intended to lubricate the springs of automobiles.

Counts 1, 3, and 4 of the issue read as follows:

1. In a leaf spring lubricator, the combination with a casing having a recess in the bottom thereof and forming a continuous wall around the edge of the bottom of the casing, a pad of absorbent material fitting in the casing, and means to press the casing against the edges of the spring leaves thereby compressing the pad about its edge.

3. In a spring-oiler, a cup element consisting of a main receptacle provided with a web formed with an oil cup and supporting means.

4. In combination with a leaf spring, a lubricating device therefor comprising a pair of metal plates extending across opposite edges of the leaves and provided with oil pockets and flat bearing faces at opposite sides of the pockets, lubricating pads between said bearing faces and adjacent edges of the spring leaves and extending across the open sides of the pockets, and means for drawing the plates toward each other to clamp the device to the spring.

Eynon took no testimony and relies upon the filing of his application on September 17, 1915, as a constructive reduction to practice of the invention.

Grus alleges a conception of the invention on February 19, 1913, and the making and successful operation of the device on or about March 1, 1913.

In his testimony Grus states that he conceived the invention on February 19, 1913, on which date he says he was working on a car in his garage in the evening and explained to Jorgensen and A. J. Kasper, Jr., that he was going to make a device of this kind. He states that he undertook to hollow out a steel plate, but was unable to do so; that he went to a machinist who told him that the steel plate was too heavy, but that the device could be made of brass, and that this was subsequently done. Jorgensen and Kasper testify that they visited Grus at his garage, and undertake to fix the date by reference to some work that Jorgensen had had done on his car, the bill for which is in evidence.

Grus has introduced in evidence, as Exhibit No. 1, a device having a flat steel plate which he says he attempted to hollow out. A device made of brass, but which Grus says was not of the right size, is in evidence as Exhibit No. 2. The device which is in evidence as Exhibit No. 3 Grus states was made a little later and was put upon a car and found to be satisfactory. He fixes the date of this test as about March 1, 1913. He testifies that he made two other devices, Exhibits Nos. 4 and 5, in August, 1914, and August, 1915, respectively. They differ from Exhibit No. 3 in that they have two plates which are held against the spring by bolts passing therethrough, one above and one below the spring, instead of a single plate held to the spring by a U-bolt. Grus testifies (Q. 45 and Q. 98) that he did not test either of these devices.

He also testifies that another device which is in evidence as Exhibit No. 6 was made in January, 1916, and that subsequently two others were made that are in evidence as Exhibits Nos. 7 and 8; that two or three thousand devices like Exhibit No. 7 were sold, and that a large number of devices like Exhibit No. 8 were sold. This latter is called a final form of the device. Exhibits Nos. 6 and 7 are heavy castings, whereas Exhibits Nos. 3, 4, 5, and 8 are made of stamped sheet metal.

It is noted that according to Grus's testimony Exhibits Nos. 1, 2, 3, and 4 were made prior to Eynon's filing date, while the other exhibits were made thereafter. It is Exhibit No. 3 that is particularly relied upon by the appellant as being a reduction to practice.

Both of the lower tribunals have held that in view of Grus's conduct with reference to these devices, particularly his not filing an application for patent on this device until June, 1916, the alleged reduction to practice was nothing more than an experiment and that he has shown no diligence in reducing the invention to practice.

According to Grus's testimony (Q. 64) after the device Exhibit No. 3 was made he put a little tin plate with slots in it in the recess in the brass plate to prevent the felt pad from being forced into this recess so that he could get oil therein more readily and that when this was done the device worked satisfactorily. He testifies (X-Q. 32) that this third device was kept on the car about a week and afterward taken to one August Wiegand to have dies made, in whose possession it remained until about three weeks before the testimony was taken.

In answer to question 75 Grus makes a long statement as to his financial condition and as to his attempts to raise the money to have dies made for the manufacturing of this device and his inability to raise the money or organize a company until the early part of 1916.

The records of this office, however, show that Grus filed on August 8, 1913, which is subsequent to the time that Exhibit No. 3 is said to have been made, an application for patent on a leaf-spring lubricator which is not within the issue. In that device the plate has no recess but has an oil-cup and an opening in the center of a flat plate, an annular leather washer being put between the plate and the spring, thereby leaving a space for the oil between the plate and the spring. This patent is referred to by Grus in answer to question 121. The records also show that Grus filed applications for patents on three other forms of the device—on August 19, 1914, May 29, 1915, and January 14, 1916, respectively. These devices are not within the issue. All three of these applications have matured into patent. Objection was raised to the consideration of these patents on the ground that they were not introduced in evidence and proper notice was not given under the rule, it being argued that there is

nothing to show that the William Grus, Jr., on whose applications the patents were granted, is the same William Grus, Jr., whose application is involved in this interference. The name is the same, the attorneys are the same, and Patent No. 1,188,442, which was granted on the application filed May 29, 1915, specifically refers to No. 1,121,354, which is referred to by Grus in his testimony. They can therefore properly be considered.

Grus's statement that he was satisfied with the device of Exhibit No. 3 and that he was so well satisfied with the devices of Exhibits Nos. 4 and 5 that he did not think it necessary to test them is absolutely inconsistent with his action in filing, before he filed the present application, three applications for patent on devices for this general purpose, but which do not embody the invention in issue. It may be true, as alleged by Grus, that it would have cost \$600 to have dies made to manufacture a device like Exhibit No. 3, though the record does not show that he got estimates but from the one machinist, but no satisfactory excuse is given why an application for patent was not filed on this device, nor does it appear why a device embodying the issue could not have been cast, as, it appears from Grus's own testimony, was done with reference to the other devices.

An applicant must be judged by his conduct rather than by what he says afterward were his intentions. His conduct in this case is so inconsistent with his claim that he was satisfied with Exhibit No. 3 that the holding is justified that the making of this device was a mere experiment and not a reduction to practice. Certainly Grus has not shown that he was diligent in reducing the invention in issue to practice at the time Eynon filed his application in September, 1915, and subsequently thereto, nor in view of the fact of the filing of three other applications, one in 1913, one in 1914, and one in May, 1915, can it be held that there was any sufficient excuse for the lack of diligence.

While, as stated above, Exhibit No. 3 is especially relied upon as a reduction to practice of the invention in issue, it is to be noted that this device does not have two plates, as called for by counts 4 and 5. Exhibits 4 and 5 contain the two plates, but neither of them was tested, nor was any device of this construction tested before Eynon's filing date.

It is held that Grus has established nothing more than a conception of the invention in issue prior to Eynon's filing date, that he was lacking in diligence, and that priority was properly awarded to George A. Eynon, the senior party.

The decision of the Examiners-in-Chief is affirmed.

HALEY v. DU RELL.

Decided February 11, 1919.

276 O. G., 776.

1. PATENTS—INTERFERENCE—REDUCTION TO PRACTICE OF PROCESS—EXPERIMENTAL MODEL.

The rules governing the reduction to practice of a process are similar to those for the reduction to practice of an apparatus. The process should be performed in a way that leaves no doubt as to its commercial practical working. *Held*, therefore, that a process carried out with an experimental model was not a reduction to practice.

2. SAME—SAME—REDUCTION TO PRACTICE—ABANDONED EXPERIMENT.

In an interference relating to an oil flotation apparatus and process where a party made laboratory experiments in 1912 in which he employed a glass funnel, a wash-bottle from which to supply water, and a spoon with which to feed ore, by which he could treat about four hundred pounds of ore per day, but did little or nothing thereafter to commercialize his machine and never made any salable commercial article, did not file his application until 1915, but took out another patent in October, 1915, for a different device, *Held* that what was done in 1912 must be considered as merely experimental.

(Affirmed by the Court of Appeals, District of Columbia, *post*, 208, 276 O. G., 778.)

APPEAL from Examiners-in-Chief.

CONCENTRATOR.

Messrs. Pennie, Davis, Marvin & Edmonds for Haley.

Mr. James T. Barkelew and *Mr. Edgar J. Clarkson* for Du Rell.

NEWTON, *Commissioner*:

This is an appeal from the decision of the Examiners-in-Chief affirming the action of the Examiner of Interferences awarding priority to Haley, the junior party, on twelve issues, of which counts 1 and 2 are examples:

1. An oil flotation apparatus comprising a flotation box having therein a receptacle holding a relatively small body of liquid and arranged to overflow into said box, and an injector arranged above the liquid level in said box to discharge a jet of pulp mixed with oil downwardly into the liquid in said receptacle and to aerate said pulp and form a froth therefrom.

2. The herein described continuous process of concentrating ores, including continuously fluidizing the ore containing mineral to be separated, continuously injecting a liquid jet through an atmosphere of gas directly and forcibly into a body of the fluidized ore to form a froth and continuously withdrawing the fluidizing ore from the body and separating the froth from the remaining material.

Du Rell has two applications filed February 12, 1915, and March 22, 1916. Haley filed June 4, 1915.

For reasons fully set forth by the lower tribunals and which have not been seriously questioned it is held that Haley reduced to practice the last of July, 1914.

Instead of taking testimony the parties have stipulated that affidavits subject to cross-examination of the affiants where desired be submitted.

Du Rell alleges conception, including the successful operation of a machine, in August, 1912. Du Rell sets up another reduction to practice in the fall of 1912.

This case largely turns on whether Du Rell's 1912 apparatus constituted a reduction to practice, since Haley did not enter the field until the summer of 1914.

Du Rell's apparatus, so far as can be gathered from its description, was built in the summer of 1912 of parts found in his laboratory. For example, the flotation-box was a glass funnel, the supply of water, etc., came from a wash-bottle, the ore was fed by means of a spoon, and the froth was caught in a beaker. The next apparatus seems to have been about the same so far as bears on the question whether or not this apparatus was a model or experiment or was what is technically known as a reduction to practice. It seems that about four hundred pounds of ore per day could be treated by this apparatus. This alone indicates the experimental nature of Du Rell's apparatus.

Du Rell contends that the second machine specifically demonstrated to his satisfaction that it would be a success and only needed to be enlarged; but after the fall of 1912 Du Rell appears to have done little or nothing to commercialize his machine and, indeed, has never made any salable commercial article, and his Patent No. 1,157,092, October 19, 1915, applied for after he had begun his work on the present invention, discloses quite a different invention from the one in controversy, indicating he was not satisfied with the present invention.

It is difficult sometimes to determine whether an apparatus is a mere experimental model or a reduction to practice. One of these things may gradually shade into the other. In *Hunter v. Stikeman* (C. D., 1898, 564; 85 O. G., 610; 13 App. D. C., 214) the Court of Appeals of the District of Columbia held on the matter of difference between a model and a reduction to practice:

So strict is the rule upon this subject that it has been held that complete invention must amount to demonstration. It must be shown to have passed the region of experiment—of possible or probable failure—and that it has arrived at certainty by being embodied in the form intended capable of producing the desired results. A model alone, no matter how complete in detail of construction, does not come within the operation of such a rule. (*Stephenson v. Goodell*, C. D., 1876, 133; 9 O. G., 1195.)

In *Manny v. Easley v. Greenwood*, (C. D., 1890, 73; 51 O. G., 1617,) where the point involved was whether a crude wooden lemon-squeezer was a reduction to practice, while the testimony showed that it had actually been used to squeeze lemons, the Commissioner held:

Reduction to practice is reduction to a form adapted to practical use. (*Coffin v. Ogden*, 5; O. G., 270; 18 Wall., 120; *Allis v. Buckstaff et al.*, C. D., 1882, 490; 22 O. G., 1705; 13 Fed Rep., 879; *Washburn & Moen Manuf'g Co. v. Haish*, C. D., 1880, 610; 18 O. G., 465; 4 Fed. Rep., 900.) Obviously the crude wooden model which Easley says he had to hold by the cone because he was afraid it would break from its base was not adapted to practical use. The utmost that can be said of it is that the use was experimental and could only establish a date of invention if it were followed up by such diligence as the law calls for to complete reduction to practice.

Du Rell's actions after his experiments also indicate that he attached little importance to his invention. His long delay before filing his application or taking any steps toward filing an application, his patenting another form of the device, and his failure to put it into commercial use all speak against this 1912 device being a reduction to practice as distinguished from an experimental model.

The attempt by Haley to show that Du Rell saw a publication of his invention in the "*Mining and Scientific Press*" of November 14, 1914, has failed. Du Rell himself denied ever having seen that publication, and hence was not stirred into action thereby.

At the hearing before me Du Rell emphasized the point that even though his 1912 *apparatus* may be classed as an experimental model, his process which he carried out with that apparatus complied with the tests of "reduction to practice" of the process *per se*, and hence he should be awarded the process claims.

The process claims and the apparatus claims in this case mean approximately the same thing, and it is highly technical to try to separate them on the ground urged by Du Rell. While in a sense it is true that a process is independent of the particular apparatus used in carrying it out, indeed, that a process should ordinarily be capable of operation with widely-differing specific apparatuses, the rules for reduction to practice of a process are, as far as the decisions go, similar to those for the reduction to practice of an apparatus. The process should be performed in a way that leaves no doubt as to its commercial practical working, and it can not be held that Du Rell has shown such a reduction to practice of his process, and the process claims should therefore go with the apparatus claims so far as this point is concerned.

I find no error in the decisions of the lower tribunals either as to fact or law, and the decision of the Examiners-in-Chief awarding priority to Haley is affirmed.

EX PARTE HALL.

Decided June 12, 1920.

277 O. G., 395.

1. PATENTS—CONTINUING APPLICATION DEFINED.

A continuing application is one filed subsequently to another, while the prior application is pending, disclosing all or a substantial part of the subject-matter of the prior application and containing claims to subject-matter common to both applications, both being filed by the same inventor or his legal representative.

2. SAME—SUBSTITUTE APPLICATION FILED AFTER ABANDONMENT OF ORIGINAL.

Where H. filed an application which was allowed, forfeited, renewed, and again allowed and where after the time within which a second renewal could have been filed he filed a second application for the same subject-matter, *Held* that the second application could not be regarded as a continuation of the first.

ON PETITION.

SPEED-VARYING MECHANISM.

Messrs. Emery, Booth, Janney & Varney for the applicant.

NEWTON, *Commissioner*:

This is a petition from a final holding of the Examiner that application Serial No. 813,311, filed January 20, 1914, may not be designated a "continuation" of application Serial No. 420,900, filed March 13, 1908, and renewed January 5, 1911, as application Serial No. 601,001.

Notice of allowance of the first application, Serial No. 420,900, was mailed June 22, 1910. Said application was forfeited and renewed January 5, 1911, under Serial No. 601,001. Notice of allowance of the last-mentioned application (Serial No. 601,001) was mailed March 28, 1913, and the present application (Serial No. 813,311) was filed January 20, 1914.

Renewed application Serial No. 601,001 therefore became abandoned upon failure to pay the final fee within six months from notice of allowance, (March 28, 1913,) which date would be September 28, 1913, more than two years from the first notice of allowance—June 22, 1910. From September 28, 1913, until the filing of the present case—January 20, 1914—was a period in which there was no continuity of applications before the Office. During this period there was no application pending in the Office of which the present application can be called a continuation.

It is well established that an applicant in order to obtain the benefit of an earlier application must have pending a continuity of applications upon which a patent could issue for an invention dis-

closed in the earlier application. In the present case no such continuity exists, because during the period between September 28, 1913, when the first application became abandoned, to January 20, 1914, applicant had no application for the invention pending in the Patent Office upon which a valid patent could have been granted.

Hien v. Pungs (C. D., 1894, 92; 68 O. G., 657) involved a case in which Pungs after his application had become abandoned filed a new application. It was held that there was no continuity in the proceedings, and in *Lindsay v. Stein*, (C. D., 1882, 245; 21 O. G., 1613; 20 Blatchf., 370,) in which a somewhat similar question was involved, the court in considering an applicant's right, after his application became abandoned, to file a new application for the same invention said:

There is nothing to prevent a subsequent application. When made, it can derive no aid, as to time, from the prior abandoned application, and the applicant must stand, as to defenses in suits upon the patent, as if the new application were the first application.

In *Carty v. Kellogg* (C. D., 1895, 83; 73 O. G., 285) Carty filed a second application approximately one month after his first application had become abandoned, and he urged that this second application should be considered as continuous with the first. Assent to this proposition, however, was refused.

In *Barrett v. Hart*, (C. D., 1918, 62; 256 O. G., 224,) where an application was allowed, forfeited, renewed, and again allowed and after the time within which a second renewal could have been filed a second application disclosing the same subject-matter was filed it was held that the second application could not be regarded as a continuation of the first.

A continuing application is an application filed subsequently to another application, while the prior application is pending, disclosing all or a substantial part of the subject-matter of the prior application and containing claims to subject-matter common to both applications, both applications being filed by the same inventor or his legal representative. Defining it in a simpler way, a continuing application is a development of an applicant's earlier application and which is entitled to the filing date of his earlier application for a constructive reduction to practice of the common embodiment of his invention in the two applications.

As petitioner's present application was not filed until the prior application upon which it is based had become abandoned, the present application can not be regarded as a continuation of the prior application.

The petition is denied.

EX PARTE KUHN AND SHAILOR.

Decided July 27, 1918.

277 O. G., 585.

PATENTS—INVENTION—ELECTRICAL HEATING UNIT.

Where the prior art disclosed in one patent an electrical heating unit consisting of a series of separate resistance-coils formed of a double spiral wound in conical form, each coil being joined to the next by a binding-post, another patent disclosed a heater having a series of coils of a continuous piece of wire, and others disclosed heating-coils of a single spiral, the wire being led back through the coil, *Held* that no invention was involved in modifying the first-named construction by making the wire continuous and winding the coils in a single instead of a double spiral in view of the other references.

[NOTE.—This application has resulted in Patent No. 1,310,994, dated July 22, 1919.]

APPEAL from Examiners-in-Chief.

ELECTRICAL HEATING UNIT.

Messrs Whittemore, Hulbert & Whittemore for the applicants.

WHITEHEAD, *First Assistant Commissioner*:

The applicants appeal from the decision of the Examiners-in-Chief affirming the decision of the Primary Examiner in finally rejecting claims 5 and 6, which read as follows:

5. An electrical heating unit comprising a continuous resistor having a series of convoluted portions each formed of a single spiral and provided with a central terminal wire and a series of insulators for detachably engaging and supporting each of said convoluted portions.

6. An electrical heating unit, comprising a single continuous resistor having a series of conical convoluted portions, and a series of conical insulators for detachably engaging and supporting each of said convoluted portions.

The reference cited by the Examiner is Seiler, No. 379,822, March 20, 1888.

The invention is an electrical heating unit consisting of a series of coils made from a single piece of wire. The coils are wound in the form of a spiral, the wire from the upper end being led back through the coil.

A number of claims have been allowed by the Examiner to specify the construction and arrangement of the insulators about which the coils are placed. The present claims merely specify that the resistor is made of a continuous piece of wire and that the coils are provided with a central terminal wire.

The patent to Seiler shows a series of resistance-coils wound in conical form; but the wire is not continuous, each coil being joined to the next by a binding-post, and the coils are not wound as in applicants' case, but in a double spiral.

It was old, however, to make an electrical heater having a series of coils of a continuous piece of wire, as is shown in the patent to Sellon, No. 302,673, cited in the concurring opinion of one of the Examiners-in-Chief on the petition for rehearing. It was also old to form heating-coils of a single spiral, the wire being led back through the coil. This is shown in the patent to Coleman, No. 530,637, cited in the decision above referred to, and also in the patents to Carpenter, No. 433,671; Hoskin, No. 877,843, and Johnson, No. 1,064,739.

It must be held, therefore, that the appealed claims define nothing constituting invention over the prior art. In other words, that broadly to modify the Seiler construction by making the wire continuous and winding the coils in a single instead of a double spiral would not be invention.

In connection with the petition for rehearing before the Examiners-in-Chief there were presented two claims as substitutes for the appealed claims. These claims are slightly more specific than the appealed claims; but for the reasons stated with respect to the appealed claims they are not regarded as patentable.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE SIMON.

Decided April 3, 1918.

279 O. G., 351.

PATENTS—INVENTION—EXTENSION OF OPERATING PARTS OF A SWITCH TO THE OUTSIDE OF THE INCLOSING CASING.

No invention is involved in extending the operating-rod of an electric switch shown in a prior patent through the cover of the inclosing casing, so that the operating-magnets would be outside the casing, particularly in view of another patent of the prior art which disclosed an operating mechanism on the outside of the casing.

[NOTE.—This application has resulted in Patent No. 1,318,508, dated October 14, 1919.]

APPEAL from Examiners-in-Chief.

ELECTRIC SWITCH.

Mr. Edwin B. H. Tower, Jr., and Mr. Frank H. Hubbard for the applicant.

WHITEHEAD, First Assistant Commissioner:

This is an appeal from the decision of the Examiners-in-Chief affirming the decision of the Primary Examiner finally rejecting claims 1, 3, and 4, which read as follows:

1. An oil immersed switch comprising, in combination, a casing, a switch support vertically suspended therein from the casing cover, a vertically dis-

posed switch arm pivoted to said support, a reciprocable operating rod extending through the casing cover and an operative connection between said rod and said switch arm adjacent the bottom of said casing.

3. An oil immersed switch provided with vertically disposed abutment contacts having curved cooperating surfaces to direct upwardly any arcs produced between the same when separated, an upwardly projecting lever carrying certain of said contacts and actuating means for said lever offset therefrom and operatively connected thereto below said contacts.

4. In an oil immersed switch, in combination, an oil receptacle, submerged vertically disposed cooperating main and arcing contacts of the abutment type mounted within said receptacle, said arcing contacts being arranged above the main contacts and having their cooperating faces curved to direct upwardly any arc drawn therebetween.

The references cited are: Davis, 758,621, May 3, 1904; Rucker, 790,983, May 30, 1905; Acly, 823,984, June 19, 1906; Van Valkenburg, 891,306, June 28, 1908; Wood, 958,788, May 24, 1910; Burrows *et al.*, 963,859, July 12, 1910; German patent, 146,308, November 3, 1903.

Claim 1 has been rejected on the ground that it covers nothing more than the extension of the operating-rod of Burrows *et al.* through the casing so that the operating-magnets would be outside the casing, and that there was no invention in this, especially in view of the structure shown in the patent to Davis. Applicant objects to this rejection on the ground that even if Burrows's structure were so modified it would not show an operative connection between the rod and the switch-arm "adjacent the bottom of the casing," and that it would be obviously impossible to construct from the Burrows and Davis switches a switch satisfying the requirements of claim 1, and assuming the possibility of so combining them there was no warrant for such a combination.

In the Burrows switch the whole mechanism is adjacent the bottom of the casing. The claim does not state that the switch-arms are pivoted at their lower end and that the contacts are above the operating mechanism. Furthermore, even if this were stated the claims would be substantially the same as the allowed claims. The claim, as noted by the Examiners-in-Chief, calls for nothing more than putting the operating-magnets of Burrows on the outside of the casing rather than on the inside, as shown, with the rod extending through the cover. In the Burrows structure the magnets are above the level of the oil, and surely there could be no invention in merely extending the operating-rod through the cover of the casing. The patent to Davis was cited not as showing a structure which could necessarily be combined with the Burrows structure, but as showing a switch in which the operating mechanism was outside the casing and therefore by its teaching negating any invention in placing the operating machines of Burrows outside the casing. The claim was properly rejected.

Claims 3 and 4 are slightly different from claim 1 in that they set out somewhat more specifically the structure of the switch-arm and of the abutment contacts. So far as the switch is defined in these claims it is substantially the same as that shown in the patent to Acly. The German patent also shows a switch in which the upper parts of the movable and fixed contacts are extended upwardly.

It appears that it is well understood by those skilled in the art that curved abutting contacts will when separated direct upwardly the arcs produced between them. Merely to put a switch, such as shown in the patent to Acly or the German patent, into an oil bath would, in view of the art, not be invention.

Claim 4 does not even include operating mechanism for the switch. In both the Acly patent and in the German patent the actuating means for the levers is connected thereto below the points of contact.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE FOSS.

Decided December 10, 1918.

279 O. G., 352.

1. PATENTS—INVENTION—PROCESS OF ROASTING ORES.

Claims for a process of roasting ores which distinguish from the prior art only in stating that the material is exposed in a confined space to heat arising from the combustion of unrefined gas as distinguished from heat otherwise applied disclosed in the prior art are devoid of invention.

2. SAME—CLAIMS—MISDESCRIPTIVE CLAIMS REFUSED.

In an application disclosing a process of roasting ores in which the crushed ore is passed through a confined space and subjected to the heat of a flame of gas, claims which specify that the material is exposed to the "heat arising from a heated body in said space" declared to be intended to refer to the fact that the walls of the rotary drier are heated, *Held* to be objectionable in form and not allowable, since the walls of the driers cannot be said to be a heated body in the drier.

[NOTE.—This application has resulted in Patent No. 1,311,645, dated July 29, 1919.]

APPEAL from Examiners-in-Chief.

ORE-REDUCING PROCESS.

Messrs. Sheridan, Sheridan & Smith for the applicant.

WHITEHEAD, First Assistant Commissioner:

Applicant appeals from a decision of the Examiners-in-Chief affirming the decision of the Primary Examiner in finally rejecting claims 1, 3, 4, 5, 6, 8, 9, and 11, of which claims 1, 3, and 11 are illustrative:

1. The process of reducing hard materials to a friable condition, which consists in feeding said materials continuously through a heated space, exposing

said materials therein to the heat arising from the combination of unrefined gas, generated immediately before its arrival at the place of said combustion, for a time sufficient to drive off volatile matter, and then immediately and suddenly cooling said materials.

3. The process of reducing hard materials to a friable condition, which consists in first breaking said materials into pieces of small size, then exposing said pieces to a flame in a confined space, said flame arising from the combustion of unrefined gas generated immediately before its arrival at and adjacent to said flame, and also to the heat arising from a heated body in said space, said pieces being kept in motion, said flame being caused to impinge upon said materials and upon said body, and then suddenly and immediately cooling said pieces after the moisture and volatile substances therein have been removed by said heat.

11. The process of reducing hard materials to a friable condition, which consists in first breaking said materials into pieces of small size, then passing said materials through an inclosed heated space and keeping them continuously in motion in said space while subjecting them to the heat of an incandescent flame impinging thereon, said pieces being retained in said space for a relatively short period of time, and being discharged therefrom when the corners or angles of the pieces appear slightly red into a cooling medium.

The references cited are: Spencer, 44,986, November 8, 1864; Stout, 477,026, June 14, 1892; Lawrence, 672,065, April 16, 1901; Naef, 711,338, October 14, 1902; Chase, 737,079, August 25, 1903; Ellis, 798,176, August 29, 1905; Randall, 903,318, November 10, 1908.

The application discloses a process of reducing hard materials to a friable condition, which consists primarily in passing the small particles of material through a drier, where they are subjected to the heat of a flame of gas, and then passing the heated particles into cold water and afterward crushing them.

A similar process is disclosed in the patent to Stout. In the apparatus of this patent the material is passed through a heated chamber and then cooled.

The Examiners-in-Chief held that there was a special advantage obtained by heating the material suddenly by exposing it to the direct action of the flame, and that this was brought out in claims 2, 7, and 10, which they held to be allowable. They found that claims 3, 4, and 5 were not allowable because they included the statement that the material was exposed to the "heat arising from a heated body in said space," or equivalent expression.

It is stated in the brief that this expression is intended to refer to the fact that the walls of the rotary drier through which the material passes are heated, but obviously the walls of the drier cannot be said to be a heated body in the drier, and the claims are therefore not patentable in the form in which they are presented. The Examiners-in-Chief, however, recommend that these claims would be allowable if amended to eliminate the reference to the heated body.

Claims 1, 8, 9, and 11 were held to be not patentable in view of the patent to Stout, since they merely specify that the material was exposed to heat arising from the combustion of unrefined gas, or equivalent expression.

Claim 11 falls in the class with claims 2, 7, and 10 rather than with claims 1, 8, and 9, since it specifies that the material is subjected to the "heat of an incandescent flame impinging thereon" and would be allowable for the same reason. The heat of the furnace of the patent to Stout is in one sense of the word the heat caused by burning gas, but it is not seen that there would be any invention in view of the art in heating the drier otherwise than as shown in Stout—for example, as by applying a flame to the outside of the cylinder, and that is all that claims 1, 8, and 9 cover.

It is noted that in the specification it is stated (last paragraph of page 2) that—

the novel feature of the process consists in first heating the ore in a suitable appliance, which may be a rotary kiln 1, and then allowing the heated material to drop into a bath of cold water 2.

This statement is obviously too broad in view of the patent to Stout since that is exactly what Stout does.

If an amendment is presented within forty days from the date hereof to claims 3, 4, 5, and 6, in accordance with the recommendation of the Examiners-in-Chief, and to the specification, to avoid the inaccuracy above noted, the Examiner is authorized to enter and allow those claims in the absence of better references.

The decision of the Examiners-in-Chief is reversed as to claim 11 and is affirmed as to claims 1, 3, 4, 5, 6, 8, and 9.

EX PARTE MOOLTEN.

Decided October 23, 1918.

279 O. G., 539.

PATENTS—INVENTION—ANALOGOUS USE.

Where it was old to provide a dental tool with a removable metal shield having absorbent disks, which shield with the disks could be removed and cleansed, and it was old in general to use protective shields of paper which could be thrown away when once used, (exemplified in clinical thermometers,) it involved no invention to provide a dental handpiece with a removable paper shield for the same purpose.

[NOTE.—This application has resulted in Patent No. 1,342,968, dated June 8, 1920.]

APPEAL from Examiners-in-Chief.

SANITARY MOUTH AND LIP PROTECTOR.

Mr. Jas. H. Griffin for the applicant.

WHITEHEAD, *First Assistant Commissioner*:

Appeal is taken from the decision of the Examiners-in-Chief affirming the action of the Primary Examiner in finally rejecting the following claims:

1. In a device of the class described, a sanitary mouth and lip protector made to fit over, and conform to, the shape of that portion of a dental hand-piece which enters the mouth of the patient, said protector consisting of a substantially tubular structure having an unobstructed interior and open at one end to enable it to be positioned on the hand-piece, and having an opening at its other end through which the operating tool extends.

4. In a device of the class described, a sanitary, detachable mouth and lip protector consisting of a tubular sheath, open at both ends, formed of pliable material and adapted to be fitted over a dental hand-piece throughout the entire length of said sheath, and to be secured to the dental hand-piece by frictional contact, said sheath being so shaped as to conform to that of the dental hand-piece either when positioned on said hand-piece or removed therefrom, whereby, when fitted over the dental hand-piece, it is retained in position by frictional contact therewith.

5. In a device of the class described, a sanitary mouth and lip protector embodying a paper sheath, the interior of which is shaped to conform to the contour of that portion of a dental hand-piece which enters the mouth of the patient, said sheath having an unobstructed interior and being open at one end to enable it to be positioned on the hand-piece and having, at its other end, an opening through which the tool operates.

Originally the Examiner cited the following references: Maloney, No. 411,160, September 17, 1889; Rothkranz, No. 684,951, October 22, 1901.

The rejection of the claims was then affirmed by the Examiners-in-Chief on appeal. On further appeal attention was called to the following references: Vaughan *et al.*, No. 738,960, September 15, 1903; Koeneman, No. 748,752, January 5, 1904.

The present claims were presented thereafter, and the case was remanded to the Primary Examiner.

The device covered by the claims is a shield or protector intended to be slipped over a dental hand-piece, the object being to prevent the transmission of disease from one patient to another. It is stated that the device is preferably made of paper, so that when used once it can be thrown away. As the protector cannot extend over the dental tool itself, it is formed with a hole therein through which the tool projects.

The patent to Rothkranz shows a shield for a dental tool the primary purpose of which is to prevent the saliva from coming in contact with the tool. It is stated, however, that this attachment may be removed and cleaned each time that the tool is operated. It is

made of metal and is provided with absorbent disks at the end thereof, so that the saliva will not reach the tool.

The patents to Vaughan *et al.* and Koneman show shields for clinical thermometers. In the latter patent the shield is made of paper and is designed to be thrown away when once used.

It thus being old, as shown by the patent to Rothkranz, to provide a detachable shield for a dental tool which can be removed and disinfected, it is not seen how there could be any invention in making such a shield of paper which can be thrown away when once used. The idea of using a protective shield is a common one, an example of an analogous use being shown in the patent to Koeneman. The shield of Koeneman, of course, does not show an opening at the lower end thereof; but such an opening is shown in the Rothkranz shield. The limitation in one of the claims that the shield is so shaped as to conform to the shape of the handpiece either positioned thereon or removed therefrom does not lend patentability to the claims. This, of course, is true of the Rothkranz shield, which is made of metal, and there would certainly be no invention in similarly shaping a paper shield.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE COMEY.

Decided December 9, 1918.

279 O. G., 589.

1. PATENTS—ANTICIPATION—DISCLOSURE.

A patent for an explosive which specifically states that the product formed is free from compounds containing nitroglycerin does not anticipate claims to an explosive limited to a mixture consisting of nitrated sugar and nitroglycerin.

2. SAME—SAME—AFFIDAVITS SHOWING DISTINCTION BETWEEN APPLICANT'S CLAIMS AND PRIOR PATENT.

A prior patent for a process for producing an explosive *Held* to be not an anticipation in view of affidavits of experiments performed which sufficiently showed that the process described would not produce an explosive such as set out in the claims alleged to be anticipated.

3. SAME—SAME—DUPLICATION—OMISSION OF FEATURE WHICH MUST BE IMPLIED.

Claims of an application for an explosive mixture which differ only in that one omits a statement in the other that the mixture is stabilized are duplicates, since stabilization must be implied in the claim omitting it or the claim must be considered to cover a useless thing.

[NOTE.—This application has resulted in Patent No. 1,801,105, dated April 22, 1919.]

APPEAL from Examiners-in-Chief.

EXPLOSIVE AND PROCESS OF PRODUCING THE SAME.

Messrs. Prindle & Wright and Mr. Spencer B. Prentiss for the applicant.

WHITEHEAD, *First Assistant Commissioner*:

Applicant appeals from the decision of the Examiners-in-Chief affirming the action of the Primary Examiner finally rejecting the claims of this application, fourteen in number, of which claims 1, 2, 9, and 13 are sufficiently illustrative.

1. The process which comprises forming a mixture of a nitrated sugar and trinitroglycerin by nitrating a mixture consisting of sugar and glycerin, and then stabilizing the mixture.

2. The process which comprises forming a mixture of nitrated cane sugar and trinitroglycerin by nitrating a mixture of cane sugar and glycerin, and then stabilizing the mixture.

9. An explosive consisting of a mixture of nitrated cane sugar and trinitroglycerin.

13. The process which comprises forming a mixture of a nitrated sugar and trinitroglycerin by nitrating a mixture consisting of 80 to 20% sugar and 20 to 80% glycerin and then stabilizing the mixture.

The references cited are: Roberts, 112,848, March 21, 1871; Heick, 235,871, December 28, 1880; Bjorkman, British, 2,483 of 1880; Guttman's *Manufacture of Explosives*, Vol. II, pages 88, 90, 91, and 92.

The British patent to Bjorkman does not disclose the invention claimed because it specifically states that the product which is formed is distinct from compounds containing nitroglycerin, whereas the appealed claims are limited to an explosive consisting of a mixture of nitrated sugar and nitroglycerin.

It is contended that the patent to Heick, which describes the nitration of a mixture of honey and glycerin, discloses an inoperative process because the composition obtained in accordance therewith could not be stabilized.

Affidavits have been filed setting out in full experiments which were performed by the assignee of this application with the process disclosed in the Heick patent. It is thought that these affidavits are sufficient to establish that Heick does not disclose a process by which there can be obtained an explosive even as set out in the broader claims. The Heick patent, moreover, is not an anticipation of the claims, which are limited to the use of cane-sugar.

Claims 9 and 10 differ only in that claim 10 specifies that the mixture is stabilized. An unstabilized explosive would be a useless composition, and therefore either claim 9 must by implication include the limitation that the mixture is stabilized or it covers a mere useless thing. If by necessary implication it includes the stabilizing, then the claim is identical with claim 10.

The same is true of claims 11 and 12.

Claims 9 and 11 are therefore not patentable over claims 10 and 12. The decision of the Examiners-in-Chief is affirmed as to claims 9 and 11 for the reasons stated and reversed as to the remaining claims.

EX PARTE WIGGINTON.

Decided April 9, 1919.

279 O. G., 729.

1. PATENTS—DOUBLE PATENTING—CLAIMS BARRED BY PATENT GRANTED ON DIVISIONAL APPLICATION.

Claims for the combination of a loose-sheet holder and the sheets held thereby which do not in any way specify the character of the sheets or how they coact with the holder *Held* unpatentable in view of a patent granted on a divisional application for the holder alone, (citing *Underwood v. Gerber*, C. D., 1893, 340; 63 O. G., 1063; 149 U. S., 224.)

2. SAME—SAME—QUESTION RAISED NOT ONE OF PRIORITY.

The question whether claims in an application are patentable over a patent granted to the same inventor does not involve priority of invention, but patentable identity of the subject-matter claimed.

3. SAME—SAME—PRACTICE OF REQUIRING DIVISION BETWEEN CLAIMS WHICH ARE NOT PATENTABLY DIFFERENT.

An Examiner should not require division between two groups of claims which he regards as not patentably different without indicating his opinion in the matter; but the issuance of a patent on matter required to be divided out affords no basis for waiving consideration of patentable identity between the claims of the patent and any claims remaining in the parent case, even though the Examiner failed to state his opinion, as the office has no authority to grant two patents to the same inventor for the same indivisible invention.

[NOTE.—This application has resulted in Patent No. 1,338,658, dated April 27, 1920.]

APPEAL from Examiners-in-Chief.

BINDER DEVICE.

Messrs. Chappell & Earl for the applicant.

WHITEHEAD, *First Assistant Commissioner*:

Applicant appeals from the decision of the Examiners-in-Chief affirming the action of the Primary Examiner rejecting claims 26 to 32, inclusive, of which claims 26 and 31 are illustrative:

26. The combination with loose sheets, and a pair of holders each comprising side and end members, the side member of one holder being disposed horizontally and its coacting end member being disposed vertically so as to support the sheets in horizontal position with their ends abutting the end member, the side and end member of the other holder being disposed in an oppositely inclined relation to provide a trough-like holder adapted to support the sheets in an

inclined position with their ends abutting the holder end member, the sheets being transferable from one holder to the other.

31. The combination with loose sheets, of a holder comprising side and end members disposed at right angles, and a support associated with said holder to support the sheets at an acute angle to said end member.

The decision of the Examiners-in-Chief is based on the ground that the applicant is not entitled to these claims in view of the fact that he had already been granted a patent for the same invention.

It appears that this application as filed contained claims for the holder and claims, such as present claim 31, to the combination of this holder with loose sheets without in any way specifying the character of those sheets or how they coact with the specific holder. A requirement for division was complied with, and an additional application was filed for the holder itself, which application has matured into Patent No. 1,270,082, being the patent referred to by the Examiners-in-Chief.

In the brief it is argued that the rejection was wrong because the situation is similar to that which obtained in the case of *Underwood v. Gerber*, (C. D., 1893, 340; 63 O. G., 1063; 149 U. S., 224,) and the reason that that case was decided against the plaintiff was because the patent for the composition was not put in suit, but merely the patent for the paper covered with this composition. Decisions are also cited which hold that a patent granted on a copending application cannot be regarded as prior art as to what it shows, but does not claim.

The question here is not whether the patent granted on the divisional application is prior art but whether the appealed claims cover an invention different from that covered by the claim of the patent.

The Examiner should not have required division without pointing out that certain of the claims of one group were not patentably different from those of the other. But however that may be, this Office has no authority to grant two patents for the same invention. The Office has held that the holder was an invention over the prior art; but certainly there was no further invention in using this holder for the purpose for which it was intended, which is all that the appealed claims cover, since they specify merely the combination with loose sheets of a certain specific holder. These claims are thought to be clearly unpatentable in view of the ruling in *Underwood v. Gerber*, *supra*, which it is thought, is not based merely on the ground that the earlier patent had not been put in suit, and in *Palmer Pneumatic Tire Co. v. Losier*, (90 Fed. Rep., 732.)

The decision of the Examiners-in-Chief is affirmed.

EX PARTE MOORE AND PACK.

Decided November 18, 1918.

279 O. G., 730.

1. PATENTS—INVENTION—SCREENING INLET-VALVE NOT INVENTION.

In view of the common practice of screening the inlet of a pump, so as to prevent undesirable objects from clogging it, there would be no invention in so screening valves leading to the bellows of a domestic suction cleaning-machine if the dust-bag adjacent thereto were of such light material that there would be danger of its being sucked into the opening.

2. SAME—SAME—MOUNTING OLD CLEANING DEVICE ON WHEELS.

No invention is involved in mounting an old suction cleaning device on wheels.

[NOTE.—This application has resulted in Patent No. 1,342,345, dated June 1, 1920.]

APPEAL from Examiners-in-Chief.

PORTABLE DOMESTIC SUCTION CLEANING-MACHINE.

Mr. Edward E. Longan and Mr. John S. Barker for the applicants.

Whitehead, First Assistant Commissioner:

Applicants appeal from the decision of the Examiners-in-Chief affirming the decision of the Primary Examiner finally rejecting claims 1, 2, 3, 5, 6, and 7, of which claims 1, and 5, are illustrative:

1. A portable suction cleaning machine, comprising a wheel-supported casing arranged to be manually moved over the surface being cleaned, means for creating a suction of air through the casing, there being an opening in the casing wall for the passage of air to the suction-creating means, a filter bag located within the casing, a guard for the said opening in the casing wall operating to prevent the dust bag from clogging the said opening, and a nozzle and carrier therefor supported by the casing, the nozzle carrier and the dust bag being independently removable from the casing and the former operating when in place to hold the latter in position.

5. A portable suction cleaning machine, comprising a casing open at its front end formed with an opening in its top wall, a removable dust bag within the casing having its open mouth held distended and disposed toward the front of the casing, suction-creating means mounted on top of the casing and communicating with the interior thereof through the said opening in its top, a detachable suction nozzle and carrier therefor arranged when applied to the casing to cover the opening in the front end thereof and also the mouth of the dust bag, and to hold the latter in place, and means for operating the suction-creating means by the movement of the machine.

The references are: Harvey, No. 673,603, May 7, 1901; Conover, No. 847,278, March 12, 1907; Mestitz, No. 875,446, December 31, 1907; Buell, No. 949,370, February 15, 1910; Hatch *et al.*, No. 980,944, January 10, 1911; British patent to Harvey, No. 375 of 1905.

The only points argued at the hearing on this appeal were whether the specification and claims show that the part 33 which carries the dust-bag is separate from and independent of the part 32 which closes the end of the casing and whether it was invention to place a guard

over the pump-valve so that the dust-bag could not be sucked there-into.

The Examiners-in-Chief allowed claim 4 and also suggested the allowance of a claim which was broad enough to cover the construction shown in Figs. 5, 8, 9, and 10, whether the part 33 be absolutely independent of the part 32 or not.

Nothing was said in the specification about whether these parts are connected or not. That they are not integral is obvious, since if they were there would be no practical way of emptying the dust from the bag, but there is nothing in the drawing to indicate that these parts are not fastened together. Applicants in the argument assumed that the member 33 is substantially the same size as the member 32 and fits closely within the casing, but there is nothing in the drawing to conclusively show this. The part 32 is not round, as indicated in Fig. 5, as is evident from the other figures, but the part 33 may be round or any other shape, just so that it is large enough to cover the inner end of the nozzle, and if so made could easily be detachably connected to the part 32. Original claim 11 would seem to indicate that this was the construction, since it specified "a removable frame mounted in the open end of the casing," and "an air-filtering and dust-collecting bag carried thereby and adapted to fit within the casing." It must be held, therefore, that there is no disclosure of the specific construction set out in the claims.

In view of the common practice of screening the inlet of a pump, so as to prevent undesirable objects from clogging that inlet, it is not seen that there could possibly be any invention in putting a screen over the valves leading to the bellows if the dust-bag was of such light material that there would be danger of its being sucked into the opening.

As noted by the Examiners-in-Chief, claim 2 is not patentable over the patent to Mestitz, since there would be no invention in mounting such a mechanism on wheels. It would seem that whatever invention there is in this case is covered by the claim allowed by the Examiners-in-Chief and the one suggested by them.

The decision of the Examiners-in-Chief is affirmed.

EX PARTE HUMPHRYS.

Decided May 3, 1919.

280 O. G., 193.

1. PATENTS—ABANDONMENT OF APPLICATION—SUFFICIENCY OF RESPONSE.

Where amendments to the specification and drawings were filed on November 13, 1918, at the expiration of the year allowed for taking action, and on November 18, 1918, the Examiner notified the attorney that the

amendments to the drawings had not been entered because all necessary corrections had not been made, made other criticisms, and stated that the claims were allowable, in response to which the attorney filed another amendment on November 22, 1918, whereupon the Examiner held the case abandoned. *Held* that the Examiner's action was wrong. If the amendment filed at the expiration of the year, taken with prior amendments, in the opinion of the Examiner were not responsive, he should have then held the application abandoned; but having objected to the sufficiency of the amendments and acted on the merits applicant was entitled to a year from that action in which to reply.

2. SAME—AMENDMENTS TO DRAWINGS—ENTRY.

Proposed amendments to drawings should not be refused entry merely because they do not make all the changes which the Examiner regards as necessary; but they should be refused entry if the work would probably have to be undone.

3. SAME—SPECIFICATIONS—CRITICISM OF ENGLISH CONSTRUCTION.

It is not deemed necessary for the Examiner to specifically point out all inaccuracies in the use of the English language, such as the use of or the omission of indefinite or definite articles, unless confusion would arise from leaving the specification as written.

ON PETITION.

RAILROAD SIGNAL.

Mr. Victor J. Evans for the applicant.

WHITEHEAD, First Assistant Commissioner:

This is a petition from the action of the Examiner holding the
* * * application abandoned for lack of sufficient prosecution.

The record shows that in the first Office action the disclosure of this application was criticized. On August 22 and August 23, 1917, amendments were filed to the specification and prints were filed of the drawing with directions to make certain changes therein. On November 13, 1917, the Examiner notified the attorney that the amendment to the drawing had not been approved since additional changes would be necessary and all of the corrections should be made at the same time. It was pointed out wherein the drawing was regarded as unsatisfactory and certain of the claims were rejected. On November 13, 1918, further amendments to the drawing and specification were filed. On November 18, 1918, the Examiner notified the attorney that the drawings of August 23, 1917, and November 13, 1918, had not been entered—

owing to the Office practice not to approve any corrections to the drawings until all necessary corrections are provided for.

It was then stated that the reference characters were confused, that there was an objection to the proposed Figure 11, and that all of the claims were held to be allowable. A further amendment was filed on November 22, 1918, both to the specification and drawing, but on November 26, 1918, the Examiner held the case abandoned because all the requirements had not been complied with. It is from

this last action that the petition is taken. A supplemental amendment with a proposed new sheet of drawings has been filed subsequent to the filing of the petition.

If the amendment filed November 13, 1918, taken in connection with the prior amendment, did not make, in the opinion of the Examiner, a responsive amendment, he should then have held the case abandoned; but instead of doing that he stated that they were not sufficient and acted on the merits of the claims. It would seem that applicant was entitled to a year in which to reply to the action of November 18, 1918.

If the amendment to the drawing is not sufficient merely in that it does not make all the changes which the Examiner regards as necessary it is not seen why it should be refused entry. It ought not to be entered if any further amendment would require the undoing of the work which has been done in entering the first amendment or if it is probable that that would be the case.

Of course an attorney should properly prepare his application when it is filed and should properly respond to the Examiner's requirements or show that he was in error in making them. It is thought, however, that a good deal of the confusion in this case has arisen from the failure to enter the amendments when they were filed.

It is directed, therefore, since the Examiner's action of November 18, 1918, was an action on the merits to which the applicant had a right to respond, that the amendments, both to the specification and drawings, heretofore filed be entered and the attorney then notified as to what further corrections are necessary. The attorney should, of course, be required to file a proper responsive amendment within one year of the date of the Office action of November 18, 1918. It is not deemed necessary for the Examiner to specifically point out all inaccuracies in the use of the English language, such as the use of or the admission of indefinite or definite articles, unless confusion would arise from leaving the specification as written.

The petition is granted to the extent indicated.

NASH *v.* REEDER *v.* RYAN.

Decided June 30, 1919.

280 O. G., 589.

1. PATENTS—STATUTES—SECTION 4920, REVISED STATUTES—"SURREPTITIOUSLY OR UNJUSTLY."

As far back as *Reed v. Cutter* (Fed. Cas., 11,645; 1 Story, 509) it was pointed out that the words of section 4920, Revised Statutes, "surreptitiously or unjustly" did not mean fraudulently, but related to a case where it appeared that another had conceived the invention prior to the patentee and while the last to reduce the invention to practice was diligent in so doing.

2. SAME—ABANDONMENT OF APPLICATION BY SUCCESSFUL INTERFERENT—RIGHT OF LOSING PARTY TO A PATENT.

Where the winning party to an interference has abandoned his application, the losing party is not entitled to a patent if the winning party has otherwise given the invention to the public before that abandonment took place, and certainly is not entitled to it if it was first reduced to practice by the winning party or if the prior conception of the latter was coupled by diligence with an actual reduction to practice, so that his work would constitute a valid defense under section 4920, Revised Statutes.

3. SAME—SAME—SAME—EVIDENCE OF COMPLETION AND PUBLIC USE OF INVENTION BY WINNING PARTY.

Where in an interference proceeding there is no evidence of the completion of the invention by the winning party, upon abandonment of such application the refusal of a patent to the losing party can not properly be based upon an affidavit averring that the winning party had reduced the invention to practice and put it into public use; but such facts must be proved by evidence showing that the device was actually put into use and was satisfactory.

APPEAL ON MOTION.

DRAFT-GEAR YOKE.

Messrs. Gillson & Gillson for Nash.

Mr. George C. Lambe for Reeder.

Mr. A. Müller Belfeld for Ryan.

WHITEHEAD, First Assistant Commissioner:

This case is before me on a motion by Nash that the award of priority be vacated. This motion is based on the ground that the application of Reeder has become abandoned. This motion was brought after a decision by me on January 22, 1919, on an *ex parte* appeal from a rejection on the ground that certain letters to this Office show that Reeder had put the device in use prior to the time that his application became abandoned. In that decision it was pointed out that the reason for making the motion in the interference, as was required in the case of *Joliffe v. Waldo v. Vermeer and Schorik*, (C. D., 1917, 15; 234 O. G., 671,) was in order to give Reeder notice.

It is contended by Nash that the abandonment of the Reeder application renders the decision in the interference nugatory and that there is no ground for refusing him a patent unless it appears that some one else had put the invention in actual use prior to his (Nash's) invention.

In the decision in *Joliffe v. Waldo et al.*, above cited, the Commissioner referred to a prior memorandum made by him in the same case in which he had stated that if at any time prior to the abandoning of their application Vermeer or Schorik or their assignee had put the invention into public use or published it Waldo's petition

must be denied, but that if they in no way gave the invention to the public then it is not clear upon what grounds Waldo could be denied a claim commensurate with the issue in the interference.

He also stated that if the winning party in an interference makes the invention public it is immaterial to the right of the losing party for patent if he thereafter abandons his application, since he has abandoned it to the public, (citing *Miller & England v. Walker*, 138 Fed. Rep., 919,) but that where the winning party to an interference, without making the invention public, permits his application to become abandoned, so that the public gets no benefit from it, he fails to complete the inventive act, and the holding that the losing party may not have a patent may result in the loss of public knowledge of the invention, which would be contrary to the theory of the patent system. He further pointed out that if the Waldo patent should be granted and suit brought thereon neither Vermeer and Schorik nor a third party could set up either public use or publication in view of the facts which appeared from the letter written by the attorney for Vermeer and Schorik. As pointed out in the decision in the Nash application, there was no formal judgment in the interference in favor of Reeder; but there was, in effect, such a judgment since the Examiner of Interferences held, and no appeal was taken from his decision, that Nash's date of conception was subsequent to Reeder's filing date.

It is contended on behalf of Nash that even if the invention was put in public use, as alleged in a letter from Reeder's attorney in answer to an inquiry of the Office as to what was done with the Reeder invention, it would have no effect, since such use was subsequent to the filing of Nash's application, and that the provision of section 4920 of the Revised Statutes that certain things may be set up as special defenses relates only to matters of pleading.

The latter contention is not correct, since that section, after providing that a party may plead and prove on trial any one of four special matters, of which the second is—

that he (the patentee) had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same.

provides that—

if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs.

As far back as *Reed v. Cutter* (Fed. Cas., 11,645; 1 Story, 590) it was pointed out that the words "surreptitiously or unjustly" did not mean fraudulently, but related to a case where it appeared that another had conceived the invention prior to the patentee and while the last to reduce the invention to practice was diligent in so doing. It was stated that he who first perfects an invention and adapts it

to use is the first inventor in the sense of the Patent Act and entitled to a patent, but that this right was subject, under the statute, to the right of a prior conceiver who had with reasonable diligence adapted and perfected the invention.

The case of *Detroit Lubricator Mfg. Co. v. Renchard et al.* (9 Fed. Rep., 293) does not bear out Nash's contention, because it was merely there held that a drawing made by Renchard prior to Parshall's invention did not constitute an anticipation under the statute and alone would not invalidate Parshall's patent. While no specific reference was made to the question of diligence, it appears that Renchard did not reduce the invention to practice until after Parshall's patent had been granted, which was nearly a year after the making of the drawing by Renchard and some months after Parshall's application was filed. It is obvious that there was no diligence on the part of Renchard.

It must be held, therefore, that in a case where the winning party to an interference has abandoned his application the losing party is not entitled to a patent if the winning party has otherwise given the invention to the public before that abandonment took place, and certainly is not entitled to it if it was first reduced to practice by the winning party or if the prior conception of the latter was coupled by diligence with an actual reduction to practice, so that his work would constitute a valid defense under section 4920, Revised Statutes. This holding is in accordance with the holding above pointed out in the decision in *Joliffe v. Waldo et al.*

The question then arises as to what evidence is sufficient to establish the actual completion of the invention by the winning party. Where, as in this case, no evidence was presented with respect thereto in the interference, obviously a mere letter stating that an invention had been reduced to practice and put into public use would not be sufficient ground for rejecting the application of the losing party, even if the statements were under oath. (*In re Frederick von Hefner-Alteneck*, C. D., 1883, 33; 23 O. G., 2223.) In order to sustain the rejection in this case it would therefore have to be established by proper evidence that the Reeder device was actually put into use and was satisfactory.

No appearance was made on behalf of Reeder at the hearing on the motion; nor has any offer been made to establish by competent testimony that his invention was so used. According to the letters certain draft-gears embodying the invention substantially as shown in Reeder's application were made in September, 1912, and were part of a large order for draft-gears from one of the railroad companies. The letter states that so far as known these draft-gears are still in use. It appears, however, that only ten of these draft-gears were made, although the order was for a very large number of gears, and

it does not appear why only ten were made nor whether any other such gears were ever made.

In view of these facts it is not believed that the case is one which would justify the Office in instituting an investigation to determine whether the Reeder use was actually a public use or not or even constituted an actual reduction to practice. In the absence of such testimony there is no competent proof upon which the Nash application can be rejected.

Attention was called to the fact that certain claims had been rejected on a prior patent to Washburn. Applicant proposes to amend these claims to more clearly bring out the distinctions over the patent, and as so amended it is thought that these two claims are allowable, as well as as claim 1, and the Examiner is directed, therefore, to enter the amendment filed March 26, 1919.

As stated in the decision of *Joliffe v. Waldo et al.*, the motion that the judgment be vacated and priority be awarded to Nash must be denied, since the judgment was properly entered; but it is held that that judgment is not of itself sufficient ground for refusing Nash a patent.

The decision of the Examiners-in-Chief on Nash's ex parte appeal will be reversed.

COLLINS v. OWENS.

Decided August 27, 1920.

281 O. G., 205.

PATENTS—INTERFERENCE—REOPENING TO PERMIT FILING OF PRELIMINARY STATEMENT.

Where a junior party to an interference fails to file a preliminary statement within the time set and makes no reply to an order to show cause why judgment on the record should not be rendered against him, but within the limit of appeal from such a judgment moves to reopen and to be permitted to file a preliminary statement executed by an official of the assignee company, *Held* that the motion should be denied on the ground of negligence where it appeared that a statement had been prepared for the signature of said official, who was traveling for his health, and was sent to him, with directions to sign it immediately and acknowledge it before a notary, that it was signed and returned without being sworn to and was not properly executed until after judgment on the record, no request having been made in the meantime for an extension of time for filing the statement.

APPEAL from Examiner of Interferences.

Messrs. Whiteley & Ruckman for Collins.

Messrs. Paul & Paul for Owens.

Coulston, *Acting Commissioner*:

The party Collins has appealed from a decision of the Examiner of Interferences denying a motion to reopen the interference and receive and file a preliminary statement.

The interference was declared on March 16, 1920. The time fixed for filing preliminary statements was April 19, 1920. On the 23d of April, 1920, an order to show cause why judgment should not be rendered against him was issued against Collins, who had not up to that time filed a preliminary statement. He was given until May 24, 1920, to reply to such order. No response was received to this order, and on May 28, 1920, judgment on the record was rendered in favor of the senior party, Owens, and the limit of appeal was set for June 28, 1920. On the 26th of June, 1920, before the limit of appeal had expired, a motion to reopen and file a preliminary statement was presented. The granting of this motion was opposed by the party Owens and was denied by the Examiner of Interferences on the ground that due diligence had not been shown in an effort to procure a statement from the party Collins himself, in the preparation and submission of a statement by the assignee of Collins, and in applying to the Patent Office for an extension of time within which to file the statement when it became apparent that one would not be filed within the time prescribed.

Accompanying the motion to reopen and file the preliminary statement was a statement executed by one Thorbus, an official of the Richardson Grain Separator Company, Minneapolis, Minn., the assignee of the Collins application, as well as an affidavit by Thorbus purporting to explain the delay, an affidavit by a physician, one Jones, setting forth that Thorbus had been ill, and an affidavit by Ruckman, one of Collins's attorneys, setting forth his part in the transaction.

The Ruckman affidavit recites that shortly after the receipt of the notice of the declaration of the interference information was conveyed to an official of the Richardson Grain Separator Company relative to the necessity of submitting a preliminary statement, and affiant was informed that Mr. Thorbus of the company was the only one who could furnish the required information. Thorbus at that time was reported to be traveling in the West for his health. The affidavit of Jones sets forth that as Thorbus's physician he had advised Thorbus to make a Western trip. The Ruckman affidavit further avers that a preliminary statement was prepared and forwarded to Thorbus at Bend, Oreg., on March 23, 1920; that on May 10, 1920, another preliminary statement was sent to Thorbus at the Hotel Stewart, San Francisco, Calif., in view of information received from the Richardson Grain Separator Company that Mr. Thorbus was at that address; that the statement so transmitted was accompanied by a letter advising Thorbus that the statement should be signed immediately, acknowledged before a notary, and returned to the attorney for filing in the Patent Office; that on June 2, 1920, the Richardson Grain Separator Company notified the affiant that Thorbus had re-

turned the statement signed, but not acknowledged before a notary, and that thereupon the employees of the company were urged to get in touch with Mr. Thorbus and obtain the preliminary statement properly sworn to, but that this was not done until June 17, 1920. It is the statement executed on the last-mentioned date which has been filed in connection with the motion to reopen.

The Thorbus affidavit sets forth that Collins in the spring of 1917 left the employ of the Richardson Grain Separator Company and that his whereabouts are unknown to the affiant; that—

the affiant and others connected with the Richardson Grain Separator Company made diligent effort to determine the whereabouts of said Harry E. Collins, without avail.

This is the only statement or showing submitted to account for the failure to obtain a statement from Collins himself. It is noteworthy that it does not recite a single fact upon which a conclusion can be based that a diligent effort to locate Collins had been made. It does not state specifically who, except the affiant, made the alleged efforts, nor does it state when such efforts were made. As appears elsewhere in the affidavit, at the time this interference was declared the affiant Thorbus was on a Western trip, seeking to recuperate his health. It is not apparent that at this time he did or could have made any effort to locate the whereabouts of Collins. As stated above, the affidavit does not set forth what efforts others connected with the Richardson Grain Separator Company made or when they made them. In view of the fact that the Collins application was involved in a previous interference in the middle of the year 1919 and that Thorbus filed the preliminary statement at that time on behalf of Collins it is at least inferable that the diligent effort to locate Collins to which affiant Thorbus refers was an effort made in 1919 and not in 1920 in connection with the submission of the present statement. I think that due diligence required that a renewed effort should have been made by Thorbus or some other member of the assignee company to locate Collins at the time when it was notified by the attorney in the Collins case of the necessity of filing a preliminary statement in this interference. It was not sufficient for the assignee company to conclude that because Collins could not be found a year ago his whereabouts could not be ascertained a year later. Furthermore, the mere conclusion of the affiant Thorbus that the effort to locate Collins, whenever it transpired, involved an exercise of due diligence will not alone suffice. The Office and not the affiant should be the judge of whether due diligence was exercised in an attempt to comply with the requirements of the situation.

But passing the question of whether due effort was made to obtain a statement from Collins personally, I am satisfied that the Examiner

of Interferences was right in ruling that Thorbus himself did not exercise due diligence in submitting a preliminary statement in lieu of Collins. Admittedly a statement properly prepared and accompanied by instructions as to signature and due execution before a notary public reached Thorbus in San Francisco, Calif. He signed it, but did not execute it, as directed, and I am unable to understand how this can be satisfactorily explained upon any theory except that of negligence. It is true that the Thorbus affidavit and that of his physician Jones set forth that he was ill and on a journey to recuperate his health. However, I am satisfied that if he was physically able to make the trip and to sign his name to the statement he must have had sufficient reserve strength to have taken the acknowledgment had he paid any attention to the letter and business in hand. Furthermore, he ought to have known that the preliminary statement had to be acknowledged before a notary, because he had himself prepared one a year before in this very application. I think that no acceptable excuse has been offered for the failure of Thorbus to promptly prepare and submit the preliminary statement, which reached him in San Francisco presumably about the middle of May, 1920, having been mailed on the 10th of that month.

I think also that the Examiner of Interferences was right in ruling that application should have been made to the Patent Office for an extension of time for filing a preliminary statement when it became apparent that one would not be submitted within the time fixed, if it appeared to the assignee of Collins and his attorneys that it was desirable that such a statement should be filed. Such an application, accompanied by a reasonable showing of the difficulties involved in obtaining a statement and of due effort made to secure one, would probably have averted the judgment. This course, however, was not followed. Judgment was entered and practically the whole time allowed for appeal permitted to expire before this motion to reopen was submitted.

A good deal has been said in the brief filed on behalf of Collins about permitting a technical judgment to control the rights of the parties and about the case being determined without a decision on its merits. All of this is set forth as being in the nature of a great wrong to Collins and a result that should be impossible to obtain. I do not so view the situation. The party Owens has some rights in the matter, and it is a fair presumption that he may be proceeding with an exploitation of his invention. After the judgment was entered he may very well have made arrangements with third parties for an interest in his invention or made investments with reference thereto which he would not have made had the judgment not been entered.

There is also a further consideration to be borne in mind under such circumstances—namely, that it is incumbent upon this Office to terminate the prosecution of contests of this character as expeditiously as possible in order that the rights of all litigants may receive due consideration and a reasonably prompt disposition. The rules governing interference procedure are liberal and offer parties involved every opportunity for taking the necessary steps to preserve their rights. The party Collins was accorded every privilege provided by the rules and made no application within the times prescribed for the performance of certain acts for any extension or modification of the application of the rules under which the contest was proceeding. The case went regularly to judgment, and the only showing that is now made as to why that judgment should not stand is that the party in interest went about obtaining a preliminary statement in what appears to me to have been a thoroughly negligent manner.

The decision of the Examiner of Interferences denying the motion to reopen the interference and admit the preliminary statement is affirmed.

ABERCROMBIE v. RINGEL v. ANGIER v. TAYLOR AND HEPP.

Decided March 12, 1920.

281 O. G., 411.

PATENTS—PUBLIC-USE PROCEEDINGS—REOPENING TO TAKE FURTHER TESTIMONY.

In public-use investigations the public, the Patent Office, and all parties concerned have a common interest in seeing to it that an invalid patent shall not issue. In such cases the same degree of diligence is not required to be shown in the discovery of evidence in order to reopen the proceedings for the taking of further testimony.

PUBLIC-USE proceedings. Order.

Mr. Nicholas M. Goodlett for Abercrombie.

Mr. Frederick C. Fischer for Ringel.

Messrs. Emery, Booth, Janney & Varney for Angier.

Mr. Watson E. Coleman for Taylor and Hepp.

Coulston, *Assistant Commissioner:*

Before proofs could be taken in this interference the junior party, Abercrombie, brought a motion for the institution of public-use proceedings to establish a bar to the grant of a patent to any of the parties with claims corresponding to the counts of the issue. This motion was granted and testimony was taken by Abercrombie and reply testimony by the senior party, Taylor and Hepp. The intermediate parties, Ringel and Angier, took no part. In accordance with the usual procedure this testimony, when submitted to the Pat-

ent Office, was referred to the Primary Examiner for consideration, and he rendered a decision holding that a case of public use had not been established.

All of the junior parties, Abercrombie, Ringel, and Angier, have now presented motions for reopening the public-use proceedings for the purpose of taking additional testimony to establish the alleged bar of public use. These motions are opposed by Taylor and Hepp.

In support of the motion of Abercrombie a large quantity of correspondence taken from the files of the Arkell Safety Bag Company is submitted, together with affidavits by Edwin D. Greene, vice-president of that company; H. W. Jordan and Robert Croasdale, of the Solvay Process Company, of Syracuse, with which the Arkell Safety Bag Company did business, and by O. B. Mitcham, a retired colonel of the United States Army, who in 1902 was an ordnance officer detailed to inspect the manufacture of picric acid by the Solvay Process Company, and others, setting forth facts which, if established by testimony, would appear to be not only relevant to the question of public use, but sufficient to supply defects in the earlier testimony which the Examiner advanced as the grounds for his ruling that a case of public use had not been established. The opposing parties to the present motions, Taylor and Hepp, have not contested the relevancy or sufficiency of the facts set out in the affidavits and correspondence above referred to as filed in connection with this motion. Their opposition is based solely on the ground that the party Abercrombie could have discovered originally the testimony which the moving parties now seek to present as further proof by an exercise of reasonable diligence. In reply to this contention Abercrombie has filed an affidavit setting forth that he personally had no knowledge of the existence of the additional evidence now sought to be adduced, and the other moving parties have taken, by way of argument, a similar position. Counsel for Abercrombie admitted, however, at the hearing that had investigation been pushed farther into the records of the Arkell Safety Bag Company, which has an interest in Abercrombie's application, this new evidence could have been discovered.

A public-use investigation is somewhat different in its nature from the usual legal proceeding between opposing parties. It is an investigation in which all concerned—the public, the parties, and the Patent Office—have, at least theoretically, a common interest in seeing to it that an invalid patent shall not issue. Even the opposing party, who happens here to be the senior party, cannot be assumed to be desirous of obtaining a patent which may be found to be invalid, and in a case such as this, where the showing presented as to the character of the proofs which it is proposed shall be taken, is such

as to make it appear that if such proofs are taken it is probable that the invention claimed will be shown to have so long been in public use that it is not patentable the interests of the parties, the duty of the Commissioner of Patents, and the public interest become paramount. Under such circumstances a somewhat less strict application of the rule of procedure governing motions to reopen decided cases becomes justifiable.

I shall grant the motions of the three junior parties to reopen this case for the taking of additional proofs to establish public use; but inasmuch as it was admitted at the hearing that the intermediate parties, Ringel and Angier, were relying upon the same state of facts as Abercrombie and inasmuch as they have previously taken no testimony or other part to establish public use the times assigned within which they may take proofs will be abbreviated as much as possible, on the assumption that they will probably not care to present much, if any, proof in addition to that taken by Abercrombie.

The times for taking testimony are set as follows: Testimony-in-chief of Abercrombie to close April 12, 1920; testimony-in-chief of Ringel to close April 19, 1920; testimony-in-chief of Angier to close April 26, 1920; testimony of Taylor and Hepp to close May 26, 1920; rebuttal testimony of Angier to close June 2, 1920; rebuttal testimony of Ringel to close June 8, 1920; rebuttal testimony of Abercrombie to close June 23, 1920, all testimony to close on July 23, 1920.

All motions must be made before the Commissioner.

Proceedings in the interference are suspended pending the final determination of the question of public use.

ABERCROMBIE *v.* RINGEL *v.* ANGIER *v.* TAYLOR AND HEPP.

Decided September 22, 1920.

281 O. G., 573.

PATENT—PUBLIC-USE PROCEEDINGS—ORAL INTER PARTES HEARING.

In public-use proceedings ordinarily an oral *inter partes* hearing will not be given, but briefs may be filed, (*in re Townsend*, C. D., 1913, 55; 188 O. G., 513;) but where the interested parties are involved in an interference proceeding, suspended for the purpose of investigating public use, so that all parties have access to the applications of all the other parties, an oral *inter partes* hearing will be permitted.

Mr. Nicholas M. Goodlett for Abercrombie.

Mr. Frederick C. Fischer for Ringel.

Messrs. Emery, Booth, Janney & Varney for Angier.

Mr. Watson E. Coleman for Taylor and Hepp.

COULSTON, First Assistant Commissioner:

On August 5, 1920, I entered an order in this case to the effect that no oral *inter partes* hearing would be held, but that briefs might be

filed by the respective parties on or prior to September 21, 1920, with reference to the testimony taken in the public-use proceedings, in accordance with the practice of *in re Townsend*, (C. D., 1913, 55; 188 O. G., 513.) Following this order the party Abercrombie has filed a motion asking that an *inter partes* hearing be had before the Law Examiner. This motion is opposed by the parties Taylor and Hepp.

The practice of refusing *inter partes* hearings in public-use cases and limiting the proponent in those cases to the mere filing of briefs is set forth not only in *in re Townsend*, but in *in re Henry*, (C. D., 1909, 40; 140 O. G., 508.) Having given consideration to the Abercrombie motion in the light of these decisions, it appears to me that this case is distinguishable from the authorities mentioned in that in this instance the parties are at this stage involved in an interference, each of them having access to all the others' applications, whereas in those cases the applicants involved were in an *ex parte* stage. If the testimony taken establishes public use, presumably all of the applications involved in the interference will ultimately be rejected in view thereof. Before that action would be taken, however, the interference would be dissolved, and until it is dissolved it would seem that all proceedings in it should be *inter partes*.

If at this time there were a motion in the case by one of the parties asking dissolution on the ground that the claims are unpatentable to any of the parties because of testimony taken establishing public use, I have no doubt that it would be referred to the Law Examiner for decision after a hearing at which all parties would be entitled to be present and take part. The absence of such a motion does not make inappropriate a direction that this proceeding shall follow that course which seems to be best adapted for the disposal of this case while the interference continues.

Accordingly the order of August 5, 1920, is vacated and a date of an inter partes hearing before the Law Examiner is fixed for October 15, 1920.

EX PARTE LACEY.

Decided October 21, 1920.

281 O. G., 573.

PATENTS—FINAL FEE PAID MORE THAN SIX MONTHS AFTER NOTICE OF ALLOWANCE OF APPLICATION.

Where the Office records indicate that a notice of allowance of an application was mailed on a certain date, the Commissioner has no authority to receive a final fee paid more than six months thereafter, upon affidavits that such notice was not received. The law (sec. 4885, Rev. Stats.) does

not require that the notice shall have been received by the applicant, but merely that it should be sent to him.

ON PETITION.

FUEL-OIL BURNER.

Messrs. C. A. Snow & Co. for the applicant.

Coulston, First Assistant Commissioner:

Twenty (20) dollars have been tendered as a final fee in the above-entitled application on October 20, 1920, more than six months after the records in the application show that it was allowed. Accompanying the letter transmitting the fee are affidavits by persons associated with the firm of attorneys who prosecuted the application saying that notice of allowance in this application was never received by them. The application file contains a regular notice of allowance, and the face of the file carries the usual indorsement of such notice as of the date of March 22, 1920. The fact that the attorneys may not have received the notice of allowance does not establish that such notice was not mailed. The Office record appearing regular and indicating that such notice of allowance was mailed, it is thought the Commissioner has no authority to receive the final fee in this case. Section 4885, Revised Statutes, requires that the final fee shall be paid—

not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant.

The law does not require that the applicant shall receive the notice, but merely that it should be sent to him.

In the absence of proof that the notice in this case was not sent the application must be held to be forfeited. This conclusion is in accordance with the ruling in the decision *ex parte Haesler and Taylor* (C. D., 1902, 474; 101 O. G., 2826;) and the decision *ex parte Pieper*, (C. D., 1905, 102; 115 O. G., 1063.)

POPEL-GILLER CO., INC., v. BERGHOFF BREWING ASS'N.

Decided March 10, 1920.

281 O. G., 789.

TRADE-MARKS—BEER AND BEVERAGE COMPOSED IN PART OF MALT AND CONTAINING LESS THAN ONE-HALF OF ONE PER CENT. OF ALCOHOL OF SAME DESCRIPTIVE PROPERTIES.

Beer and a beverage composed in part of malt and containing less than one-half of one per cent. of alcohol were considered of the same descriptive properties prior to the enactment of the prohibition laws. (*Independent Breweries Co.*, C. D., 1912, 559; 182 O. G., 251; 39 App. D. C., 118,) and the enactment of such laws does not furnish any basis for a different ruling.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR NON-INTOXICATING BEVERAGE.

Mr. Arthur E. Wallace for the Popel-Giller Co., Inc.

Mr. Edward H. Merritt for the Berghoff Brewing Ass'n.

COULSTON, Assistant Commissioner:

The Berghoff Brewing Ass'n, the senior party to the above-entitled interference, has appealed from the decision of the Examiner of Interferences adjudging that the Popel-Giller Co., Inc., is entitled to register the mark for which it has made application and that the Berghoff Brewing Ass'n is not entitled to register the mark for which it has made application.

The mark of the Popel-Giller Co., Inc., is the word "Burg," which it seeks to register for a—

non-intoxicating, non-alcoholic cereal maltless beverage sold as a soft drink.

and the mark of the Berghoff Brewing Ass'n is the word "Bergo," which it seeks to register for a—

non-alcoholic, maltless cereal beverage, sold as a soft drink.

There is no contention that either these marks or the goods on which they are used are dissimilar. The question to be decided is one of priority of adoption and use.

If reference be had strictly to the actual marks and goods, the award must go to the Berghoff Brewing Ass'n, because it has introduced testimony establishing the adoption and use of its mark "Bergo" in March or April, 1917, which was considerably prior to the time when the Popel-Giller Co., Inc., first used its mark "Burg" for cereal beverages, such first use by it being shown by its testimony as in June or July, 1918. However, it appears that as early as March or April, 1916, the Popel-Giller Co., Inc., was using the mark "Burgmeister" on cereal beverages. It further appears that a number of its customers ordered these beverages under the name "Burgo" or "Burg" prior to the adoption by the Berghoff Brewing Ass'n of its mark "Bergo." The testimony of the Popel-Giller Co., Inc., also establishes that it had used the mark "Burg" on beer since 1907.

The Court of Appeals of the District of Columbia held, in the case of *in re Independent Breweries Company*, (C. D., 1912, 559; 182 O. G., 251; 39 App. D. C., 118,)* that beer and a beverage composed in part of malt and containing less than one-half of one per cent. of alcohol are goods of the same descriptive properties. I do not see that a mere change in legislation can alter the fact of similarity between goods. If beer and non-alcoholic cereal beverages were similar before prohibition laws were generally enacted throughout the country, they are similar still. Being similar, I think that the trade-mark right which, so far as this record appears, the Popel-Giller Co., Inc., had acquired of the use of the word "Burg" for

beer entitles it to extend the use of that mark to non-alcoholic non-intoxicating cereal beverages of the character for which it has now made application for registration; but I do not think that its use of the word "Burgmeister" on cereal beverages prior to the adoption by the Berghoff Brewing Ass'n of its mark "Bergo" for the same class of goods affords a sufficient basis for the judgment below—that the Popel-Giller Co., Inc., is entitled to the registration of the mark for which it has made application.

The decision of the Examiner of Interferences is affirmed.

MOYER v. ANGLADA.

Decided November 5, 1920.

281 O. G., 789.

1. EVIDENCE—ADMISSIBILITY—TESTIMONY TAKEN IN A PRIOR INTERFERENCE.

The testimony taken in a prior interference of witnesses called in behalf of one of the parties cannot be admitted in a pending interference between the same parties for the purpose of impeaching them where proper foundation was not laid therefor by confronting them with the previous testimony.

2. SAME—ADMISSION OF TESTIMONY OF PARTY TO PROCEEDINGS TAKEN AT FORMER TRIAL.

Where a party to an interference is not called upon to testify, his testimony taken in a prior interference between the same parties may be admitted as an admission on his part, and it is not material that the application is assigned, since the assignee stands upon the same footing as the assignor.

APPEAL on Motion.

VEHICLE-WHEEL RIM.

Messrs Watson, Coit, Morse & Grindle for Moyer.

Mr. Arthur William Nelson for Anglada.

WHITEHEAD, *Commissioner*:

This is an appeal from the decision of the Examiner of Interferences denying Anglada's motion for permission to introduce in this case testimony taken in a prior interference, No. 38,695.

The motion was properly denied in so far as it concerns the testimony of Loomis and Ridge, since it does not appear that any proper foundation was made in the cross-examination of these witnesses for introducing the testimony, which, it is alleged, is for the purpose of impeaching them. It does not appear that they were confronted with the testimony in the prior interference or given an opportunity to make any explanation as to their alleged inconsistencies or contradictions. It is not believed that the party Moyer should now be put to the expense of recalling these witnesses, which could have been

avoided had proper notice been given when the testimony was being taken.

The testimony of Moyer himself, it is thought, stands on a different footing. Moyer is the applicant involved in this interference, and the question is as to the date when he made this invention. The testimony which it is sought to introduce from the prior interference includes a statement by Moyer with reference to this matter. It is true that Moyer did not testify in this interference, and therefore the testimony in the prior interference cannot be offered for the purpose of impeaching him; but it is thought that it can be offered as an admission on his part. (Wigmore on Evidence, sec. 1048.) The fact that Moyer has assigned his application and the interference is being conducted by the assignee is not material, since the assignee stands upon the same footing as the party from whom it derived its title.

No ruling is made as to the weight to be given to this testimony, which is a question for the consideration of the Examiner of Interferences in the first instance.

The decision of the Examiner of Interferences is affirmed in so far as the testimony of Ridge and Loomis is concerned, but reversed in so far as the testimony of Moyer is concerned.

OPINIONS
OF THE
SOLICITOR
AND OF THE
ATTORNEY GENERAL,
1920.

[OPINION OF THE SOLICITOR OF THE DEPARTMENT OF THE
INTERIOR.]

CONSTRUCTION OF THE ACT OF MARCH 19, 1920.

Decided July 13, 1920.

277 O. G., 181.

1. **TRADE-MARKS—ACT OF MARCH 19, 1920, CONSTRUED—MARKS REGISTERABLE UNDER ACT OF 1905 NOT REGISTERABLE UNDER SECTION (b).**

 Marks which are registerable under the Trade-Mark Act of February 20, 1905, are not registerable under section (b) of the act of March 19, 1920.

2. **SAME—SAME—MARKS NOT REGISTERABLE UNDER SECTION (b).**

 In the act of March 19, 1920, providing that the Commissioner shall keep a register of "(b) all other marks not registerable under the act of February 20, 1905, as amended, except those specified in paragraphs (a) and (b) of section 5 of that act," etc., the provision "except those specified in paragraphs (a) and (b)" was intended to include those scheduled under (a) as consisting of or comprising immoral and scandalous matter and those scheduled under (b), consisting of or comprising the flag or coat-of-arms or other insignia of the United States, States, municipalities, or foreign nations and designs, etc., adopted by fraternal and other societies.

3. **SAME—SAME—PROVISO CLAUSE OF SECTION 1 (b) CONSTRUED.**

 The proviso clause of section 1 (b) of the act of March 19, 1920, construed as if it read: "*Provided*, That trade-marks which are *so nearly* identical with a known trade-mark owned and used in interstate and foreign commerce, or commerce with the Indian tribes by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, shall not be placed on this register."

4. **SAME—TRANSFER OF FILING FEE FROM ONE APPLICATION TO ANOTHER.**

 The filing fee of ten dollars paid in connection with an application filed under the act of February 20, 1905, may be transferred to an application for registration under the act of March 19, 1920.

DEPARTMENT OF THE INTERIOR,
OFFICE OF THE SOLICITOR,
Washington, D. C., July 13, 1920.

The honorable the Secretary of the Interior.

DEAR MR. SECRETARY: By letter of June 17, 1920, the Commissioner of Patents requested my opinion respecting certain questions arising

under the recent act of March 19, 1920, (Public No. 163,) entitled "An Act to Give effect to Certain Provisions of the Convention for the Protection of Trade-Marks and Commercial Names, Made and Signed in the City of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other Purposes."

Section 1 of said act provides:

That the Commissioner of Patents shall keep a register of (a) all marks communicated to him by the international bureaus provided for by the Convention for the Protection of Trade-Marks and Commercial Names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, in connection with which the fee of \$50 gold for the international registration established by article 2 of that convention has been paid, which register shall show a facsimile of the mark; the name and residence of the registrant; the number, date, and place of the first registration of the mark, including the date on which application for such registration was filed and the term of such registration, a list of goods to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark.

(b) All other marks not registerable under the act of February 20, 1905, as amended, except those specified in paragraphs (a) and (b) of section 5 of that act, but which have been in *bona fide* use for not less than one year in interstate or foreign commerce, or commerce with the Indian tribes by the proprietor thereof, upon or in connection with any goods of such proprietor upon which a fee of \$10 has been paid to the Commissioner of Patents and such formalities as required by the said Commissioner have been complied with: *Provided*, That trade-marks which are identical with a known trade-mark owned and used in interstate and foreign commerce, or commerce with the Indian tribes by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, shall not be placed on this register.

The questions asked are, in effect, as follows:

(1) Whether marks registerable under the act of February 20, 1905, can be registered under section (b) of the act of March 19, 1920?

(2) What is the scope or limitation of paragraph (b) of section 5 of the act of February 20, 1905, (33 Rev. Stat., 724,) as amended, when considered in connection with the interpretation of the recent act?

(3) Whether the filing fee of ten dollars paid in connection with an application under the act of February 20, 1905, may be transferred to an application for registration under the act of March 19, 1920, or must a new fee be required?

(4) Must a trade-mark be "identical" with a known trade-mark to be subject to rejection, or need it be only so nearly similar to a registered or known trade-mark to justify rejection?

Section 5 of the said act of February 20, 1905, has been amended by the following acts: March 2, 1907, (34 Rev. Stat., 1251;) February 18, 1911, (36 Rev. Stat., 918;) January 8, 1913, (37 Rev. Stat., 649,) and section 9 of the recent act, now under consideration.

My answer to the first question is in the negative, as no reason has been called to my attention, and I see none, for ignoring the express provision of this law that the (b) register shall be kept for—

all other marks *not* registerable under the act of February 20, 1905, as amended, except those specified in paragraphs (a) and (b) of section 5 of that act, etc.

The doubt pertaining to the second question is expressed by the Commissioner, as follows:

Paragraph (b) after referring to State, national or society insignia goes on to specify what marks shall not be registered as well as some that may be registered. Hence the act is not clear as to what is referred to in paragraph (b).

In my opinion the recent act of March 19, 1920, as applied to register (b) therein provided should be construed as if it more specifically read as follows:

All other marks not registerable under the act of February 20, 1905, as amended, except those specified as *not registerable* in paragraphs or schedules (a) and (b) of section 5 of that act, etc.

This is the plain meaning of the law, as it was undoubtedly the intention to continue to deny registration to those marks prohibited registration by paragraphs or schedules (a) and (b) of section 5 of the act of February 20, 1905. In other words, my view is that register (b) provided by the recent act is not intended for any trade-mark registerable under any part of the act of February 20, 1905, nor for registration of any mark not registerable as specified in paragraphs or schedules (a) and (b) of section 5 of that act. The doubt will be relieved and a rational construction of the law will be subserved by considering the reference in the recent act to "paragraphs (a) and (b)" of section 5 of the amended act of February 20, 1905, as meaning *schedules a and b* rather than paragraphs strictly and as comprising the following matters specified as not registerable, viz:

(a) Consists of or comprises immoral or scandalous matter.

(b) Consists of or comprises the flag or coat-of-arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem, or of any name, distinguishing mark, character, emblem, colors, flag, or banner adopted by any institution, organization, club, or society which was incorporated in any State in the United States prior to the date of the adoption and use by the applicant: *Provided*, That said name, distinguishing mark, character, emblem, colors, flag, or banner was adopted and publicly used by said institution, organization, club, or society prior to the date of adoption and use by the applicant.

This was the evident intention, as shown by the congressional hearings on the recent act, and with such construction a field will exist for the operation of the new law; otherwise none would remain.

Replying to question 3, I can see no objection to applying the fee paid in connection with an application under the old law to an ap-

plication under the new law. The amount of the fee is the same in either case, and it would seem it could be applied in perfecting the registration even though the applicable law be other than that originally invoked. If it be deemed necessary to amend the application, that will be merely a detail of procedure.

The fourth question arises from the language of the proviso to section 1 of the recent act above quoted. The word "identical" in its strictest sense means "exactly alike" or "the same in all respects." It is apparent that the word cannot properly be used in this sense as applied in two different objects, because it is axiomatic that no two things are exactly alike; but the word is sometimes used more loosely to mean very similar or the same in essential characteristics. I have no doubt that it is to be so understood in this case. The language of the said proviso would perhaps justify the conclusion that a comparative term, such as "so nearly," was intended to accompany the positive term "identical," so as to harmonize with the further expression "as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers." This view is strongly supported by a similar provision contained in the act of 1905, which prohibits registration of names identical or which so nearly resemble a registered or known trade-mark as to be likely to cause confusion, etc.

Cordially yours,

CHARLES D. MAHAFFIE,
Solicitor.

[OPINION OF THE ATTORNEY-GENERAL.]

CONSTRUCTION OF THE ACT OF MARCH 3, 1883.

Decided March 22, 1920.

274 O. G., 406.

PATENTS—STATUTES—ACT OF MARCH 3, 1883, CONSTRUED.

When a patent issues under the provisions of the act of March 3, 1883, (22 Rev. Stat., 603,) authorizing the Secretary of the Interior and the Commissioner of Patents to grant patents without the payment of any fee to officers of the Government, except officers and employees of the Patent Office, no dedication to the public results, but any person in the United States, including governmental officers and employees, may use the invention disclosed in the patent without the payment of royalty, provided the use be in the prosecution of work for the Federal Government.

DEPARTMENT OF JUSTICE,
Washington, D. C., March 22, 1920.

SIR: This is in compliance with your request of November 24, 1919, for my opinion as to whether or not the act of March 3, 1883, (22

Rev. Stat., 603,) operates to dedicate to the public inventions disclosed in patents issued thereunder.

The act reads:

The Secretary of the Interior and the Commissioner of Patents are authorized to grant any officer of the Government, except officers and employees of the Patent Office, a patent for any invention of the classes mentioned in section forty-eight hundred and eighty-six of the Revised Statutes, when such invention is used or to be used in the public service, without the payment of any fee: *Provided*, That the applicant in his application shall state that the invention described therein, if patented, may be used by the Government or any of its officers or employees in the prosecution of work for the Government, or by any other person in the United States, without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

It is my opinion that when a patent issues under the provisions of this act no dedication to the public results, but that any person in the United States, including governmental officers and employees, may use the invention disclosed in the patent without the payment of royalty, provided the use be in the prosecution of work for the Federal Government. This conclusion is in accord with that reached by the Judge-Advocate General of the Army in his opinion dated November 30, 1918. (C. D., 1919, 133; 260 O. G., 733.)

As far as I can learn no court has passed upon this question, and diligent search of the records of Congress in an effort to find some expression of the intent of this act in records of debate or minutes of committee has been unavailing. Consequently I have recourse only to the act itself and the natural inferences to be drawn from it.

The view that the act works a dedication of the invention to the public has been advanced; but it is a view with which I am unable to agree.

The Constitution of the United States gave to Congress the power (Art. I, sec. 8, clause 8)—

to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.

By virtue of the power thus vested in it Congress enacted the patent statutes, sections 4884 and 4886, Revised Statutes, being particularly in point on the present question.

These sections read:

Sec. 4884. Every patent shall contain a short title or description of the invention or discovery correctly indicating its nature and design, and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use, and vend the invention or discovery throughout the United States and the Territories thereof, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Sec. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful

improvement thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.

By the enactment of section 4886, Revised Statutes, Congress gave the name "patent" to the "exclusive right" alluded to in the Constitution, and by the enactment of section 4884, Revised Statutes, it defined the "exclusive right" or "patent" as the exclusive right to make, use, and vend the invention throughout the United States and the Territories thereof for a period of seventeen years. (*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, C. D., 1908, 594; 136 O. G., 1297; 210 U. S., 405; *Patterson v. Kentucky*, 97 U. S., 501; *Bloomer v. McQuewan*, 55 U. S., 539; *Grant v. Raymond*, 31 U. S., 217.)

It therefore follows, logically, that when Congress in the act of March 3, 1883, authorized the Secretary of the Interior and the Commissioner of Patents to grant a *patent* it authorized the grant of the exclusive right to make, use, and vend the invention. Hence if the act be interpreted to mean that the invention is dedicated to the public by operation thereof the applicant would be granted no exclusive right and would obtain no patent except in name. The instrument, although called a patent, would be practically tantamount to a mere publication of the invention and effective only to prohibit the obtaining of a valid patent for the same invention by a later inventor. Obviously it was unnecessary to enact a statute to produce this effect, for the same result was attainable by disclosure of the invention in a publication. As a matter of fact, the disclosure in a publication would probably be easier and less expensive, for it would obviate the necessity of the filing, prosecution, and examination of a formal patent application.

But if the act be interpreted to mean that the Government would acquire only such rights in the invention as I have hereinbefore defined a patent monopoly would be granted to the applicant, subject only to such rights in or on behalf of the Government. The applicant would receive the patent, the Government its benefits thereunder, and the apparent intention of Congress would be satisfied.

A patent is a contract between the United States and the patentee, wherein the consideration flowing from the United States to the patentee resides in the grant of the exclusive right to make, use, and vend the invention of the patent for a limited time, while the consideration flowing from the patentee to the United States is the dedication of the invention to the public at the expiration of said limited time. (*Denning Wire & Fence Co. v. American Steel & Wire*

Co., 169 Fed. Rep., 793; *Century Electric Co. v. Westinghouse Electric & Mfg. Co.*, C. D., 1914, 267; 207 O. G., 1249; 191 Fed. Rep., 350.) It is evident that if no monopoly be granted the consideration on the one hand fails and the contract (and therefore the patent) does not come into existence.

If Congress intended that every person in the United States might use the invention without the payment of royalty, it was obviously unnecessary to require the applicant to state anything but that the invention could be so used by the Government *or any person in the United States*. The expression—

or any of its officers or employees in the prosecution of work for the Government—

would be unnecessary and mere surplusage. But these phrases cannot be regarded as surplusage, and evidently the intent of that portion of the act may be accurately expressed by considering the expression “or any other person in the United States” to mean “or any other person in the United States in the prosecution of work for the Federal Government.”

Again, if the expression “or any other person in the United States” be construed to mean “or any other person in the United States in the prosecution of any work, either governmental or private” the general public would appear to obtain greater rights in the inventions of the patents issued under the act than governmental officers and employees, since the latter would obtain merely the right to use the inventions “in the prosecution of work for the Government.” It seems hardly conceivable that Congress could have intended so to discriminate against the officers and employees of the Government.

It was clearly the intention of Congress to encourage the filing of applications under the act, so that such rights as defined above would be available to the Government. To construe the statute to mean that the invention would be dedicated to the public would defeat the very purpose for which the statute was enacted, since it would discourage rather than encourage the filing of applications under the act. That this would be the result cannot be denied, for we have tangible evidence to that effect in your statement:

There are also many cases in which employees of the Government have declined to make applications for patents under this statute because of the doubt as to its proper interpretation and the possibility of a dedication of the invention to the public.

Such an attitude on the part of inventors as you mention in your communication is not to be wondered at, for if in filing applications under the act in question the inventor effects a dedication of practically all his rights therein to the public he loses all to which he

otherwise would be entitled and receives nothing in return. Surely it is no serious consideration that he is relieved of the payment of the usual Patent Office fees. Were he not, he would be in the anomalous situation of dedicating his rights to the public and paying for the privilege of doing so.

Respectfully,

C. B. AMES,
Acting Attorney-General.

The SECRETARY OF WAR, Washington, D. C.

DECISIONS
OF THE
UNITED STATES COURTS
IN
PATENT CASES
FOR
THE YEAR 1920

[Supreme Court of the District of Columbia.]

MATTULLATH AEROPLANE COMPANY *v.* NEWTON, COMMISSIONER OF
PATENTS.

Decided April 8, 1920.

279 O. G., 730.

1. SUITS IN EQUITY UNDER SECTION 4915, REVISED STATUTES—TIME FOR FILING.

Where a patent on an application is refused by the Court of Appeals of the District of Columbia and the applicant files a bill in equity under section 4915, Revised Statutes, the year within which the bill must be filed begins to run from the date of the decision of the court, and this time is not extended by a motion for rehearing.

2. SAME—NATURE OF ACTION—NOT AN APPEAL.

An action taken under the provisions of section 4915 is not an appeal from the Commissioner of Patents, but is one of original equity jurisdiction.

Mr. W. H. Swenarton for Mattullath Aeroplane Company.

Mr. T. A. Hostetler for the Commissioner of Patents.

GOULD, J.:

The bill in this case was filed on February 23, 1918, under section 4915, Rev. Stats. U. S., plaintiff seeking a decree that it was entitled to receive a patent for an invention connected with flying-machines. The bill recites that the original application was rejected by the Patent Office, April 25, 1916; that an appeal was taken to the Court of Appeals of the District of Columbia, and that "on or about the 26th day of February, 1917," the court of appeals transmitted to the Commissioner of Patents its mandate affirming the said decision.

The case is before this court on a motion to dismiss the bill on the ground that the suit was not brought within one year after the decision of the court of appeals refusing the patent. As heretofore

stated on the face of the bill, it is alleged that the decision of the court of appeals, affirming the decision of the Commissioner of Patents rejecting plaintiff's application, was transmitted to the Commissioner of Patents "on or about the 26th day of February, 1917." As the bill was filed February 23, 1918, it would appear to have been filed within one year from the decision of the court of appeals.

It appears, however, from the brief filed for the Commissioner of Patents, that the decision of that official was affirmed by the court of appeals on February 5, 1917, and that would appear to be borne out by the record in the case (*in re Matbullath Aeroplane Company*, C. D., 1917, 141; 238 O. G., 650; 46 App. D. C., 143,) where the recital is that the case was decided by the court February 5, 1917, affirming the Commissioner in rejecting the application. This is not denied in the brief filed for the plaintiff, the latter's contention being that by reason of having filed on February 21, 1917, "a motion for reargument and modification of the opinion," which was denied on February 24, 1917, the year during which he might file his bill under section 4915, did not begin to run until the latter date, thus bringing the filing of the present bill within the year from the refusal of the application, so that the question before the court is simply this:

Did the filing of the motion for reargument by the plaintiff, and the denial thereof by the court, extend the time during which plaintiff could file his bill?

Section 4915 above referred to, reads as follows:

Whenever a patent or application is refused either by the Commissioner of Patents or by the Supreme Court of the District of Columbia, upon appeal from the Commissioner, the applicant may have remedy by a bill in equity.

The Supreme Court of the United States in *Gandy v. Marble* (C. D., 1887, 413; 39 O. G., 1423; 122 U. S., 432) held that the time for bringing suits under section 4915, above referred to, was governed by section 4894, Rev. Stats. U. S., which reads as follows:

All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

The same conclusion was reached in the case of *Westinghouse Electric Company v. Ohio Brass Company*, (C. D., 1911, 259; 169 O. G., 204; 186 Fed. Rep., 518.)

The contention of the plaintiff that the motion for rehearing extended the time for appeal is answered by the decision of the Court of Appeals in *Ross v. Loewer*, (C. D., 1896, 665; 77 O. G., 2141; 9 App. D. C., 563,) where it was held that a motion for rehearing

does not suspend or extend the time for taking appeals from the Commissioner of Patents to that court.

In the course of its opinion the court said :

The procedures of the Patent office are not controlled by the usual rules of practice, but are controlled by statutory provisions and a code of rules made in pursuance of the statutory provisions wholly unlike the rules of practice enforced in the courts.

No provisions are found either in the rules of the Patent Office, the court of appeals, or in any statute, whereby the right of filing a motion for rehearing is given. That being so, and on appeal from the decision of the Commissioner of Patents to the court of appeals being a part of the procedure fixed by statute for patent cases, it does not include motions or petitions for rehearing as in equity or in cases at law. The bill in equity, filed under section 4915, is not an appeal from the Commissioner of Patents, but is one of original equity jurisdiction. *Appert v. Brownsville Plate Glass Co.*, (144 Fed. Rep., 115;) *Butterworth v. Hoe*, (C. D., 1884, 429; 29 O. G., 615; 112 U. S., 50.)

Restating the facts: The case of *in re Mattullath Aeroplane Company* was an appeal from the decision of the Commissioner of Patents, granted by statute and governed by the rules fixed in accordance with the statute which failed to provide for a motion for rehearing. The present case, brought under section 4915, is by the terms of that section a bill in equity which may be filed whenever an application is refused either by the Commissioner of Patents or by the court of appeals. In this case the patent was finally refused on February 5, 1917, by the court of appeals, and this action not being brought within one year from that time as required by section 4894, the *motion to dismiss must be sustained.*

[U. S. District Court—Northern District of Ohio, Eastern Division.]

VAN KANNEL REVOLVING DOOR CO. v. WINTON HOTEL CO.

Decided March 8, 1920.

276 O. G., 406; 263 Fed. Rep., 988.

1. PATENTS—REVOLVING DOOR—ANTICIPATED BY EARLIER PATENT TO SAME INVENTOR.

Claims 1, 2, 3, 13, 22, 23, and 24 of the Van Kannel Reissue Patent No. 14,255, for an automatically-collapsible revolving door, *Held* invalid, as anticipated by Patent No. 658,062, issued to the same inventor and now expired.

2. SAME.—PIONEER PATENTEE CANNOT PROLONG MONOPOLY BY PATENTING ONE FEATURE OF THE DEVICE.

Where an inventor of an automatically-collapsible revolving door was granted a pioneer patent and insisted upon and obtained a construction so

broad that any form of double-acting hinge or of a releasing device was an infringement, he could not prolong his patent monopoly by subsequently obtaining a patent for some one form of double-acting hinge or self-releasing or collapsible device.

3. SAME—CONSTRUCTION INFRINGING PATENT MAY BE MADE AND SOLD AFTER EXPIRATION OF PATENT.

A construction which was anticipated by a patent and condemned as an infringement of it may be freely made and sold after such patent has expired.

4. JUDGMENT—PATENTS—PARTY CONDUCTING DEFENSE IS BOUND BY AND ENTITLED TO BENEFIT OF JUDGMENT, BUT NOT REQUIRED TO BECOME PARTY.

A corporation employing counsel appearing for defendant in a patent infringement suit and conducting the defense at its own cost and expense is a privy to any judgment rendered and bound thereby, but was not required to become a party to the record.

IN EQUITY. Suit by the Van Kannel Revolving Door Company against the Winton Hotel Company. *Bill dismissed.*

Mr. Titian W. Johnson and Messrs. Hull, Smith, Brock, & West for the plaintiff.

Messrs. Trabue, Doolan, Helm & Helm and Messrs. Christopher & Robblee for the defendant.

WESTENHAVER, Dist. J.:

Plaintiff's bill is based upon Reissue Patent No. 14,255, reissued February 6, 1917, being a reissue of original United States Letters Patent No. 836,843, issued to T. Van Kannel November 27, 1906. The invention claimed therein relates to an automatically-collapsible revolving door, such as is commonly used at the street-entrance to public buildings. The defendant has purchased, installed, and is using a collapsible revolving door manufactured and sold by the Atchison Revolving Door Company, which has assumed and undertaken the burden and expense of defending this suit. The defenses are (a) that the claims in issue of this reissue patent are void for lack of novelty and lack of invention; (b) that it is void because no inadvertence, accident, or mistake is shown whereby the original patent is inoperative or invalid; and, even if so, the reissue was not applied for with due diligence; and (c) that, if valid at all, these claims must, in view of the prior art, as declared by numerous decisions, be so limited that defendant's door does not infringe.

(1) The claims in issue of this reissue patent are Nos. 1, 2, 3, 13, 22, 23, and 24. Of these the first four are rewritten and rephrased claims of the original patent, and the remaining three are new or added claims. Claims 1, 2, 3, and 22 cover in various forms, as the predominating element, a flexible tie connecting together and holding in position the radial wings of the door, automatically releasable, whereby, upon the release of any one, all the wings will fold or collapse. Claims 3 and 23 cover in various forms as a predominant-

ing element a hanger disk or plate, with grooves therein located in the spindle or center post, serving as hinges for the radial wings, whereby a series of wings may be collapsed to a folded position. Claim 24 embodies both elements of hanger-plates with grooves and flexible ties. Upon the issue of invalidity for lack of novelty and lack of invention defendant contends that all these claims are in substance and legal effect the same as claims 1, 2, 3, 13, and 14 of original Patent No. 836,843, all of which have, in one case or another, been held to be invalid. The differences, if any, between the reissue and the original claims can be most conveniently stated after a brief review of this prior litigation and of the results reached therein.

The inventor, Van Kannel, was in 1888 granted a patent, being No. 387,571, for a revolving door, having a series of radiating wings, rotating in a casing. It did not have any automatic or collapsible features, although the desirability of providing for the egress of an excited or panic-stricken crowd was foreseen and disclosed therein. On August 14, 1900, he was granted Patent No. 656,062 for an automatically-collapsible revolving door, designed to provide for rapid exit by automatic collapse in the event of panic or other necessity therefor. Later, on November 27, 1906, he was granted an additional patent for an automatically-collapsible revolving door, being No. 836,843, of which the one now involved is a reissue. The 1900 and the 1906 patents have been extensively litigated, and defendant contends that all questions touching the validity of the claims now in dispute of the reissue patent have been fully considered and adjudged adversely to plaintiff's present contentions. These decisions are as follows: *Van Kannel v. Revolving Door & Fixture Co.*, (2 C. C. A.; 219 Fed. Rep., 741; 135 C. C. A., 439;) *Louisville Trust Co. v. Van Kannel* (6 C. C. A.; 231 Fed. Rep., 166; 145 C. C. A., 354;) *Van Kannel Revolving Door Co. v. Nathan Straus*, (2 C. C. A.; 235 Fed. Rep., 135; 148 C. C. A., 629;) *Van Kannel Revolving Door Co. v. Lyon & Healy*, (7 C. C. A.; 247 Fed. Rep., 329; 159 C. C. A., 423;) *Van Kannel Revolving Door Co. v. Uhrich*, (decision and opinion by Pollock, district judge, 247 Fed. Rep. 344.)

The nature and elements of plaintiff's invention and of the state of the art respecting revolving doors are so fully stated and described in these several decisions that it is unnecessary to go over the same ground. The conclusions reached in these cases are in accord; indeed, there is an unusual uniformity, not only in the result, but in the reasoning by which the results have been reached. Briefly, my understanding of these decisions is that the Van Kannel 1900 patent, No. 656,062, was held to be the pioneer patent for an automatically-collapsible or panic-proof revolving door, and that the inventor was entitled to a wide range of mechanical equivalents, and his patent claims to a reasonably broad construction. More specifically, as re-

guards devices for hinging the radial wings to the spindle or center posts, and devices for connecting or tying the radial wings in an automatically-detachable manner, it was held that any device which would produce substantially the same result was an infringement. Accordingly the 1900 patent was in all these cases uniformly sustained, and its claims protected against infringement, as against any construction having any form of hinge or tying device which permitted these results to be realized. On the other hand, and in view of this broad construction, the more specific and detailed combinations embodied in the litigated claims of the 1906 patent, No. 836,843, were held to be invalid for lack of invention, as double patenting to the same inventor. Nor do I understand that this invalidity resulted from the particular phraseology used in the later patent in describing the connecting device.

Thus, in *Van Kannel Revolving Door Co. v. Revolving Door & Fixture Co.* (219 Fed. Rep., 741; 135 C. C. A., 439) Mayer, district judge, had sustained the validity of claims 1, 2, 3, and 8 of the earlier patent, and of claims 13 and 14 of the later patent, and had held that claims 1 and 2 of the later patent were invalid. This holding as to claims 1 and 2 of the later patent is based upon the disclosures of the earlier patent, but as to claims 13 and 14 he held that they stated a combination of elements from which—

we have apparently, a new structure in commerce, a new result for operative panic-proof doors, and all described with words of limitation sufficiently definite and limited to save the combination from all the prior art.

The circuit court of appeals, second circuit, sustained this decision, except so far as it found claims 13 and 14 to be valid, and reversed as to these, holding that they also were anticipated by the disclosures of the earlier patent. Judge Mayer had stressed particularly this feature of the flexible tie, and the great merit thereof in permitting all the doors to collapse upon the release of any one fastening, and the easy restoration of all the wings to their normal position; but Circuit Judge Lacombe, who delivered the opinion, said as to these claims that they were merely an attempt to extend the monopoly of the earlier patent by changing the names of the various elements or the location of the folding device, or by merely combining old elements which would be evident to an ordinary mechanic. The construction held to infringe was not defendant's present construction, but the tying devices for holding together the wings, it was held, did not avoid infringement, even though they were made of such fragile construction as to be breakable rather than automatically releasable.

In *Louisville Trust Co. v. Van Kannel Revolving Door Co.* (231 Fed. Rep., 166; 145 C. C. A., 354) the decision of the lower court, which held claims 1, 2, and 13 of the 1906 patent valid and infringed,

was reversed by the sixth circuit court of appeals. As to claim 13, this reversal was on the ground that the device for connecting the radial wings together was a bar, instead of a cord or strap or other flexible device, and it was not, therefore, the flexible tie which was supposed to give novelty and patentability to this claim. I do not understand Judge Knappen's opinion as expressing any dissent from the decision of the second circuit court of appeals, nor any intimation that the claim would be upheld, if it were so narrowed as to be limited to a flexible tying device, but merely that, inasmuch as infringement was not shown, no expression of opinion in that respect was called for. The reasoning of the opinion seems to me to lead to the conclusion that claim 13 was anticipated by the 1900 patent, as claims 1 and 2 were held to be anticipated.

In *Van Kannel Revolving Door Co. v. Straus* (235 Fed. Rep., 135; 148 C. C. A., 629) the claims of the 1906 patent were not put in issue, but only those of the 1900 patent. These claims were not only sustained, but were given a construction so broad that the phrases "automatically unlocked" and "self-releasing locking devices," used therein, should cover any device which has been deliberately planned, whether by mechanical adjustment or by the proper proportioning of the parts, to effect the release of the wings at the proper moment without the interposition of any human agency, and that the phrases used therein of "a series of wings mounted so as to swing independently" and "swing forwardly to project side by side" should cover any mounting devices which substantially accomplishes that purpose, even though all of the wings are not so mounted. It was accordingly held that a construction embodying a series of wings, three only of which were mounted to swing independently of their joint rotating movement, and in which the so-called "self-releasing locking device" consisted of chains constructed so weakly as to break under the normal pressure of a panic-stricken crowd, was an infringement.

However, in *Van Kannel Revolving Door Co. v. Lyon & Healy* (247 Fed. Rep., 329; 159 C. C. A., 423) and in *Van Kannel Revolving Door Co. v. Uhrich* (D. C., 247 Fed. Rep., 344) the construction held to infringe the 1900 patent was precisely the same as that involved in this case. It had the same form of hinge, called by defendant a "trammel hinge," and the same flexible automatically-releasing tie for holding the adjacent faces of the wings together. In the first case the district court had held claims 1, 2, and 8 of Patent 656,062 and claim 3 of Patent 836,843 invalid. The appeal as to claim 3 of the latter patent seems either to have been dismissed, or the assignment of error with respect thereto not insisted upon, so that no discussion of it is found in the opinion of the seventh circuit court

of appeals, but claims 1, 2, and 8 of the earlier patent were sustained and given the same broad construction as had been previously given thereto by the earlier decisions already reviewed. Defendant's plate, called a "trammel hinge," was held to be a mechanical equivalent of the hinge or wings whereby in the 1900 patent the radial wings were folded together, and the tie or device for connecting the adjacent wings and permitting all to fold upon the release of any one was held to be a mechanical equivalent of the self-releasing locking device called for by the 1900 patent. Judge Pollock's holding in the other case is precisely the same as to the 1900 patent, and as to claim 3 his holding is that it also was invalid in view of the disclosures of the earlier patent.

Thus it appears that the earlier or 1900 patent has been uniformly upheld, and that no claim ever put in issue of the later or 1906 patent has been upheld, but, on the contrary, has been uniformly held to be invalid. The plaintiff has thus obtained from numerous courts a construction of the 1900 patent that is infringed by any form of double-acting hinges applied to all or any part of the wings, and by any form of self-releasing devices, wherever located and of whatever construction. In other words, the 1900 patent has been held to be a pioneer patent entitled to a broad construction, and to a wide range of mechanical equivalents, and is infringed by any form of automatically-collapsible panic-proof doors containing any form of double-acting hinge, or any form of device designed to release the wings automatically, whether by breaking or otherwise. The consequence of these holdings has been that the later or 1906 patent has been held to be invalid for the same reasons that other constructions have been held to be infringements. Certainly it is now too late for any district court to do more than accept fully and apply consistently these several decisions.

The claims now in issue of the reissue patent must be held invalid, unless there is a new patentable element embodied therein, not anticipated in the litigated claims of the 1900 or the 1906 patents. The differences between the claims of the reissue patent and of these earlier patents can be clearly shown only by examining them side by side. It would expand this opinion unduly to quote these claims in parallel columns and point out in detail the points of resemblances and differences. This, however, I have done with care, and as a result am convinced that the changes are in phraseology only, and not in substance. The claims have been merely rewritten and rephrased as respects claims 1, 2, 13, and 23 therein, with a more specific description of the connecting device, so as to limit it to a flexible tie, and to this extent only may these claims be said to be narrowed. As to claims 3, 23, and 24 a hanger plate is substituted for a hanger-disk of the earlier claims, and this defendant contends, not without

reason, is broadening intentionally these claims, so as to cover its trammel-hinge, already held to be an infringement of the 1900 patent; but, as already said, an examination side by side forces the conclusion that these claims have been merely rewritten and rephrased, with the view and in the hope of escaping the adverse decisions of numerous Federal courts. No new or patentable combination is disclosed thereby, which would not be an infringement of the earlier or 1900 patent.

(2, 3) Certainly, under the construction already given the 1900 patent, a revolving door, constructed in accordance therewith, would be condemned as an infringement. An inventor who has been granted a pioneer patent, and who has insisted upon and obtained a construction therefor so broad that any form of double-acting hinge or of a releasing device is an infringement, can not prolong his patent monopoly by subsequently obtaining a patent for some one form of double-acting hinge or self-releasing or collapsible device. Plaintiff's contention merely comes to this: Defendant's present construction has been held to be an infringement of the 1900 patent, because its hinging and its releasing devices are equivalents of the hinging and releasing devices of that patent. It would be an absurd distortion of the patent law now to hold that a construction which was anticipated by a patent, and condemned as an infringement of it, may not be freely made and sold after that patent had expired. This, it seems to me, is what plaintiff is seeking to accomplish.

This conclusion renders unnecessary an examination of the second defense relied on, namely, that no inadvertence, accident, or mistake is shown in the original patent as a basis for the reissue, and that, even if it were, due diligence was not exercised in applying for the reissue. The validity of the 1906 patent was at an issue many years before the reissue was applied for, it was held invalid by the second circuit court of appeals December 15, 1914, and its validity was insisted upon thereafter in this circuit, resulting in an adverse decision March 17, 1916. The application for a reissue, it is urged, was induced by these failures, and not as a result of any inadvertence, accident, or mistake. It would be difficult, it seems to me, either on the facts or in principle to distinguish this case from *Milloy Electric Co. v. Thompson-Houston Electric Co.* (6 C. C. A.; 148 Fed. Rep., 843; 78 C. C. A., 533); but I deem it unnecessary to consider or express an opinion thereon. Likewise it becomes unnecessary to consider or express an opinion as to whether or not, even if any claims of the reissue patent should be held valid, they must be given a construction so narrow as not to include present form of hinging and releasing devices.

(4) Plaintiff, after this cause was heard and submitted for decision, filed a motion to make the Atchison Revolving Door Company

a defendant. This motion is based upon admission made at the hearing that this company had employed the counsel appearing for defendant, and was conducting the defense at its own cost and expense. Undoubtedly, upon these admissions, the Atchison Revolving Door Company is privy to any judgment as may be rendered herein, and is bound thereby. (See *Elliott Co. v. Roto Co.*, 2 C. C. A.; 242 Fed. Rep., 941; 155 C. C. A., 529; *David Bradley Mfg. Co. v. Eagle Manufacturing Co.*, C. D., 1894, 121; 66 O. G., 315; 7 C. C. A.; 57 Fed. Rep., 980; 6 C. C. A., 661.) But I do not understand that one thus assuming the burden of a defense is required to become a party to the record, especially as, under the law, no such action is necessary to make the decree binding upon him.

This motion will be denied. Plaintiff's bill will be dismissed, at its costs.

[U. S. District Court, Northern District of New York.]

BARBER v. OTIS MOTOR SALES CO.

Decided May 22, 1920.

280 O. G., 810; 265 Fed. Rep., 675.

1. PATENTS—FOREIGN ANTICIPATIONS MUST HAVE BECOME PATENTS OR PUBLICATIONS BEFORE INVENTION AND TWO YEARS BEFORE APPLICATION.

Under Revised Statutes, section 4886, as amended, (Comp. St., section 9430,) foreign patents to be available to defeat a United States patent for the same invention must have become patents or printed publications in foreign countries before the date of the United States invention, or more than two years before the application for the United States patent was filed.

2. SAME—BRITISH AND FRENCH PATENTS DATE AS ANTICIPATIONS FROM ENROLLMENT; "PRINTED PUBLICATIONS."

British and French patents do not become "patents," or "printed publications," within the meaning of the patent statutes, until the enrollment or sealing of the complete specifications, so that they cannot defeat a United States patent, unless enrolled before the invention or two years before the application.

3. SAME—EVIDENCE HELD TO SHOW INVENTION ANTEDATED FOREIGN PATENTS.

Evidence by the inventor and others, showing drawings, patterns, and an experimental machine involving the invention, *Held* to show invention before the date of enrollment of foreign patents, which were enrolled less than two years before the application for United States patent.

4. SAME—AGAINST ANTICIPATION, INVENTOR MAY SHOW DATE OF INVENTION BY COMPETENT PROOF.

Where defendant makes no rival claim to priority of invention, but relies on the statutory defense of anticipation, the patentee may show, if he can, the fact of his prior invention by drawings, sketches, models, or any other competent proofs.

In equity. Suit to restrain infringement of patent by William Barber against the Otis Motor Sales Company. *Decree ordered for plaintiff.*

See, also, 247 Fed. Rep., 553.

STATEMENT OF THE CASE.

This is an action in equity to restrain alleged infringement of United States Letters Patent No. 781,802, dated February 7, 1905, for "valves and valve gear for explosive engines," and which patent was applied for February 24, 1902. The case originally came on for final hearing on pleadings and proof on November 18, 1915, and this court, after consideration of the proofs and of the prior art, reached the conclusion that the Barber patent was valid and infringed by the defendant. (231 Fed. Rep., 755.) On appeal to the United States Circuit Court of Appeals for the Second Circuit the conclusions of this court were affirmed and a petition for rehearing denied. (240 Fed. Rep., 723; 153 C. C. A., 521.) Thereafter accounting proceedings were inaugurated under the decree and the mandate of the Court of Appeals. Subsequently the Barber patent here in suit came before Judge Hazel in the case of *Barber v. Reo Motor Car Sales Co.*, in the District Court for the Southern District of New York, upon additional prior art patents, which were not before and were not considered by this court in its original consideration of this suit. Judge Hazel reached the conclusion that the Barber patent must be limited by the new prior art set up, and when so limited was not infringed by the defendant. (245 Fed. Rep., 938.) Thereafter motion was made for the court to request the recall of the mandate of the Court of Appeals, in order that jurisdiction might be restored to this court to hear and consider a motion to suspend the accounting and a rehearing or retrial of this case on the new prior art patents set up before and considered by Judge Hazel in *Barber v. Reo Motor Car Sales Co.* These motions were granted and the mandate of the Circuit Court of Appeals has been recalled. The case now comes before this court for final determination on proofs submitted by both parties, based on the alleged new prior art patent referred to.

Fred F. Weiss (Samuel E. Darby, of counsel) for the plaintiff.

Messrs. Wetmore & Jenner (Robt. D. Eggleston, Lawrence E. Sexton and Harry G. Kimball, of counsel) for the defendant.

RAY, Dis. J., (after stating the facts as above:)

The Barber patent, No. 781,802, has been before this court repeatedly in various litigations, and after most careful study of the numerous prior art patents, presented to the court in the various litigations to which said patent has been subjected, it has success-

fully withstood the attacks made upon its validity. The structure which the Barber patent shows and describes, the invention which it defines in claims 8 and 9 thereof, these being the claims here involved, the problem which this invention successfully and satisfactorily solves, and the conclusions reached after a careful and painstaking examination and study of the prior art patents heretofore set up against it, in this case and in other cases in which the patent is involved, are fully set forth in the opinions of this court (231 Fed. Rep., 755) and of the Circuit Court of Appeals, (240 Fed. Rep., 723; 153 C. C. A., 521,) and they need not be repeated here. For present purposes it is sufficient to say that on the original hearing in this case this court held:

The evidence shows and it is well known that the valves of motor-engines frequently get out of order and require cleaning and repairs of various kinds. A construction which is safe and of reasonable cost, and which will enable the owner to remove and replace these valves speedily and cheaply and without injury to the motor engine, is therefore of great value. Here was the problem which confronted Mr. Barber, the inventor in this case, and the evidence shows that he solved the problem satisfactorily, and that his invention went into use, and that this defendant and others have appropriated it, to his damage and injury. Mr. Barber has not been guilty of any laches in endeavoring to enforce his rights. He is not a man of wealth, but this is no reason why courts should not give him the same consideration they would give wealthy men or wealthy corporations. I find and hold that the structure of the patentee discloses patentable invention in view of the prior art and that there is no anticipation.

The defendant placed in evidence more than twenty different patents, but no one of them shows the combination of Mr. Barber, and no one of them shows a combination of elements which solves the problem presented to Mr. Barber, and which he successfully solved. There is no one element in the combination of Mr. Barber which is absolutely or entirely new; but he has a new combination and a useful combination of old elements, and the making of this combination discloses patentable invention of a high order. His invention has been availed of by others, and several have taken a license under his patent, while others are boldly infringing. The defendant in this case struggled vainly to show a combination in any prior patent which solves the problem presented to this complainant. The defendant presented patents which disclose one or more of the elements found in the Barber patent, but it has been held again and again that a new and useful combination of old elements which results in a new structure of utility, and which the ordinary mechanic skilled in the art would not have produced, constitutes patentable invention.

Again, at page 761 of 231 Fed. Rep.:

It is vain to search the prior art for a construction and combination like this. Each and every patent in evidence, which shows a valve cage, or a screw plug, or a combination of both, has one or more obstructions to a removal of these parts, which interfere with the removal of the valves. Various of these patents show that efforts had been made in the direction of securing a quick removal of the valves, but no one had fully solved the problem until Barber came into the field. In a sense and to an extent, at least, he is a pioneer. In

but one or two of the prior patents is any reference made to the problem which Barber sought to solve.

The Circuit Court of Appeals, after quoting the last paragraph above quoted from the opinion of this court, said at page 726 of 240 Fed. Rep., (153 C. C. A., 524:)

It will serve no good purpose for this court to traverse step by step the ground which the district judge has very carefully gone over in his opinion. It must suffice to say that our examination of the patent and of the patents of the prior art fails to convince us that any mistake was made by the District Judge in sustaining the validity of this patent.

On this retrial, however, additional patents alleged to be in the prior art, and which have not been specifically presented to this court before, are set up, and proofs have been presented by both parties with respect thereto. Of the new patents alleged to be of the prior art now set up in this case the Hirsch United States patent, No. 532,555, and the Carling British patent, No. 110 of 1891, may be dismissed from consideration, for the reason that these patents are not directed toward the problem of providing for the quick, easy, and convenient removal of the valves, which is the problem with which the Barber patent in suit deals, but are directed toward a different object and purpose. This is also the view of Judge Hazel in connection with the Hirsch patent. The Fessard United States patent, No. 639,160, may likewise be eliminated for the same reason. Moreover, the valve of this patent is of the flanged type. It was the purpose of the Barber invention to avoid the use of that type of valve and the difficulties incident to such use. This is also the view taken by Judge Hazel with regard to the Otto engine valve cage device.

This leaves for consideration the British patents to Bousfield, No. 5,230 of 1899; to Hall, No. 4,191 of 1899, and to Jerram, No. 3,720 of 1900, and the French patent to Wohlgrath, No. 296,244 of 1900. These foreign patents can be availed of to defeat the Barber patent, assuming that they are for the same invention as that claimed in the Barber patent, only in case they become patents or printed publications in the foreign countries before the date Barber made the invention of his patent, or more than two years before Barber filed the application for his patent. The wording of the statute (sec. 4886, Rev. Stat., 29 Stat., 692 [Comp. St., sec. 9430]) is:

Any person who has invented or discovered any new and useful art machine,
* * * not patented or described in any printed publication in this or any
foreign country, before his invention or discovery thereof, or more than two
years prior to his application * * *

may obtain a patent. It is necessary, therefore, in the present case, to ascertain the dates when the Bousfield, Hall, Jerram, and Wohlgrath patents became "patents" or "printed publications" within

the meaning of the statute and then to ascertain whether or not these respective dates, or any one of them, was prior to the date when Barber made his invention or was more than two years prior to the date on which Barber made application for his patent. The Barber application was filed February 24, 1902. Did any of these foreign patents become a "patent" or a "printed publication" earlier than February 24, 1902?

[2] The evidence shows that the Bousfield British patent was applied for March 9, 1899, the application was accepted January 20, 1900, and the patent was sealed or enrolled *April 3, 1900*. The Hall British patent was applied for February 25, 1899, the application was accepted February 24, 1900, and the patent was sealed or enrolled *May 8, 1900*. The Jerram British patent was applied for February 26, 1900, the application was accepted March 31, 1900, and the patent was sealed or enrolled *June 12, 1900*. The Wohlgrath French patent was applied for January 17, 1900, and was granted *May 3, 1900*. It has been repeatedly held that British and French patents do not become "patents" nor "printed publications" within the meaning of the patent statutes of this country until the enrollment or sealing of the complete specifications. (*Ireson v. Pirece*, C. C.; 39 Fed. Rep., 795; *American Roll-Paper Co. v. Weston*, C. C.; 45 Fed. Rep., 686; *Sirocco Engineering Co. v. Sturtevant*, C. D., 1915, 194; 213 O. G., 1447; 220 Fed. Rep., 137; 136 C. C. A., 91; *Electrical Accumulator Co. v. Julien Electric Co.*, C. C.; 38 Fed. Rep., 117; *Bliss v. Merrill*, C. C.; C. D., 1885, 182; 42 O. G., 97; 33 Fed. Rep., 39; *Walker on Patents*, 5th Ed., sec. 55, p. 69.) It is thus clear that the foreign patents did not become patents or foreign publications more than two years prior to the date on which Barber filed his application for the patent in suit.

A Swiss patent to Wohlgrath, No. 20,387, and a book by Beaumont on "Motor Vehicles and Motors," pages 285 and 291, have also been considered in this connection. No proof has been offered as to the date when the Swiss patent was sealed, nor as to the date when the Beaumont book was published. This book bears the imprint of "1900" as the date of its publication, and the printed "preface" purports to be dated "March, 1900." Obviously these dates are too late.

[3] Did the British and French patents become patents or publications within the meaning of the statute before the date Barber made his invention? Evidence has been offered by Barber to establish the date he made his invention and of the various steps taken by him in the development, by the making of sketches and drawings, patterns, castings, and the assembling of the parts into a complete working engine. The testimony of Barber is to the effect that he

made the invention of his patent, and made drawings of his engine in all its details, in the fall of 1897, fixing the time he worked on his drawings by reference to the date his wife gave birth to a child. Barber testifies that in the fall of 1899 he made wooden patterns of various parts of his engine, including the parts of the valve structure embodying the invention of his patent, and some of the wooden patterns of the valve assembly parts made at that time were preserved and are produced in evidence. Barber testifies that as the patterns were completed he employed them in producing castings and that the various castings and parts were machined and assembled into an engine, which was set up in his shop and successfully and practically operated experimentally in the winter of 1899-1900, and subsequently he built other engines of the same structure, all containing the claimed invention of his patent. This testimony is fully corroborated by Mrs. Barber, by Burtchell, the pattern-maker, who assisted in making the wooden patterns; by Higginson, the iron molder, who made the castings; by Beake, the machinist, who assisted in the work of machining and assembling the parts of the engine, and by Johnson, who visited Barber's shop in the winter of 1899-1900 and saw the engine in operation. All of these witnesses gave their testimony in open court and under the personal observation of the court, and I am satisfied from their bearing and manner on the witness stand that they testified truthfully, and their testimony carries conviction as to the matters concerning which they have testified. They all agree that the Barber engine, embodying and containing the claimed invention of the Barber patent, was completed and successfully operated, experimentally at least, as early as February or March, 1900.

[4] The earliest date which can be accorded to the foreign patents set up to defeat the Barber patent is April 3, 1900, which is the sealing date of the Bousfield British patent. But to defeat the Barber patent, under the patent statutes of this country, it is necessary for the defendant to show a foreign patent or a printed publication which became a patent or a publication before Barber made his invention or discovery. This is the statutory requirement, and under the authorities the defendant has failed to show this. (*Webster Loom Co. v. Higgins*, C. D., 1882, 285; 21 O. G., 2031; 105 U. S., 580; *Von Schmidt v. Bowers*, C. D., 1897, 529; 80 O. G., 347; 80 Fed. Rep., 121; 25 C. C. A., 328; *Philadelphia & Trenton Railroad Co. v. Stimpson*, 14 Pet., 461; 10 L. Ed., 535.) The issue is not one of priority as between rival claimants. The defendant does not assert or set up any rival claim to priority of the Barber invention. On the contrary, the question is the statutory one whether Barber made his invention before the available dates of the foreign patents. (*Miner v. Symington*, 229 Fed. Rep., 730.) And it is well settled

that, as against the statutory defense of anticipation, the patentee may show, if he can, the fact of his prior invention by drawings, sketches, models, or by any other competent proofs. (*Von Schmidt v. Bowers, supra*; *Loom v. Higgins, supra*; *Bates v. Coe*, C. D., 1879, 365; 15 O. G., 337; 98 U. S., 34; *Smith v. Vulcanite*, 93 U. S., 486; 23 L. Ed., 952; *Apparatus Co. v. Woerle*, C. C.; 29 Fed. Rep., 451.)

Having reached the conclusion that the alleged new prior art patents set up by defendant to defeat the Barber patent are too late in date, under the statute and the authorities, to operate as anticipations, it becomes unnecessary to consider or to discuss the disclosures of said patents. I may say, however, after a careful study of them, I am persuaded that they fail as anticipations or even as materially or substantially limiting the scope of the Barber patent, and I am all the more constrained to this view by the fact that the defendant does not employ the structures of these foreign patents, but instead has chosen to take the Barber structure. I do not deem it necessary, however, to base my disposition of the controversy on this ground.

For the foregoing considerations I am of the opinion that the decree should be awarded the plaintiff, with costs, and the accounting proceedings resumed.

[Court of Appeals of the District of Columbia.]

IN RE ALVAH BUSHNELL COMPANY.

Decided December 1, 1919.

270 O. G., 189; 49 App. D. C., 133; 261 Fed. Rep., 1013.

TRADE-MARKS—DESCRIPTIVENESS—"SAFE-TSEAL," FOR ENVELOPS.

The mark "SafeTseal" as applied to envelopes *Held* descriptive, as indicating either safety-seal envelopes or safe-seal envelopes.

Mr. E. T. Fenwick, Mr. L. L. Morrill, and Mr. Charles Allen for the appellants.

Mr. T. A. Hostetler for the Commissioner of Patents.

VAN ORSDER, J.:

This appeal is from the decision of the Commissioner of Patents refusing registration of the word-symbol "SafeTseal" as a trade-mark for envelopes, wallets, letter-files, jackets, etc.

Counsel for the Commissioner discloses the existence of patent to D'Agostina, dated February 8, 1916, for safety-envelops, and also patent to Halloran, dated July 25, 1905, which is described as relating "to a safety seal for envelopes." It must be assumed that the goods of the respective patentees are known to the trade as "safety envelopes" or "safety seal envelopes." This designation having been established by virtue of the patents, even if arbitrary, would not be available as a trade-mark for either of the patentees for goods of the same

class as those patented. It follows that, if by their use, the marks could not be registered as trade-marks by the persons first applying them to the patented articles, a stranger could not adopt either of them as a trade-mark for the same class of goods.

Treating the mark independently, the test here is the impression which it would make upon the public. It is clear that the trade would identify the goods bearing the mark either as safety-seal envelopes or safe-seal envelopes. In either case the mark is descriptive of the goods and comes within the prohibition of section 5 of the Trade-Mark Act of February 20, 1905.

The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as required by law.

Affirmed.

[Court of Appeals of the District of Columbia.]

AMERICAN FEED MILLING CO. v. M. C. PETERS MILL CO.

Decided December 1, 1919.

270 O. G., 189; 49 App. D. C., 131; 261 Fed. Rep., 1011.

TRADE-MARKS—SIMILARITY.

A mark consisting of the words "Big Chief," associated with the representation of a man on horseback, inclosed within a circle, *Held* deceptively similar to a mark consisting of the word "Arab," associated with the representation of a man on horseback, inclosed within two circles.

Mr. Raymond J. Mawhinney and Mr. Robert J. Mawhinney for the appellant.

Mr. T. Walter Fowler for the appellee.

VAN ORSDDEL, J.:

This is an appeal from the decision of the Commissioner of Patents in a trade-mark opposition.

The mark of applicant, American Feed Milling Company, a North Carolina corporation, consists of the words "Big Chief," associated with the representation of a man on horseback concentrically inclosed within a single circle. The mark of the opposer, M. C. Peters Mill Company, a Nebraska corporation, consists of the word "Arab," associated with the representation of a man on horseback concentrically inclosed within two circles. The man in the mark of applicant is intended to represent an Indian chief armed with a gun, while the man in opposer's mark represents an Arab armed with a spear.

The sole question presented is the likelihood of confusion in trade. Applicant alleges use of its mark since 1914, while opposer shows use of its mark prior to that date. The dominating feature of each

mark is the horse with an armed man mounted upon it. The horse in each mark is similar in size, style and appearance. While the dress of the men is different, they are similar in size, position and the respective manner of holding the spear and gun. These striking similarities bring this case within the rule announced in *Bickmore Gall Cure Co. v. Karns Mfg. Co.* (126 Fed. Rep., 573,) where the conflicting marks consisted of representations of horses attached to the same class of goods. In that case the court said:

Both pictures are used on boxes containing the salve. The complainant's trade-mark cannot confer a monopoly to every representation of a horse upon a medicine of that character. Such a mark would be generic in character. Its right is restricted to the particular horse designated in the registration, or one of substantially similar appearance, style or position.

Opposer's mark discloses an Arabian horse of unusual appearance, style and position, while the horse of applicant is similar in all its details and dimensions.

The respective marks are used on burlap sacks containing horse feed, displaying at best a dull impression of the mark and forbidding to a large extent the detection of distinguishing features. The similarity of the dimensions and general appearance of the marks emphasizes the improbability of accidental selection by applicant. As was said by Judge Lurton in *Paris Co. v. Hill Co.*, (102 Fed. Rep., 148:)

When there are found strong resemblances, the natural inquiry for the court is, why do they exist? If no sufficient answer appears, the inference is that they exist for the purpose of misleading. (*Taylor v. Taylor*, 2 Eq. Rep., 290.) We are to remember that the average purchaser has seldom the opportunity of making a close comparison; that he is apt to act quickly, and is therefore not expected to exercise a high degree of caution. (*Pillsbury v. Flour-Mills Co.*, 64 Fed. Rep., 841; 12 C. C. A., 432.)

The decision of the Commissioner of Patents sustaining the opposition is affirmed, and the clerk is directed to certify these proceedings as by law required.

Affirmed.

[Court of Appeals of the District of Columbia.]

BADER *v.* BURROUGHS.

Decided December 1, 1919.

270 O. G., 190; 49 App. D. C., 136; 261 Fed. Rep., 1016.

INTERFERENCE—PRIORITY.

Evidence reviewed and *Held* insufficient to establish that the junior party, on whom the burden of proof rested heavily as an applicant against a patentee, was the first inventor.

Mr. C. S. Davis for the appellant.

Mr. Howard P. Denison for the appellee.

ROBB, J.:

Appeal from a decision of an Assistant Commissioner of Patents in an interference proceeding awarding priority of invention to the junior applicant, he having copied the claim of appellant's patent, reading as follows:

In an eye-glass mounting, the combination with a bridge provided with a non-circular opening and a flat surface surrounding the opening, of a pivot stud comprising a portion fitting in and conforming to the non-circular opening, a cylindrical bearing portion, a shoulder at the junction of the bearing portion with the non-circular portion, said shoulder engaging the flat surface of the bridge, and a flange spaced from said flat surface; a screw engaging the post and the bridge and holding the shoulder against the flat surface, a nose clamp lever pivoted to the stud and engaging the flange and the flat surface of the bridge; and a spring secured at one end to the stud and at the other end to the nose clamp lever.

At the time the invention was made the parties were in the employ of the Standard Optical Company of Geneva, N. Y., Burroughs as superintendent and Bader as an expert designer of eyeglass-mountings. Burroughs was not an inventor, while Bader had taken out several patents relating to this art. It is conceded that Bader was the inventor of a structure like the device of the issue except that the end of the post supporting the guard was offset and hence not readily removable. In other words, in the device of the issue a screw has been substituted for the offset. For this substitution or change each of the parties claims credit. The Examiner of Interferences awarded priority to Bader, while the Board and Assistant Commissioner found for Burroughs.

At the time the controversy arose, and thereafter until Bader canceled the license, the company was paying him a royalty on the mounting, minus the screw feature. Some complaint was made because the guard was not removable, and, on the 13th of April, 1915, two representatives of the Geneva Optical Company were in conference with Burroughs at the factory of the Standard Optical Company. During the latter part of this interview, which took place after lunch, some one suggested that by putting a screw in place of the offset or rivet the mounting could be more easily repaired. Burroughs says he made this suggestion. The two representatives of the Geneva Company do not remember who made it. One of them testified, under cross-examination, that most mountings of this character were made with a screw and that the substitution of the screw for the fixed head or offset "was the obvious thing." Bader was called in and the matter discussed. Burroughs at first testified that the interview terminated between 4 and 4.30 in the afternoon and that he thought Bader was there at that time. Later Mr. Dorsey, the attorney who prepared the application for Bader at Rochester, N. Y.—a very frank witness and entirely disinterested at the time of his testimony—produced for

Bader a drawing of the invention dated April 13, 1915, and which he testified was on that day sent to his correspondent in Washington for the purpose of a search as to patentability. To the best of Mr. Dorsey's recollection, the drawing was made—

from a description furnished by Mr. Bader at some time before making the search.

Judging from the appearance of the sketch, the witness was certain it had been done when he had plenty of time on his hands, and not in the course of an interview with Bader. The witness was quite sure that the communication from Bader was at a personal interview; that had the fact been otherwise he, in all probability, would have remembered it. The stenographer to whom the letter accompanying the drawing was dictated by Mr. Dorsey on the date mentioned, stated that her note-book showed she had taken other dictation that day after the letter in question was dictated to her. Following this testimony Mr. Burroughs was recalled to the stand and asked whether he knew where Mr. Bader was in the afternoon of April 13th, and, notwithstanding his former statement that Bader was at the factory when the interview closed at 4 o'clock or later, replied that he did not. He further stated that it was Bader's habit to go to Rochester from Geneva by motorcycle, a distance of approximately forty-six miles. Bader testified positively that he was not in Rochester on the 13th, and that his disclosure to Mr. Dorsey was prior to that time. We do not deem it necessary further to discuss the evidence, save to say that the bill for the filing of Bader's application was paid by the Geneva Company.

Since Bader is a patentee, the burden is heavily on Burroughs, and in our view he has entirely failed to sustain it. He does not even claim to have done more than suggest a slight and, according to his own witness, obvious modification of one of the elements of a structure admittedly Bader's. And he really is not corroborated as to that, while the testimony of Mr. Dorsey and the drawing produced by him conclusively establishes, we think, that Bader was in possession of the invention before the interview at which Burroughs says he (Burroughs) first disclosed it. Moreover, this "obvious thing" was more likely to occur to Bader, the expert, than to any one else.

The decision is reversed and priority awarded to Bader.

Reversed.

[Court of Appeals of the District of Columbia.]

COWLES v. RODY.

Decided December 1, 1919.

270 O. G., 191; 49 App. D. C., 135; 261 Fed. Rep., 1015.

JURISDICTION—COURT OF APPEALS OF THE DISTRICT OF COLUMBIA—INTERFERENCE PROCEEDING.

The Court of Appeals of the District of Columbia is without authority in an interference proceeding to review the Commissioner's ruling that the claims of one of the parties are not patentable because barred by the statute of public use (or printed publication).

Mr. W. H. Finckel, Jr., for the appellant.

Mr. J. C. Pennie and *Mr. F. E. Barrows* for the appellee.

SMYTH, C. J.

Cowles appeals from a decision of the Assistant Commissioner of Patents dissolving an interference to which he was a party. The subject-matter, which was a method for treating feldspar and the like, is expressed in nine counts. In view of the conclusion which we have reached it is not necessary to set out any of them.

Rody was granted a patent August 24, 1915, on an application filed October 11, 1913. Cowles's application was not filed until November 20, 1915, nearly three months after Rody's patent had issued. Cowles was therefore the junior party. The Examiner of Interferences awarded priority to Rody on all the counts. This was reversed by the Examiners-in-Chief as to counts 1 to 4 and affirmed as to the remainder. In granting the reversal the Examiners held that while Cowles was prior to Rody with respect to the first-named claims, he was anticipated by a patent to one Adolf Kayser, and announced that they would so notify the Commissioner of the apparent statutory bar to the granting of a patent to Cowles with claims corresponding to the counts 1 to 4. On appeal by Cowles the Assistant Commissioner held that he had in effect admitted publication of his invention in 1912, or more than two years before he filed his application. He further said:

If the Cowles publications, taken in connection with the previous Kayser patent or otherwise, disclose the invention of Cowles as he claims it, then the possibility of granting a patent to Cowles disappears, and there is no applicant before this Office with allowable claims to this matter, and consequently there is no interference.

The Assistant Commissioner found that the publications disclosed the invention, and he, in consequence dissolved the interference. Rody moves to dismiss on the ground that the court has no jurisdiction to consider the appeal.

We are without authority in an interference proceeding to reverse the Commissioner's ruling that Cowles's claims are not patentable because barred by the statute of public use. He did not pass upon the question of priority, and that is the only question reviewable by us in this kind of a proceeding. His action in dissolving the interference simply placed the parties back where they were before he had declared the interference, and we have no power to disturb it—it is not a final order. This has been often announced by us. (*In re Fullager*, C. D., 1909, 270; 138 O. G., 259; 32 App. D. D., 222; *Cosper v. Gold*, C. D., 1910, 282; 151 O. G., 194; 34 App. D. C., 194; *Carlin v. Goldberg*, C. D., 1917, 128; 236 O. G., 1222; 45 App. D. C., 540; *Field et al. v. Colman*, C. D., 1918, 135; 247 O. G., 246; 47 App. D. C., 189.) In the last case it is said:

We have held in many cases that this court is without jurisdiction to entertain an appeal in an interference case except from a judgment of priority. (Citing cases.)

As a result the motion to dismiss in this case for want of jurisdiction must be sustained.

Affirmed.

[Court of Appeals of the District of Columbia.]

L. OTZEN & CO. v. THE J. K. ARMSBY CO.

Decided December 1, 1919.

270 O. G., 191; 49 App. D. C., 184; 261 Fed. Rep., 1014.

TRADE-MARKS—SIMILARITY.

A mark consisting of the words "From the Land of Sunshine" *Held* not deceptively similar to a mark consisting of the words "Blossom and Sunshine," associated with the representation of blossoms and a sunburst.

Mr. A. P. Greeley for the appellant.

Mr. E. T. Fenwick and *Mr. L. L. Morrill* for the appellee.

VAN ORSDER, J.:

This is an appeal from the Commissioner of Patents in a trade-mark cancelation proceeding, in which the petitioner, L. Otzen & Company, is seeking the cancelation of the registration of the mark "From the Land of Sunshine," granted to the registrant March 31, 1914.

Petitioner's mark consists of the words "Blossom and Sunshine," associated with the representation of blossoms and a sunburst. Both marks are used on identical goods—dried fruits.

It is contended by petitioner that the word "Sunshine" is the dominating feature of each mark. Registrant, however, answers this by way of a counterclaim that petitioner's registration of the mark

in issue in 1906 was illegally secured, because of a prior use by registrant of a mark for fruits consisting of the word "Sunshine" alone. The use of this mark, registrant claims, was prior to any rights acquired by petitioner in its present mark. This would seem to foreclose conclusively petitioner's right to demand cancelation of registrant's mark on the ground that its dominating feature is the word "Sunshine," since prior rights to the use of that word are in the registrant.

This, however, does not decide the issue of probable confusion arising from the use of the marks in question. We agree with the tribunals below that there is nothing inherent in the appearance of the marks, or in the proof adduced by petitioner, to justify an adjudication that the marks are so similar as to be likely to lead to confusion in trade.

The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as by law required.

Affirmed.

[Court of Appeals of the District of Columbia.]

PAUL F. BEICH COMPANY v. KELLOGG TOASTED CORN FLAKES COMPANY.

Decided January 5, 1920.

271 O. G., 361; 49 App. D. C., 186; 262 Fed. Rep., 640.

TRADE-MARKS—CLASS OF GOODS—BREAKFAST FOODS AND CANDY.

The general and essential characteristics of breakfast foods and candy are different, and the first to adopt and use the mark "Krumbles" for a cereal breakfast food has no right to extend it to candy as against one who shows an intermediate adoption and use of "Golden Crumbles" for candy.

Mr. Jas. L. Stewart and Mr. S. R. Perry for the appellant.

Mr. W. H. C. Clarke for the appellee.

ROBB, J.:

Appeal from a Patent Office decision sustaining appellee's petition for the cancelation of appellant's trade-mark "Golden Crumbles," which it had used on candy since February of 1915.

It appears that the words "Golden Crumbles" were suggested by the color of the candy and its tendency easily to crumble. A very considerable business soon was established. Appellee, in 1912, adopted the word "Krumbles" as a trade-mark for a cereal breakfast food. In April of 1916, more than a year subsequent to appellant's adoption of its mark, appellee commenced using its mark on a confection. It contends that this was a legitimate and natural ex-

pansion of its business. We do not think so. (*Quaker Oats Co. v. Mothers Macaroni Co.*, C. D., 1914, 108; 198 O. G., 899; 41 App. D. C., 254.) The Acting Examiner of Interferences pertinently observed that there is no—

proof to the effect that manufacturers of cereal breakfast foods are in the habit of engaging in the production of candy.

Moreover, the general and essential characteristics of breakfast foods and candy are different, and we are of opinion that the use of a mark by a dealer in one leaves its use open to a manufacturer of the other.

The decision is reversed.

Reversed.

[Court of Appeals of the District of Columbia.]

KENNICOTT v. CAPS.

Decided January 5, 1920.

271 O. G., 361; 49 App. D. C., 187; 262 Fed. Rep., 641.

INTERFERENCE—PRIORITY—REVIEW BY COURT OF APPEALS.

Where the tribunals of the Patent Office concur with respect to the proper solution of a question of fact, the Court of Appeals of the District of Columbia will not disturb their action if there is competent evidence to sustain it.

(*For Commissioner's decision see ante*, 6; 271 O. G., 359.)

Mr. Francis M. Phelps and *Mr. Frank A. Howard* for the appellant.

Mr. Joseph H. Milans, *Mr. Calvin T. Milans*, and *Mr. Rudolph W. Lotz* for the appellee.

SMYTH, C. J.:

The Assistant Commissioner of Patents awarded priority of invention to Caps in an interference between his application and that of Kennicott, and the latter appeals. Improvements in an apparatus for softening water constitute the subject of the invention. There is only one count of the interference. It reads:

1. In a water-softening apparatus, a reagent drum, means for passing water to be softened through the reagent in said drum, a water meter for measuring the water flowing through the said drum, a valve for shutting off the flow of water through the drum, and means operable by said meter for actuating the said valve.

Caps alleged conception in January, 1915, and disclosure in February following. He filed his application in January, 1916. Kennicott in his original preliminary statement claimed that he had conceived the invention and reduced it to practice in December, 1915. His application was filed in March following. He is, therefore, the senior party. After Cap's testimony had been completed and Kenni-

cott knew the dates claimed by him, he sought leave to amend his statement by alleging conception in February, 1914, nearly two years before the date first claimed and about a year anterior to Caps. The three tribunals of the Office concurred in denying leave to amend, on the ground that he had failed to show diligence in discovering the assumed error in his first statement. They also concurred in holding, on the question of fact presented, that Caps was the first to conceive and, being diligent thereafter and up to the time of the filing of his application, was entitled to priority. It is a well settled rule of decision in this court that where the tribunals of the Office concur with respect to the proper solution of a question of fact we will not disturb their action if there is any competent evidence to sustain it. (*Greenawalt v. Dwight*, C. D. 1919, 234; 266 O. G., 138; 258 Fed. Rep., 982; 49 App. D. C., 82; and cases there cited.) *We think the evidence here amply satisfies the rule, and therefore we affirm the decision of the Assistant Commissioner of Patents.*

Affirmed.

[Court of Appeals of the District of Columbia.]

IN RE SCHNEIDER.

Decided January 5, 1920.

271 O. G., 362; 49 App. D. C., 204; 262 Fed. Rep., 718.

1. REISSUE—DELAY OF TWO YEARS AND EIGHT MONTHS IN FILING APPLICATION.

A delay of two years and eight months in filing an application for reissue to secure broader protection *Held* to be unreasonable where applicant's only excuse is "that he had no occasion to review his patent from the date of its issue until the present time, and that the insufficiencies in his original specification and claims only came to his attention through others."

2. SAME—DELAY OF MORE THAN TWO YEARS—EVIDENCE OF ABANDONMENT.

A lapse of more than two years in the filing of an application for reissue to secure broader claims applies not only to the *prima facie* presumption of intervening rights, but it is evidence of abandonment.

3. SAME—FAILURE TO SECURE ADEQUATE PROTECTION—INVENTOR BOUND BY ACTS OF SOLICITORS.

An unreasonable delay in the filing of a reissue application which seeks to broaden the claims cannot be excused on the ground that the failure to secure adequate protection was due to the fault of the solicitors. They were the agents of the inventor, and he is bound by their acts.

(*For Commissioner's decision see ante, 9; 271 O. G., 360.*)

Mr. H. B. Fay for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

SMYTH, C. J.:

This is an appeal from a decision of the Commissioner of Patents refusing a reissue on the ground that the appellant was not diligent in making his application. Two years and eight months elapsed

between the issue of the original patent and the filing of his application. The only reason assigned by him for the delay is—

that he had no occasion to review his patent from the date of its issue until the present time, and that the insufficiencies in his original specification and claims only came to his attention through others; namely, Mr. Burton W. Sweet, who was employed by him, and his attorneys, Messrs. Fay, Oberlin and Fay, within the past few weeks, and that he did not delay after he had knowledge of the insufficiency of his original patent.

It is conceded by him that the claims which he now seeks to have allowed are broader than those of the original patent. This is important.

While the applicant says he had no occasion to review his patent from the date of its issue until the present time, we think prudence would have suggested that he examine his claims when the patent was granted, or soon thereafter, certainly within two years after he had received it, to determine whether or not they were commensurate with his invention. If the claims were intricate,—something he could not understand,—it was his duty to call for the aid of an expert. A reasonably careful man would have pursued such a course. In *Ives v. Sargent* (C. D., 1887, 191; 38 O. G., 781; 119 U. S., 652) the Court, in rejecting the excuse for delay proffered by an applicant for a reissue, said that—

he assumed, without examination, that the specification and claims of his (original) patent were just what he had desired and intended they should be, and rested quietly in ignorance of the error and of his rights for nearly three years, and then did not discover them until after others had discovered that he had lost the right to repair his error by his neglect to assert it within a reasonable time.

This, in effect, is what was done by the applicant in the case before us. The period of his inaction was two years and eight months—"nearly three years." During that time he made no examination of his claims and specifications, but assumed, as did the applicant in the *Ives* case, that they were just what he had desired.

The Court said in *Wollensak v. Reiher*, (C. D., 1885, 310; 31 O. G., 1301; 115 U. S., 96, 99:)

If, at the date of the issue of the original patent, the patentee had been conscious of the nature and extent of his invention, an inspection of the patent, when issued, and an examination of its terms, made with that reasonable degree of care which is habitual to and expected of men, in the management of their own interests, in the ordinary affairs of life, would have immediately informed him that the patent had failed fully to cover the area of his invention. And this must be deemed to be notice to him of the fact, for the law imputes knowledge, when opportunity and interest, combined with reasonable care, would necessarily impart it.

In the light of this reasoning it cannot be said that Schneider was diligent.

Nor will it do for the applicant to say that the fault was that of his solicitors in drawing the original claims. They were his agents and he is bound by their acts. In the Ives case the applicant sought to shift the responsibility to his solicitors, but the Court refused to permit him to do so, saying, in effect, that even if they were negligent, he had not shown sufficient reason why he had not discovered it before.

There being no justifiable cause for applicant's failure to apply for the reissue until more than two years had elapsed, the law presumes that he abandoned—

the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of the abandonment of the patent to the public. (*Topliff v. Topliff*, C. D., 1892, 402; 59 O. G., 1257; 145 U. S., 156.)

And it is said in *in re Starkey* (C. D., 1903, 239, 251; 105 O. G., 745, 1259; 21 App. D. C., 519, 525) that—

we must now regard the law as well settled by the Supreme Court of the United States, that, after the lapse of two years after the issue of a patent, a reissue which seeks to enlarge the claims of the original patent will not be granted, or if granted will be held invalid, unless special circumstances are shown to excuse the delay.

As we have already shown, those circumstances have not been made to appear in this case.

It is said that there can be no action without knowledge, and that Schneider did not have knowledge that his original claims were not as broad as they should be; but there may be negligence in not acquiring knowledge, and it was in this respect that Schneider failed. Applicant asserts that the lapse of two years applies only to the *prima facie* presumption of intervening rights, but this is not correct. It is, as we have just observed, also evidence of abandonment. *There being no showing of diligence the decision of the Commissioner is affirmed.*

Affirmed.

[Court of Appeals of the District of Columbia.]

MARIE E. SCHEUERLE, ADMINISTRATRIX OF THE ESTATE OF HENRY A. SCHEUERLE, DECEASED, v. CONNER.

Decided January 5, 1920.

271 O. G., 363; 49 App. D. C., 196; 262 Fed. Rep., 650.

1. INTERFERENCE—EVIDENCE—INFERENCE ARISING FROM FAILURE TO CALL INVENTOR.

Where the inventor refused to sign the preliminary statement made on his behalf and the assignee of the application, who conducted the inter-

ference, failed to call him as a witness, although he was available, the inference is warranted that, in the judgment of counsel for the assignee, he would not support the claims made in his name.

2. SAME—PRIORITY—EVIDENCE.

Evidence considered and *Held* that S. reduced the invention to practice prior to the date of conception alleged in the preliminary statement filed by the assignee of C.'s application.

Mr. A. E. Paige for the appellant.

Mr. V. H. Lockwood for the appellee.

SMYTH, C. J.

From a decision of the First Assistant Commissioner of Patents awarding priority to Conner, in an interference, Scheuerle appeals. The invention relates to mechanism for polishing or abrading the major areas of bifocal lenses. A reissue patent emerged to Henry A. Scheuerle July 27, 1915, on an application filed June 8, 1915. He afterward died, and the interest of his estate in the patent is represented by his widow, Marie E. Scheuerle, as administratrix. Conner's application was filed May 25, 1912. There are four counts in the issue, of which count 3 is typical. It reads:

3. The combination with an annular rotary lap having a central recess; of a rotary holder for the surface to be abraded; means arranged to relatively rotate said lap and holder; and means maintaining the axes of said lap and holder in such angular relation that said recess spans the axis of said holder, in eccentric relation therewith, with said axes intersecting at a center of curvature of said surface; whereby said lap is prevented from abrading the axial region of said surface while it is caused to abrade an annular region of said surface concentric with the axis of said surface but eccentric with the axis of said lap.

The case turns upon a question of fact. At the very outset we are confronted by these significant things: Conner refused to sign the preliminary statement made on his behalf; it was signed by one Rau, president of the Onepiece Bifocal Lens Company, which owns Conner's application. Conner, who was in Indianapolis when testimony was being taken there in this proceeding,—a fact well known to the Lens Company,—was not called as a witness in its behalf. It had the right to force his attendance but it did not see fit to exercise it. This warrants the inference that he, in the judgment of counsel for the company, would not support the claims made in his name.

The earliest date of conception claimed for Conner in the first preliminary statement filed on his behalf is about February 1, 1911, but in an amended statement the date is moved back to August 1, 1910.

The witness Wall, an officer of Wall & Ochs, manufacturers of lenses, testified that in 1906 Scheuerle was employed by his establish-

ment and at that time "had knowledge of the manufacture of bifocal lenses." Brown, another witness, says that in the spring or summer of 1909 Scheuerle made an abrading-tool for use in the preparation of bifocal lenses, and Henry A. Scheuerle, a practical optician, nephew of Scheuerle, the patentee, testified that his uncle was manufacturing bifocal lenses in 1909 at his residence with a mechanism the same as Exhibit K that—

he had several customers, his own patients that he refracted, that he supplied with these lenses.

Margath, who seems to be an intelligent witness, supports him with respect to the use, by the elder Scheuerle, of a mechanism like Exhibit K. In short, a careful study of the records satisfies us that, to borrow the language of the Examiner of Interferences—

it positively appears that as early as 1909 Scheuerle had made the abrading tool as illustrated in his reissue patent involved in this interference and that during the Christmas holidays of the same year he had disclosed his method to others, and by February, 1910, had operated his tool and holder in the manner set forth in this issue, and had in 1911 actually sold lenses made thereby.

We do not think the part of the record sent up by the Office in response to our writ of certiorari, issued at the instance of the party Conner, was necessary, and therefore the costs of it are taxed against Conner, this being in accordance with the terms of the order for the writ.

The decision of the First Assistant Commissioner is set aside and priority of invention of the subject-matter in issue is awarded to Scheuerle.

Reversed.

[Court of Appeals of the District of Columbia.]

IN RE SMITH.

Decided January 5, 1920.

271 O. G., 363; 49 App. D. C., 203; 262 Fed. Rep., 717.

PATENTABILITY—INVENTION—BRINGING OLD DEVICES INTO JUXTAPOSITION.

Merely bringing old devices into juxtaposition and there allowing each to work out its own effect without the production of something novel is not invention. (*Hailes v. Van Wormer*, (5 O. G., 89; 20 Wall, 353, 363.)

(*For Commissioner's Decision, see ante, 5; 271 O. G., 156.*)

Mr. B. G. Foster for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

SMYTH, C. J.:

Smith appeals from a decision of the Commissioner of Patents rejecting his application for a patent for an improvement in motors,

on the ground that he was anticipated by two patents, one to Joy August 4, 1868, and one to Wakfer October 20, 1914. There are five claims, of which 1 and 4 are examples:

1. In a motor of the character set forth the combination with a cylinder member having a head chamber and opposite neck chambers extending therefrom, of a piston in the cylinder member, comprising a head operating in the head chamber and oppositely extending necks operating in the said neck chambers, said piston being reversible to permit either neck to operate in either neck chamber, means for supplying motive fluid alternately to opposite sides of the piston head, and means for permitting a portion of such motive fluid supplied to one side of the head to pass into one of the neck chambers behind the neck therein.

4. In a motor of the character set forth, the combination with a cylinder member having a head chamber and opposite neck chambers extending therefrom, of a piston in the cylinder member comprising a head operating in the head chamber, necks operating in the opposite neck chambers, said piston being reversible to permit either neck to operate in either neck chamber, and means for supplying motive fluid alternately to opposite sides of the piston head, said means being controlled by the piston necks.

Claims 1 and 2 read directly on Wakfer. While the passage 16 and 17 in his patent might not suggest the use of a like passage for the purpose outlined by Smith, it would necessarily give the same result. An inspection makes this apparent at once. As the Examiners-in-Chief said, a claim cannot be allowed to Smith, the appellant, for a construction disclosed by Wakfer "which would inherently accomplish applicant's purpose," whether intentionally or not. With respect to claims 3, 4 and 5, the Joy patent, particularly Figure 8, anticipates them. Certain changes, it is true, would be required to make the one conform to the other, but this would not call for invention, for all the factors revealed by the claims are old in the art.

Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention. (*Hailes v. Van Wormer* (5 O. G., 89; 20 Wall., 353.)

We think the decision of the Commissioner should be affirmed.
Affirmed.

[Court of Appeals of the District of Columbia.]

HOPKINS v. RIEGGER.

Decided January 5, 1920.

271 O. G., 511; 49 App. D. C., 188; 262 Fed. Rep., 642.

INTERFERENCE—QUESTION OF FACT INVOLVED—CONCURRENCE OF TRIBUNALS OF PATENT OFFICE.

Where the question between two contestants in an interference proceeding is one of originality and the three tribunals of the Patent Office concur on

this question of fact, the court of appeals will follow the prior decisions unless they be manifestly wrong.

Mr. Clarence O. McKay, Mr. Chas. S. Jones, and Mr. W. Lee Helms for the appellant.

Mr. C. L. Sturtevant and Mr. Oscar W. Jeffery for the appellee.

SMYTH, C. J.:

This is an interference involving nine counts, which cover a subject-matter that relates to a tank-ball or rubber float-valve for the outlet toilet flush-tanks. The Commissioner of Patents awarded priority to Riegger on all the counts except No. 9, which was given to Hopkins, and the latter appeals. Counts 1 and 4 illustrate the character of the invention. They are as follows:

1. A tank ball formed with a seat engaging portion of flexible rubber, an upper portion of flexible rubber, and a reinforcement formed of rubber composition vulcanized to the upper portion for preventing the collapsing thereof, said reinforcement being formed with an annular enlargement opposite the juncture of the seat engaging portion and the upper portion.

4. A float ball valve formed with a flexible seat portion, an upper portion, a separate stiffening member arranged interiorly of said upper portion to prevent the collapsing thereof, and also to prevent the collapsing of the upper edge of the seat portion, and a reinforcing member arranged at the juncture of the upper portion and the lower portion, said reinforcing member overlapping said stiffening member for providing a substantially rigid joint.

The thing about which the controversy centers, as we have just stated, is a ball, the lower part of which is made of soft white rubber, and the top of like material reinforced on the inside with a hard-black-rubber core cemented and vulcanized to it. In order that the joint between the two parts may not separate easily the upper part is carried down to and across the edge of the lower part, while a reinforcing-strip embraces the lower edge of the shell and is vulcanized to the upper and lower portions of the ball. Both parties claim the inventive idea, each asserting that the other derived it from him. There is evidence tending to support the cause of each, but it is not necessary for us to go into an analysis of it. The three tribunals of the Patent Office decided in favor of Riegger. Where they concur, the question being one of fact, as here, we will not review the Commissioner's decision unless it be manifestly wrong (*Greenawalt v. Dwight*, C. D., 1919, 234; 266 O. G., 138; 258 Fed. Rep., 982; 49 App. D. C., 82; and cases cited), and we cannot say that it is in the case before us.

For this reason the decision of the Commissioner must be affirmed. Affirmed.

[Court of Appeals of the District of Columbia.]

REICHEL *v.* DORSET.*Decided January 5, 1920.*

271 O. G., 511; 49 App. D. C., 198; 262 Fed. Rep., 652.

1. INTERFERENCE—REDUCTION TO PRACTICE—NECESSITY OF TEST.

Where the invention in issue constituted an important step in the art of hog-cholera treatment, covering both a process and product, nothing short of a successful test could meet the legal requirements of a reduction to practice.

2. SAME—DELAY IN REDUCTION TO PRACTICE—EXCUSE INSUFFICIENT.

A delay of a year in making a test of a product designed to prevent hog-cholera after it was alleged to have been obtained may not be excused on the ground that the inventor was working under orders as a Government official and was not at liberty to lay aside his assigned work, where all that was necessary and all that he did to make the test was to send it to an experiment station, particularly where other circumstances indicated that the real cause of delay was that he did not think his process was patentable until the activity of his adversary was brought to his attention.

Mr. L. H. Campbell for the appellant.

Mr. C. W. Boyle and *Mr. A. J. Decker* for the appellee.

VAN ORSDEL, J.:

The issue in this interference is in four counts, of which counts 1 and 3 are illustrative:

1. The process of eliminating from hog cholera "antitoxin," the serum albumins, cellular debris fibrin, or living or dead germs, by precipitation with chemical precipitants other than those forming insoluble hydroxids and filtration and preserving only the active substances, whereby the hog cholera immune bodies and the globulins are obtained, having the characteristics of increasing the resistance of the hog against infection from hog cholera virus or the cause of hog cholera, and adapted to be used either alone or in connection with hog cholera virus or the cause of hog cholera to prevent the disease known as hog cholera in healthy hogs or to cure hogs sick of hog cholera.

3. As a new substance hog cholera globulin, consisting only of the hog cholera immune bodies and the globulins obtained from hog cholera defibrinated blood antitoxin, having the active substance in concentrated and sterile form.

The invention relates to a process for refining antitoxin for hog-cholera and the product thereby obtained.

The respective dates found by the tribunals below are fully sustained by the record. Appellant Reichel conceived the invention October 15, 1913, and constructively reduced it to practice by filing his application April 3, 1914. Dorset conceived the invention in the latter part of 1912, obtained a product in May, 1913, which was tested and reduced to practice May 16, 1914. The reduction to practice con-

sisted in Dorset sending some of the defibrinated blood antitoxin to Dr. Schroeder at the experiment station at Bethesda, Md., where it was tested by immunizing a hog and was found to be potent in preventing cholera. Dorset filed his application for patent August 5, 1915.

We are of the opinion that the mere obtaining of the product by Dorset in May, 1913, without a test of its potency by immunizing a hog, does not amount to a reduction to practice. The invention is an important step in a difficult art, and, therefore, nothing short of a successful test could meet the legal requirements of a reduction to practice.

The diligence of appellee at the time appellant entered the field is the sole question in the case. The Examiner of Interferences held that Dorset was lacking in diligence, and awarded priority to Reichel. He was reversed by the Board of Examiners-in-Chief and the Assistant Commissioner. Dorset's excuse for his inactivity from May, 1913, to May, 1914, is pressing official duties. He was chief of the Biochemic Division of the Bureau of Animal Industry of the Department of Agriculture. In March, 1913, Congress passed an act requiring the Agricultural Department to inspect all plants producing hog-cholera serum and other veterinary biological products. All the field-work in connection with this inspection was assigned to Dorset, and he claims that, inasmuch as he was working under orders as a Government official, he was not at liberty to lay aside his assigned work and devote his time to testing his invention.

The validity of this sort of excuse depends entirely upon the facts and circumstances of the instant case. If he had perfected the product, as he claims, it would seem that, without any material loss of time or interference with his official duties, he could have done in May, 1913, what he did in May, 1914—send some of the perfected defibrinated blood antitoxin to Dr. Schroeder, at Bethesda, Md., and have it tested.

But the record discloses circumstances which, we think, point more accurately to the real cause of appellee's delay. He did not think the process patentable until Reichel visited his office in May, 1915, and told him that a patent had been allowed on his application. Dorset then caused a protest to be filed against the issuance of the patent, and shortly thereafter filed his application. This resulted in a withdrawal of Reichel's case from issue and the declaration of this interference.

Failure to appreciate the patentability of an invention is no excuse either for failure to reduce it to practice or to make timely application for Letters Patent. Dorset allowed one year to elapse be-

tween his alleged perfecting of the product and its reduction to practice, during which time Reichel conceived the invention and constructively reduced it to practice by filing his application in the Patent Office. Another year of inactivity on Dorset's part elapsed until he discovered the allowance of the patent to his rival, when, spurred to activity, he entered his protest and filed his application. While the delay in filing, had he been diligent in reducing to practice, would not have barred his right to priority, it is a circumstance strongly indicating that lack of appreciation of the patentability of the invention was the real cause of his inactivity when the law required diligence.

The invention in issue was a development of the work in which Dorset was officially engaged. The Government was deeply interested in a discovery which would effectually aid it in its war upon a destructive disease; hence, considering the relation of Dorset to the public service, the delay of one year in sending the product to Dr. Schroeder for test is totally inexcusable.

The decision of the Commissioner of Patents is reversed, and the clerk is directed to certify these proceedings as by law required.

Reversed.

[Court of Appeals of the District of Columbia.]

ENGLE *v.* MANCHESTER AND SPOONER, (No. 1,262.) ENGLE *v.* MANCHESTER, (Nos. 1,263 AND 1,264.)

Decided January 5, 1920.

271 O. G., 687; 49 App. D. C., 191; 262 Fed. Rep., 645.

INTERFERENCE—ORIGINALITY—EVIDENCE—ACQUIESCENCE.

On the question of originality as between E. and S. and M. evidence considered and *Held* that it tended to show acquiescence by S. and M. in E.'s claim to inventorship and that the evidence on behalf of S. and M. failed to overcome the burden of proof imposed on junior applicants.

Mr. Vernon E. Hodges for the appellant.

Mr. A. S. Stewart and *Mr. Melville Church* for the appellee.

SMYTH, C. J.:

This is an appeal from a decision of the Patent Office awarding priority in three interference proceedings; to Manchester and Spooner in No. 1,262, and to Manchester alone in Nos. 1,263 and 1,264. Engle is the senior party, having filed some two months before the others. The subject-matter of each interference is so closely related to that of the others that the three have been submitted on the same record, and they shall be disposed of as one case.

The invention concerns an electric battery, and the claims of the issue are illustrated by the following:

No. 1,262.

1. An electrode for batteries composed of cupric oxid (CuO) and cuprous oxid (Cu_2O).

5. An electrode for batteries formed of cupric oxid and cuprous oxid in the form of scales of appreciable size bonded together and compressed into a dense hard mass.

11. The process of producing a copper oxid electric battery element, consisting in forming flakes of black or cupric oxid of copper carrying therewith portions of unoxidized copper and treating the said flakes to eliminate any unctuous matter therefrom, thoroughly mixing the flakes carrying the portions of unoxidized copper with a binder and pressing the mass thus produced into a desired shape so that the black or cupric oxid of copper and portions of the metallic copper will be regularly distributed throughout the body of the pressed mass, then subjecting the compressed mass to the action of heat until the compressed mass is cured and the binder reduced to a minimized residuum, then placing the compressed mass carrying the minimized residuum of the binder in the oven and subjecting the said mass to a high degree of heat to first burn out the binder residuum and next to change the metallic copper within the body of the mass of cuprous oxid, removing the mass now composed of cupric and cuprous oxids of copper from the baking oven and again compressing the same while red with heat, and finally allowing the plate to cool in the air.

No. 1,263.

1. A gelatinous alkaline electrolyte for primary batteries formed of an alkaline hydroxid of approximately 28° gravity Baumé with which vegetable starch is combined at a temperature of approximately 180° F. and in quantity substantially less than that required to gelatinize an equal quantity of water.

No. 1,264.

1. The herein described process of making an alkaline gelatinous electrolyte, consisting in thoroughly mixing a caustic alkaline solution comprising about one part of starch to ninety parts of the solution and thoroughly stirring the two components, subjecting the mixture of alkaline solution and starch to a degree of heat less than that required to boil the mixture to avoid the liberation of the constituents of starch that would have a tendency to harden the electrolyte, and allowing the mixture to cool to a pouring consistency.

Appellant was successful before the Examiner of Interferences and the Board of Examiners, but failed before the Assistant Commissioner. Originality is the crux of the dispute, and the question for decision is one of fact. Manchester and Spooner, being junior parties, must overcome the claim made by Engle or they cannot succeed. All the parties worked together in the same house upon the invention. Manchester and Spooner assert that they were partners with Engle; that he was merely a promoter and legal adviser, but supplied none of

the inventive ideas, while Engle says that Manchester and Spooner were employees of his; that he furnished the funds necessary to carry on the work, and also the ideas embodied in the invention.

The testimony is a tangled web of contradictions; none the less there are certain things in it which stand out prominently and point to the right direction for the investigator. One of the witnesses called by Manchester and Spooner refers to the battery throughout his testimony as Engle's, and speaks of Spooner as Engle's workman, though he later tried to change his testimony on the latter point. Spooner, without dissent, witnessed a contract, after it had been read to him, in which Engle was represented as the inventor, and both Manchester and Spooner knew that Engle was going to file an application for a patent on the invention, but neither objected. Indeed, Engle was distinctly asked in the presence and hearing of Manchester at the time his application for a patent was being prepared as to whether he, Engle, was the sole inventor, or a joint inventor with Manchester, and he answered that he was the sole inventor. Manchester did not deny it but acquiesced in the answer by his silence. Perhaps this conduct on the part of Manchester and Spooner may be explainable in harmony with their claim of inventorship. They attempt to show that it is by saying that they were misled by Engle, who, they assert, gave them to understand that he was the proper one to make the application, and that he would, after having obtained a patent, recognize their interests in it. This may be correct but it is difficult to accept it, for it means that they, knowing they were the inventors and that Engle was not, made no protest against his pretensions. They would have to be far less intelligent than the record shows them to be before we could believe that they did not understand that a person who is not an inventor cannot, under the statute, obtain a patent. These things, in connection with others in the record, tend to establish with much force that Manchester and Spooner have not sustained the burden of proof imposed upon them by the law. With great care the Examiner of Interferences and the Board of Examiners have analyzed the testimony in their respective opinions.

We are entirely satisfied with their reasoning, and therefore the decision of the Assistant Commissioner must be reversed and priority of the subject-matter involved in the three interferences awarded to Engle.

Reversed.

[Court of Appeals of the District of Columbia.]

IN RE MACLIN-ZIMMER-McGILL TOBACCO COMPANY, INCORPORATED.

Decided January 5, 1920.

271 O. G., 688; 49 App. D. C., 181; 262 Fed. Rep., 635.

1. TRADE-MARKS—"EL GALLO." (THE ROOSTER) ANTICIPATED BY "OUR ROOSTER" AND PICTURE OF A ROOSTER.

The Spanish words "El Gallo," meaning "The Rooster," as a trade-mark for tobacco, refused registration in view of the prior registration by another concern of the words "Our Rooster" and a picture of a rooster.

2. SAME—REGISTRABILITY—FOREIGN LANGUAGE.

A trade-mark otherwise not registrable is not made so because it is written in the Spanish language instead of English.

Mr. Henry M. Wise for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

ROBB, J.:

Appeal from a Patent Office decision refusing registration to the words "El Gallo" as a trade-mark for tobacco.

"El Gallo" is the Spanish for "The Rooster," and it appears that "Our Rooster" and a picture of a rooster have been registered as a trade-mark for tobacco by another concern. In *Nestlé & A S. C. Milk Co. v. Walter Baker & Co.* (C. D., 1911, 369; 167 O. G., 765; 37 App. D. C., 148) we ruled that "Milkmaid" and a pictorial representation of a milkmaid meant the same to the public, and that the—

right to employ one necessarily includes the right to employ both.

It matters not that appellant has employed the Spanish language instead of English. (*In re Bradford Dyeing Asso.*, C. D., 1917, 202; 243 O. G., 1309; 46 App. D. C., 512.)

The decision was right and is affirmed.

Affirmed.

[Court of Appeals of the District of Columbia.]

SEYMOUR v. MOLYNEUX.

Decided January 5, 1920.

271 O. G., 688; 49 App. D. C., 216; 268 Fed. Rep., 468.

1. INTERFERENCE—ISSUE—CONSTRUED IN LIGHT OF SPECIFICATION WHERE FIRST MADE.

"While * * * a party will not be permitted to narrow his claims to suit the exigencies of a given situation, it is equally well settled that the meaning given to the counts of an interference must be that disclosed in the specification of the party first to make the claim. (*Funk v. Whitely*,

25 App. D. C., 313; *Podlesak v. McInnerney*, C. D., 1906, 558; 120 O. G., 2127; 28 App. D. C., 399; *Viele v. Cummings*, C. D., 1908, 362; 134 O. G., 777; 30 App. D. C., 455.)"

2. SAME—SAME—RIGHT TO MAKE CLAIM—DEVICES DESIGNED TO MEET DIFFERENT PROBLEMS.

Where the count in controversy in an interference included guideways susceptible of being "adjusted angularly about their respective pivots" and was first made in the application of S., wherein precise adjustment was not only necessary but provided, and the other party M. provided adjustment for a different purpose and precise adjustment was unnecessary and unprovided, the two devices being constructed to meet different problems, *Held* that M. had no right to make the claim.

Mr. C. L. Sturtevant and *Mr. E. G. Mason* for the appellant.

Mr. John F. Heine for the appellee.

ROBB, J.:

Appeal from a decision of the Patent Office in an interference proceeding awarding priority to the senior party, the contention of the junior party being that his adversary has no right to make the claim.

As originally declared the interference contained a single count, which had been formulated by the Primary Examiner and suggested to the parties. The declaration of the interference having given each party access to the other's application, Molyneux presented an amendment containing six claims, which, as he represented to the Patent Office, embodied—

the substance of allowed claims 14, 15, 16 and 17 of the Seymour application.

Seymour rested his case upon the contention that Molyneux had no right to make any of the seven claims of the interference. A *pro forma* decision upon the record for the senior party was rendered by the Examiner of Interferences. The Board of Examiners-in-Chief sustained Seymour's contention as to all save count 5, and their decision was affirmed by an Assistant Commissioner. Count 5, the single count of this issue, reads as follows:

5. A feeding mechanism including, in combination, a feeding bar, two feeding elements arranged side-by-side and sustained by said feed-bar for lateral movements relatively to said feed-bar, guideway supporting means, guideways pivotally mounted on said supporting means and coöperating with the respective feeding elements for controlling the lateral movements thereof as the feed-bar moves back and forth, and means whereby said guideways may be adjusted angularly about their respective pivots to vary the amplitude of lateral movement of the feeding elements.

The invention, according to Seymour's specification—

relates to new and useful improvements in sewing machines, and more particularly to a sewing machine having mechanism for covering previously joined edges of fabric sections.

In the subjoined illustrative drawing entitled "Seymour" the two pieces of fabric in Figure 1, represented by the letters "a" and "b," have been stitched together in another machine at "c." Before being fed to the Seymour machine the fabric sections are opened out, as in Fig. 2, the result being a slight ridge at "c." Seymour's mechanism was designed and intended to cover the seam at "c," in Fig. 2, in such a way as to result in the entirely flat seam shown in Fig. 3. He says in his specification that the object of his invention is to—provide mechanism for exerting a strain on the fabric sections prior to, or as they are being covered by the stitch-forming mechanism, so that the seam will be substantially flat.

and to effectuate this he provides a mechanism—

wherein feed-dogs engage the respective fabric sections in advance of the stitching mechanism, and said feed-dogs are moved away from each other as well as in the direction of feed for exerting a strain on the joined edges as they are being covered by the stitch-forming mechanism.

The path of the feed-dogs is capable of accurate adjustment; in other words, the strain on the fabric may be precisely regulated. We do not deem it necessary to enter upon a technical examination of Seymour's mechanism. We have stated its function and it is enough to say that the machine is fully capable of performing its intended function, namely, to cover previously-joined edges of fabric sections so that the seam, when completed, is substantially flat.

Seymour.

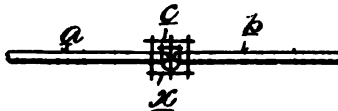
Fig. 1.



Fig. 2.



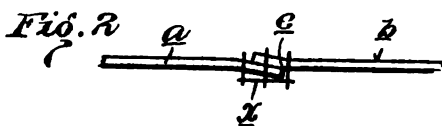
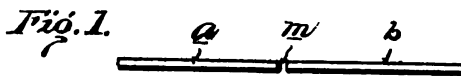
Fig. 3.



Let us now turn for a moment to the Molyneux device. That, too, relates to a sewing-machine, but Molyneux says the object of his invention is "to automatically lap two pieces of goods being stitched;" in other words, automatically lap and stitch two pieces of

goods, as illustrated below in the drawing entitled "Molyneux." The letters "a" and "b" in Fig. 1 represent the two pieces of goods to be lapped and stitched by the machine, and Fig. 2 the completed work.

Molyneux.



Molyneux points out in his specification that a greater overlap than is normally provided may be obtained by the pressing of a treadle by the operator.

It will thus be seen that the parties were concerned with entirely different problems, and the count of the issue, having originated with Seymour, must receive an interpretation consistent with his specification. While we many times have ruled that a party will not be permitted to narrow his claims to suit the exigencies of a given situation, it is equally well settled that the meaning given to the counts of an interference must be that disclosed in the specification of the party first to make the claim. (*Funk v. Whitely*, C. D., 1905, 670; 117 O. G., 280; 25 App. D. C., 313; *Podlesak v. McInnerney*, C. D., 1906, 558; 120 O. G., 2127; 26 App. D. C., 399; *Viele v. Cummings*, C. D., 1908, 362; 134 O. G., 777; 30 App. D. C., 455.) The patent law contemplates an interference in fact rather than in mere words, and unless such an interference really exists it is a hardship and an injustice to permit an earlier applicant to go out of the Patent Office with a dominating claim. The court always is reluctant in technical cases to disturb the findings of the Patent Office, but when convinced that an error has been made it is our duty to do so. (*Arbetter v. Lewis*, C. D., 1910, 371; 154 O. G., 516; 34 App. D. C., 491.) We are convinced in the present case that this claim, when interpreted in the light of the application in which it originated, is not readable upon the Molyneux structure; in other words, that there are two distinct inventions and that neither party should be given a claim that would dominate the other. In the Seymour structure, as already noted, the guideways are susceptible of very precise adjustment. This ob-

viously was necessary to accomplish the result desired. One limitation of the claim of the issue is that the guideways are susceptible of being "adjusted angularly about their respective pivots." Molyneux contended, and the Patent Office ruled, that the manually-operated treadle disclosed by Molyneux satisfied this limitation. We are unable to accept that finding. We think the term "adjusted," as here used, has a much more precise signification. Webster says that to adjust is "to fit, or make exact." In Seymour's machine precise adjustment not only was necessary but provided. In the Molyneux structure precise adjustment was unnecessary and unprovided. Certainly it may not be doubted that it would be impossible to achieve the same result with the manually-operated treadle of Molyneux that may be produced by the mechanically-operated device of Seymour. Having in mind that the problems confronting the two inventors were entirely different and that the machines designed for the solution of those problems also were entirely different, we are convinced that only by giving to the count of the issue a forced construction, out of harmony with the Seymour construction in which it originated, can it be read upon the Molyneux device; in other words, we are convinced that Molyneux has no right to make this claim.

It results that the decision must be reversed and priority awarded Seymour.

Reversed.

[Court of Appeals of the District of Columbia.]

SEYMOUR v. MOLYNEUX.

Decided January 5, 1920.

271 O. G., 690; 49 App. D. C., 219; 263 Fed. Rep., 471.

INTERFERENCE—RIGHT TO MAKE CLAIMS.

In an interference between S. and M., relating to a feeding mechanism for sewing-machines, where certain counts called for feed-dogs to engage the fabric "in advance of the stitch-forming mechanism," *Held* that M. had no right to make these claims in view of the fact that in his device the feed-dogs operated almost, if not entirely, in the rear of the needles, only a limited number of feed-dog teeth engaging the fabric in advance of the stitch-forming mechanism, while in S.'s case the dogs necessarily operated in advance of the stitch-forming mechanism.

Mr. C. L. Sturtevant and Mr. E. G. Mason for the appellant.

Mr. John F. Heine for the appellee.

ROBB, J.:

This appeal is from a Patent Office decision awarding priority on the record to the senior party Molyneux. Seymour's application in

this case is the same as that involved in *Seymour v. Molyneux*, *ante*, (p. 133,) but there is involved a different application of Molyneux. The issue is expressed in eleven counts, of which counts 1, 5 and 8 are illustrative:

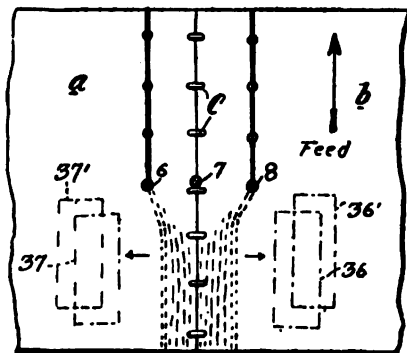
1. The combination of stitch-forming mechanism and four-motion feeding mechanism including a main feed-dog for engaging the stitched seam in rear of the stitch-forming mechanism, auxiliary feed-dogs for engaging the fabric in advance of the stitch-forming mechanism, and means for moving said auxiliary feed dogs away from each other while in engagement with the fabric.

5. A feeding mechanism for cylinder bed sewing machines including, in combination, a feed-bar having a forwardly extending free end-portion, two forwardly extending arms each carried by and movably connected at its rear end to the free end-portion of the feed bar, feeding teeth carried by said arms, and means for moving said arms in opposite directions during the feeding movements of the feed-bar for causing said feeding teeth to stretch the fabric.

8. In a sewing machine, the combination with stitch-forming mechanism including a pair of needle and covering thread handling means coöperating therewith to form seam-covering stitches, of means in advance of the needles for stretching and flattening a previously seamed fabric transversely of the line of seam and maintaining it stretched while the previously formed seam is being covered by said stitch-forming mechanism.

As in the prior case, the claims of this interference were added by amendments to the Molyneux application after the Seymour application had been inspected by Molyneux, and they "embody the substance of" claims in the Seymour application. The attached drawing, entitled "*Seymour*," illustrates the operation of his device.

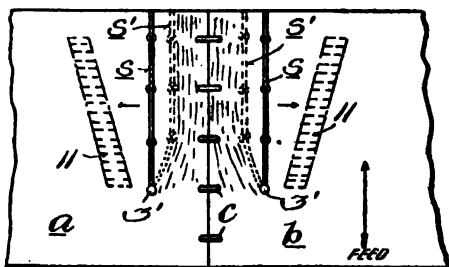
Seymour



In the Seymour device the main feed-dog operates upon the fabric in the rear of the needles, while the two auxiliary feed-dogs "36" and "37," shown in Figure 3 of the drawing herein inserted, engage the fabric in advance of the needles. The stroke of these auxiliary feed-dogs is a stitch length and has an outward motion, so that when

the fabric is presented to the needles it is stretched flat. This is what Seymour intended to accomplish, and what in fact he did accomplish. Molyneux, according to his specification, was concerned with overcoming the tendency of light and elastic goods to "draw or pucker" when being covered, and hence his machine was designed to operate, and does operate, quite differently from that of Seymour, as illustrated in the drawing below.

Molyneux.



It will be observed that in the Molyneux machine the feed-dogs operate almost, if not entirely, in the rear of the needles. The Examiners-in-Chief recognized that only a limited number of feed-dog teeth engage the fabric in advance of the stitch-forming mechanism, and the Assistant Commissioner was of the view that only a "small part" of the feed-dogs "work in advance of the needles." In the Seymour device it was essential that the auxiliary feed-dogs should have performed their entire function before the covering-stitch was made; in other words, it was essential that at the moment when the seam was being covered the auxiliary feed-dogs should hold the fabric in a stretched and flat position. It was not to prevent a "draw or pucker," but to eliminate a ridge where two fabrics previously had been stitched together, that Seymour devised and constructed his machine. The importance of this distinction becomes apparent when an examination is made of the two drawings hereinbefore inserted and of the phraseology of the claims. In all save claims 5 and 6 is a limitation that the auxiliary feed-dogs shall engage the fabric "*in advance of the stitch-forming mechanism.*" The reason for this limitation, which was essential rather than arbitrary or accidental, we already have stated. We think it obvious that, even though one or two of the Molyneux feed-dog teeth engage the fabric at the instant the covering-stitch is formed, it is a physical impossibility to accomplish through that engagement what Seymour's machine was designed to accomplish and does accomplish, namely, the flattening out and elimination of a ridge. To conclude

otherwise would be to shut our eyes to the obvious. The Molyneux device, however, does accomplish the result intended by him, for his dogs are so arranged as to hold the fabric during and after the formation of the stitch in such a position that the fabric will not be drawn up by the action of the threads. Giving the claims mentioned the signification to which they are entitled in the Seymour application, where they originated, they are not readable upon the Molyneux machine.

Claims 5 and 6 do not contain the limitation that the auxiliary feed-dogs must engage the fabric in advance of the stitch-forming mechanism. It is earnestly contended by Seymour that the Molyneux device contains no auxiliary feed-dogs in the sense in which that term is used by Seymour. While that question is not free from doubt, we are inclined to accept the finding of the Patent Office, which results in an affirmance of the decision as to claims 5 and 6.

The decision is reversed as to claims 1, 2, 3, 4, 7, 8, 9, 10, and 11, and affirmed as to claims 5 and 6.

Reversed in part and affirmed in part.

[Court of Appeals of the District of Columbia.]

IN RE SMITH.

Decided January 5, 1920.

271 O. G., 691; 49 App. D. C., 189; 262 Fed. Rep., 643.

1. JURISDICTION—COMMISSIONER OF PATENTS—APPEAL TO COURT PERFECTED.

The Commissioner of Patents has no jurisdiction to consider claims presented to him after an appeal to the court of appeals has been perfected as to other claims.

2. APPEAL—MATTERS RENEWED—CLAIMS NOT CONSIDERED BY COMMISSIONER.

Where, after an appeal to the court of appeals from a refusal to allow certain claims is perfected, an applicant presented for consideration certain other claims as substitutes in a petition for rehearing, which was denied, and such claims are presented to the court on the appeals, *Held* that the court will not consider them, as appeal lies only from a final decision.

(*For Commissioner's decision see ante, 2; 271 O. G., 155.*)

Mr. E. S. Clarkson for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

VAN ORSDEL, J.:

This appeal is from a decision of the Commissioner of Patents denying the application of appellant for a patent on improvements in hydroaeroplane construction.

The application is in forty-one claims, all of which were considered by the tribunals of the Patent Office and refused in the light of the

prior art: On appeal to this court, appellant has abandoned all but ten of the claims.

It appears that on November 24, 1914, applicant was granted a patent on the present disclosure with claims limited to the aeroplane features. Whatever aeroplane features are contained in the present application could have been claimed in that patent. It was, therefore, held not to constitute invention to substitute his patented aeroplane in hydroplanes of the prior art. To review in detail appellant's claims, or the relation of the prior art to his disclosure, would amount merely to a restatement of that which is clearly set forth in the opinions of the respective tribunals of the Patent Office. The combination here sought to be patented, while not disclosed in a single structure of the prior art, is so completely shown in different prior inventions as to admit easily of mechanical simulation. Such an assembling of mechanical equivalents of features old in the art into a single structure does not constitute invention.

After the present appeal had been perfected, applicant filed with the Commissioner of Patents a petition for a rehearing, asking permission to withdraw the entire forty-one claims appealed and present in lieu thereof six claims. The Commissioner denied the rehearing, and applicant seeks a hearing upon the substituted claims in this court. It is clear that claims cannot be here considered, since an appeal only lies from a final decision of the Commissioner on the issue of patentability. The claims were not presented to the Commissioner until the case had passed beyond his jurisdiction, and no case was before him in which the claims could be heard or to which a judgment thereon could attach. It follows, therefore, that no proper judgment on the patentability of these substituted claims is before this court for review.

The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as by law required.

Affirmed.

[Court of Appeals of the District of Columbia.]

BRAUN v. WIEGAND.

Decided January 5, 1920.

272 O. G., 179; 49 App. D. C., 193; 262 Fed. Rep., 647.

1. INTERFERENCE—ORIGINALITY—EVIDENCE CONFLICTING—CIRCUMSTANCES.

Where evidence on the question of originality is very conflicting, nearly every material statement made by one side being denied by the other, the accuracy of the evidence must be tested by the circumstances surrounding the parties, as well as by things done or omitted to be done by them and about which there is no controversy.

2. SAME—SAME—APPLICATION AND PATENT—BURDEN OF PROOF NOT SUSTAINED.

Where in an interference involving the application of B. and a patent to W. it appeared that the question was one of originality, that both parties were employed by the same company, that B. did not file his application until long after the invention patented by W. had gone into commercial use and more than nine months after the grant of W.'s patent, though prior to the time that the device of W. was adopted the devices manufactured by the company were unsatisfactory and the company was anxious to discover a device that would meet with approval, and that B. was working on a less satisfactory device, *Held* that the testimony on behalf of B. was insufficient to establish beyond a reasonable doubt that he was the first to conceive the invention.

Mr. Harry Frease and Mr. L. C. Wheeler for the appellant.

Mr. John B. Hull and Mr. Harold E. Smith for the appellee.

SMYTH, C. J.:

Braun appeals from a decision of the Assistant Commissioner of Patents awarding priority to Wiegand in an interference concerning the invention of an apparatus for embedding an electric-resistance wire in the insulating portion of heating devices, such as an electric sadiron. There are 14 counts; illustrated sufficiently by counts 1, 5, 6 and 9:

1. In an apparatus of the character described, the combination of a base support, a supporting device for a conductor, means for moving said device toward and from the base, and means adapted to remove the conductor from its supporting device and apply it to the base.

5. As a means for applying a conductor to a suitable base, the combination of a plurality of pins whereto the conductor is applied, and means coöperating with the conductor to remove the same from the pins.

6. As a means for applying a conductor to a suitable base, the combination of a support for a conductor, and means coöperating with the conductor to remove the same from the support.

9. In an apparatus of the character described, the combination of a base support, a base plate having a plurality of pins projecting therefrom on the ends of which the conductor is wound, a stripping plate mounted on the pins and interposed between the conductor and the base plate, means for moving said base plate toward the base support, and means for moving the stripping plate relatively to the base plate to remove the conductor from the projecting ends of the pins.

Both parties claim the invention and rely upon the same reduction to practice, which was accomplished in the shops of their employer, the Dover Manufacturing Company, Dover, Ohio. The problem to be solved, therefore, is one of originality. Wiegand was granted a patent for the invention March 30, 1915, on an application filed January 9, 1914. Braun did not apply for a patent until January 19, 1916. In order, therefore, that Braun may succeed he must establish beyond a reasonable doubt that he is the inventor. (*Sharer v. McHenry*, C. D., 1902, 503; 98 O. G., 585; 19 App. D. C., 158; *Dashiell v. Tasker*, C. D., 1903, 551; 103 O. G., 2174; 21 App. D. C.,

64; *Sendelbach v. Gillette*, C. D., 1904, 597; 109 O. G., 276; 22 App. D. C., 168; *Schmidt v. Clark*, C. D., 1909, 280; 138 O. G., 768; 32 App. D. C., 291.)

Braun is an electrical engineer, and entered the employ of the Dover Manufacturing Company in April, 1911, and, for aught that appears, is still there. His first work for that company was to design a sadiron embodying an automatic control for which he had previously secured a patent. This proved so unsatisfactory that the officers of the company became convinced that the iron would have to be improved or its manufacture discontinued.

Wiegand, a young man, became an employee of the same company in June, 1911. He had taken a course in electrical engineering and, with his brother, had equipped a shop at his home, where he made various electrical devices, such as motors, batteries, etc. In January, 1912, he was assigned to the work of assembling and testing the irons which the company was manufacturing. After awhile he became foreman of the electric-flatiron department and was regarded as an expert in that line.

Braun assigned his application to his employer. Nearly all his witnesses are officers of that company, while Wiegand depends on the testimony of himself, his brothers, and a friend. The evidence is very conflicting,—nearly every material statement made by the one side is denied by the other. We must, therefore, test its accuracy by the circumstances surrounding the parties, as well as by things which were done or omitted to be done by them, and about which there is no controversy.

An important consideration in this connection is the fact that the sadirons which the company was manufacturing were totally unsatisfactory, and consequently that it was very anxious to discover an iron which would meet the requirements of the trade. Keeping this in mind we find that Braun's preliminary statement asserts conception in October, 1911, and disclosure about January 15, 1912. Haug, the general superintendent of the company, testified that in the early part of December, 1911, after the president of the company had strongly expressed to Braun his dissatisfaction with the latter's first invention, Braun came into the office where Haug was, made sketches and explained in detail the complete machine of the issue. Yet that machine was not constructed until the latter part of 1912. It appears, also, that before the device disclosed by Braun, according to Haug, was developed Braun spent several months working on a less satisfactory form, but finally returned to the form first conceived. If Haug's recollection as to the time of the disclosure be correct, why the delay in preparing the structure for the market? Especially pertinent is this inquiry in view of the earnest desire of the company to discover an acceptable device. The trade was waiting for it; the

company had it, according to Haug, and yet neglected to construct it and put it on sale. It is claimed on behalf of Braun that there are a number of witnesses who testified that he commenced work upon the machine of the issue in January, 1912, but we do not think that testimony supports the claim. It relates to what is known as the groove type of winding-form which was operated by hand for a little while, and not to the pin type of winding-form, which is the invention in controversy.

Wiegand gave much attention to experimental work. Besides the patent in controversy he had obtained two other patents. It is admitted that he made the working drawings for the machine of the issue. He claims that they were made at his home, while Braun insists that they were made at the factory under the latter's directions. Wiegand is supported by the testimony of his brother, who says that the drawings were made at his home at night. Another brother testifies that in June, 1912, Wiegand told him that he had a machine figured out which

would bring this wire down, put it in the bottom all at once, something in this style.

and illustrated it by bringing his right hand down into his left hand. Wiegand filed his application in January, 1914, and left the company in the summer of that year. This shows that Wiegand had a conception of the invention of the issue before Braun, unless the latter has established beyond a reasonable doubt that he conceived it in 1911 and disclosed it in January, 1912. But he has not done so.

In addition to this it must not be overlooked, because it is in our judgment of much importance, that Braun did not apply for a patent until nine months after Wiegand's patent had issued, and not until over three years after the invention patented by Wiegand was to a large extent in commercial use. Braun knew that Wiegand had applied for a patent and that he had received one; nevertheless he, though he had been seeking earnestly the device of the issue, made no objection whatever at the time. Not only that, but he permitted more than two years to elapse between the date on which he claims to have made a disclosure of the device, and the time of his application for a patent thereon, thus allowing the bar of public use to run against any right that he might otherwise have to a patent. This in itself constitutes strong evidence against him. (*Sendlebach v. Gillette*, C. D., 1904, 597; 109 O. G., 276; 22 App. D. C., 168.) All these things, when considered, convince us that as to all the claims, except No. 6, Braun has not established beyond a reasonable doubt that he is entitled to them.

But with respect to claim 6, we think that he has clearly proven by the required quantum of evidence that the device on which it reads

was made and used in January, 1912, prior to the date of conception claimed by Wiegand. There is no limit in it to the pin type of winding-form, nor is there any limitation to an organized machine for supporting the form and bringing it down to the base whereon the plastic material is supported. It calls particularly for a means of applying a conductor to a suitable base, including or comprising a support for the conductor, which may be the grooved winding-form of Braun's Exhibit 13, and means coöperating with the conductor to remove the same from the support which in Braun's Exhibit 13 may be the movable spider with which the form is provided, and therefore we think that Braun is entitled to this claim.

The decision of the Assistant Commissioner of Patents is affirmed with respect to all the claims excepting claim 6, and as to it priority of invention is awarded to Braun.

Modified.

[Court of Appeals of the District of Columbia.]

LEE AND HOGAN, JR., v. VREELAND.

Decided January 5, 1920.

272 O. G., 180; 49 App. D. C., 200; 262 Fed. Rep., 654.

1. INTERFERENCE—PRIORITY—RIGHT TO TAKE TESTIMONY ON OPERATIVENESS.

An affidavit filed by L. and H. alleging that an apparatus like that shown in V.'s earlier application, of which the application in interference is a division, had been constructed by them and had been found to be inoperative, *Held* sufficient to overcome the *prima facie* showing of V. where it appeared that V.'s earlier application was filed more than five years prior to the filing of the application of L. and H., that the subject-matter is highly technical and very decided advances in the art had been made since the filing of V.'s earlier application, and that V. did not seriously contend that his early device was operative for practical purposes, but only that it could be made so by a skilled mechanic.

2. SAME—SAME—SAME.

Where it appeared that an affidavit made out a *prima facie* showing of inoperativeness of the apparatus of the early application of the senior party, in view of which judgment had been rendered in favor of him, the judgment reversed and the case remanded for trial on its merits.

Mr. F. W. Winter for the appellants.

Mr. F. L. Dyer and *Mr. Melville Church* for the appellee.

ROBB, J.:

Appeal from a decision of the Commissioner of Patents in an interference proceeding awarding priority of invention to the party Vreeland upon the record, neither party having taken testimony.

The application of Lee and Hogan was filed on November 16, 1912, and ripened into a patent (No. 1,141,717) on June 1, 1916. Vree-

land's application in interference was filed October 27, 1916—or nearly five months after the grant of the Lee and Hogan application—as a division of an earlier application filed January 2, 1907, upon which a patent was issued September 1, 1917. In the divisional application Vreeland copied verbatim claims from the Lee and Hogan patent. The contention of Lee and Hogan is that the apparatus disclosed by Vreeland in his early application is inoperative, and that their motion for leave to take testimony to that effect should have been allowed; in other words, that, in the circumstances of the case, Vreeland was not entitled to an award of priority on the record.

The invention relates to an improvement in wireless receiving systems and particularly for receiving persistent and continuous waves. It is conceded that this is a highly-technical subject-matter, in which very slight changes and modifications may be of great importance, and it clearly appears that there has been a very decided advance in the art since the filing of Vreeland's original application. Moreover, it should be observed that the claims having originated with Lee and Hogan, they must be given an interpretation in harmony with that patent.

Under the view we have taken of the case, we do not deem it necessary to do more than set forth the substance of the affidavit which Lee and Hogan filed to overcome the effect of Vreeland's original filing date. In that affidavit it is stated that an apparatus like that shown in Vreeland's early application had been constructed by the affiant and had been found to be inoperative; that the Vreeland battery is short-circuited around the detector, and that if there were assumed such values of the elements of the circuit as prevailed in actual practice and hence were known to those familiar with the art, the device would not be operative. Vreeland, both in the Patent Office and in the argument at bar, did not seriously contend that his early device as shown was operative for practical purposes, but he did contend that it could have been made so by a skilled mechanic. The Examiner of Interferences ruled that the affidavit of Lee and Hogan stopped short of showing that, by assuming values other than those commonly used, the Vreeland structure would not operate. The Examiners-in-Chief were of the view that—

the accuracy of the conclusions of neither party, based on the conditions assumed by him, can be assailed. The question is a practical one, depending largely upon how far in an actual system we may depart from the theoretical value of a zero resistance in the resonant circuit without seriously interfering with the operation of the system, etc.

The Commissioner, while expressing some doubt as to certain of the conclusions reached by the lower tribunals, accepted those conclusions.

The authority of the Commissioner to award priority on the record to the senior applicant in a proper case, is settled. (*Ewing v. Fowler Car Co.*, C. D., 1917, 409; 238 O. G., 983; 244 U. S., 1.) In that case the applicant last to file *had copied the claims of the earlier applicant* and failed to—

intimate the existence of any circumstances which would overcome the priority of invention as determined by the difference in times of the conception of the contending applicants. * * * There was not only the precedent conception, said the Court—

but there was its expression in claims; and that it was practical, a useful gift to the world, petitioner concedes by adopting the claims. There were, therefore, all of the elements of a completed invention—one perfected before the filing of petitioner's application.

The present invention, as we have stated, relates to an obscure and highly-technical art. The claims of the later applicant were copied by Vreeland, and the later applicant has filed an affidavit to the effect that the apparatus disclosed in the early application, if tested in the light of the development of the art at the time that application was filed—that is, in 1907 instead of 1916, the date of the affidavit—is inoperative. The affidavit further alleges that certain changes in the apparatus amounting to invention are essential to operativeness. We are of the view that, in the circumstances of the case, the affidavit overcame the *prima facie* showing of the senior party.

The decision is therefore reversed and the case remanded for a trial on the merits.

Reversed and remanded.

[Court of Appeals of the District of Columbia.]

IN RE STEPHENS-ADAMSON MANUFACTURING COMPANY.

Decided January 5, 1920.

272 O. G., 181; 49 App. D. C., 181; 262 Fed. Rep., 635.

1. TRADE-MARKS—REGISTRABILITY—DESCRIPTIVE MARK—CANCELATION OF DESCRIPTIVE ELEMENT.

Where the words "Unit Carrier," for roller-brackets for belt conveyers, were refused registration because descriptive, the refusal by the Commissioner of an application for leave to strike out the word "Carrier" was error. (*In re Beckwith*, C. D., 1918, 179; 252 O. G., 245; 48 App. D. C., 110.)

2. SAME—DESCRIPTIVENESS AND SUGGESTIVENESS—"UNIT" MERELY SUGGESTIVE.

Although a mark to be suggestive must contain some element of descriptiveness, this does not render it obnoxious to the law. The word "Unit,"

for roller-brackets for belt conveyers, *Held* merely suggestive, and therefore registrable.

Mr. L. K. Gillson and Mr. C. B. Gillson for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

SMYTH, C. J.:

The Stephens-Adamson Manufacturing Company applied to have the words "Unit Carrier" registered as a trade-mark for roller-brackets for belt conveyers, but the application was denied on the ground that the words were descriptive. While the application was pending a motion for leave to strike out of the mark the word "Carrier" was overruled by the Commissioner of Patents. According to the decisions of this court (*in re Beckwith*, C. D., 1918, 179; 252 O. G., 245; 48 App. D. C., 110, and authorities there referred to,) this was error.

Considering the mark as embracing merely the word "Unit," the question as to whether or not it is descriptive is a close one. We have sustained the word "Cream" as a valid trade-mark for baking-powder over the objection that it was descriptive. And the following words have been upheld: "Holeproof," as applied to hosiery, (*Holeproof Hosiery Co. v. Wallach Bros.*, 172 Fed. Rep., 859;) "Cream," as applied to rolled oats, (*Albers Bros., Milling Co. v. Acme Mills Co.*, 171 Fed. Rep., 989;) "Anti-Washboard," as applied to soap, (*O'Rourke v. Central City Soap Co.*, 26 Fed. Rep., 576,) and many others, equally suggestive, referred to in the last case where the opinion is by Judge Brown, afterward Mr. Justice Brown of the Supreme Court of the United States. He said of the words "Anti-Washboard" that they were not objectionable—

although the natural inference from them is that by the use of the soap the necessity of rubbing the clothes is obviated.

Continuing he ruled:

We incline to the opinion that they are rather suggestive than descriptive, and that they may be properly claimed as a trade-mark.

It may be said that a mark to be suggestive must contain some element of descriptiveness; but if this be true, it seems from the foregoing decisions that this does not render it obnoxious to the law. The word "Unit" is not descriptive, therefore, because it may suggest to the mind that the carrier, consisting of three rollers, moves as one. Standing alone it does not necessarily indicate "a plurality of similars." It refers as well to a single person or thing. (*Standard Dictionary*, 1913.) In electricity we speak of a unit current,—one in which a unit quantity of electricity flows in unit time. We think, therefore, that the applicant company, upon eliminating the word

"Carrier," is entitled to have the word "Unit" registered as a trade-mark for the goods mentioned in its application. *The decision of the Commissioner is reversed.*

Reversed.

[Court of Appeals of the District of Columbia.]

IN RE LOWER.

Decided February 2, 1920.

272 O. G., 913; 49 App. D. C., 226; 263 Fed. Rep., 478.

PATENTS—INVENTION—DUPLICATION OF PARTS.

Claims for a locomotive-stoker covering mechanism for transferring coal from a tender to a locomotive having a plurality of devices for independently elevating the coal from the transfer mechanism to the fire-box of the locomotive *Held* unpatentable as involving only a duplication of the conveyers of the prior art.

Mr. L. K. Gillson and Mr. G. B. Gillson for the appellant.

Mr. T. A. Hostetler for the Commissioner Patents.

SMYTH, C. J.:

The Patent Office rejected claims 1, 2, 14, and 15, of the appellant's application for a patent on a device relating to a locomotive-stoker, on the ground that they were anticipated by a number of references. Claims 1, and 15, are typical. They read:

1. In a locomotive stoker, in combination, fuel transfer mechanism adapted to be located below the deck of a locomotive and its tender, a plurality of conduits receiving and leading upwardly from the transferring mechanism, and delivering independently to the fire-box of the locomotive, and elevating means within each of such conduits.

15. In a locomotive stoker, in combination, fuel transferring mechanism adapted to be located below the deck of a locomotive and its tender, a plurality of elevating means receiving from the transferring mechanism and adapted to deliver fuel to the fire-box of the locomotive.

The structure covered by the appealed claims embraces a mechanism for transferring coal from a tender to a locomotive, and a plurality of devices for independently elevating the coal from the transfer mechanism to the fire-box of the locomotive. The references chiefly relied upon are Brewster, 880,623, March 3, 1908; Fortune, 835,106, November 6, 1906; Elvin, 1,058,356, April 8, 1913; and Street, 1,130,443, March 2, 1915. The Board of Examiners in refusing to allow the claims said:

Claim 1 reads directly upon the patent to Street or Elvin, except for the statement that there is a plurality of conduits receiving and leading upwardly from the transferring mechanism, etc. It sets forth no specific construction

or arrangement of the parts and amounts to nothing more than the duplication of the conveyers of the three references. The brief asserts that it is not clear how the conveyers of the references could be duplicated. As the claim calls for no specific construction of conveyer, the question is not whether the specific conveyers of these references could be duplicated, but whether it would be possible without invention to provide a plurality of conveyers of any kind leading to separate openings in the fire box. We think there would be no difficulty in doing this, and do not consider that claim 1 sets forth anything which can be held patentable. The same treatment applies also to claims 2, 14, and 15.

For substantially the same reasons the Assistant Commissioner affirmed the action of the Board. We think he was right.

It is undoubtedly true, as urged by the appellant, that old parts may be so combined as to produce a new and valuable result which would be patentable. (*Goss Printing Co. v. Scott*, 108 Fed. Rep., 253;) but, for the reasons stated by the Patent Office tribunals, we do not think that the result obtained by the applicant comes within the purview of the rule. Nor is this case like *in re Rowell*, (C. D. 1919, 164; 259 O. G., 778; 48 App. D. C., 238,) where it was shown that the different inventions preceding Rowell's were failures and that he solved the problem which had puzzled others. It was there asserted that certain references anterior to Rowell's conception taught him how to do the thing which he had accomplished, but this court said it was strange that they were able to teach Rowell that which they failed to teach their own inventors. There is no analogy between the two cases.

The decision of the Patent Office is affirmed.

Affirmed.

[Court of Appeals of the District of Columbia.]

SCANNELL v. BETHKE.

Decided February 2, 1920.

278 O. G., 186; 49 App. D. C., 402; 262 Fed. Rep., 1023.

PATENTS—INTERFERENCE—PRIORITY.

Evidence considered and *Held* that priority of invention was properly awarded by the lower tribunals to Bethke.

(*For Commissioner's decision see ante*, 11; 273 O. G., 185.)

Mr. C. E. Riordan and *Mr. W. S. Hodges* for the appellant.

Mr. A. L. Morsell and *Mr. C. D. Davis* for the appellee.

PER CURIAM:

This is an interference proceeding which solely turns upon issues of fact. After a careful review of the testimony and the concurring decisions of the tribunals of the Patent Office, we are convinced that

no error was committed. The testimony is fully and fairly reviewed in the decision of the Commissioner and a further review here would serve no good purpose.

The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as required by law.

[Court of Appeals of the District of Columbia.]

DICKINSON v. SWINEHART.

Decided February 2, 1920.

273 O. G., 407; 49 App. D. C., 222; 263 Fed. Rep., 474.

1. PATENTS—INTERFERENCE—DILIGENCE.

The diligence required of one first to conceive and last to reduce to practice need not be extraordinary. "It needs to be only reasonable under the circumstances of the case, nor does it 'involve uninterrupted effort nor the concentration' of all the applicant's energies upon the single enterprise."

2. SAME—SAME—SAME.

D. conceived the invention in August, 1912, disclosed it in November, 1912, and immediately after the disclosure caused a draftsman to commence work on drawings for a machine. D. was obliged to be away from his home for a considerable period from March, 1913, to February, 1914, but during this time draftsmen were working on drawings under his directions, and a model apparatus for producing the process of the invention was completed in June, 1914. D.'s application was filed on February 26, 1915. S. alleges conception and disclosure in February, 1913, and filed his application on December 16, 1914. *Held* that D. was not lacking in diligence.

3. SAME—REDUCTION TO PRACTICE—PROCESS—NECESSITY OF TESTING PRODUCT PRODUCED.

Quære: Whether the practice of a process for making a cord tire which involved "winding the cord spirally around a support to produce a fabric web, and thereafter shifting said cord to change the angle of the cord element relative to the sides of said web," without embodying the web so formed into a tire, is a reduction to practice.

Mr. J. R. Littell and *Mr. J. C. Dowell* for the appellant.

No appearance or brief for the appellee.

SMYTH, C. J.:

Dickinson appeals from a decision of the Patent Office, awarding priority to Swinehart for a method of making a cord fabric or fabric carcass which forms the foundation of a pneumatic tire. There are seven claims involved of which claim 1 is illustrative. It is as follows:

1. The method of making a tire skeleton, which comprises winding cord spirally around a support to produce a fabric web, and thereafter shifting said cord to change the angle of the cord elements relative to the sides of said fabric web.

Swinehart filed his application on December 16, 1914, and Dickinson, February 26, 1915. Therefore the onus of proof is on Dickinson. The Examiner of Interferences found in favor of Dickinson, but he was reversed by the Board of Examiners, whose decision was affirmed by the First Assistant Commissioner.

The record establishes that Dickinson conceived the invention in August, 1912, and disclosed it in the following November. Immediately after the disclosure, he caused a draftsman to commence work on drawings for a machine for manufacturing a tire skeleton according to the method of the issue. This work was continued until March, 1913, when it was turned over to another draftsman. Dickinson, by reason of his brother's illness, was required to be absent from New York, where the work was being carried on, for a considerable period in 1913, and during the month of January, 1914, but while he was away, his draftsman was at work under his directions communicated by letter. In June of the latter year, Dickinson had, according to his own testimony, supported by that of three witnesses, completed a model apparatus by which a complete fabric carcass could be made, and he also constructed on the model such a carcass by pursuing the method of the issue, but the Board and the Assistant Commissioner thought that he should have gone further, and shown that the cords as laid up by him on the model could be embodied into a fabric tire without further invention; and that since he had failed to do this, he was not entitled to have the work done in June considered as a reduction to practice. The Examiner of Interferences, on the other hand, was of the opinion that the counts of the issue did not require him to do more than he had accomplished. We doubt this. He was required to produce a "tire skeleton" or carcass. Unless the skeleton constructed by him could be used in making a tire, it would not meet the issue, since it would not be a "tire skeleton." But as we view the case, this is immaterial.

Dickinson, as we have said, was the first to conceive and disclose the invention. This is clearly established. Was he diligent between the disclosure and the date on which he filed his application? The diligence required is not extraordinary. It needs to be only reasonable under the circumstances of the case, nor does it "involve uninterrupted effort nor the concentration" of all the applicant's energies upon the single enterprise.

The health, the means, the liberty of the inventor * * * are proper subjects for consideration—

in determining the question. (1 Rob. on Pats., sec. 387; Walk. on Pats., 5th ed., sec. 91; *Courson v. O'Connor*, C. D., 1916, 250; 224 O. G., 1057; 227 Fed. Rep., 890.)

From Dickinson's return to New York after the January, 1914, absence, he was continuously at work until he filed his application

in the Patent Office, February 26, 1915. This is made clear by his own testimony and that of his witnesses. And the Board of Examiners found—

that the proofs of his activity during that period are fairly satisfactory.

Serious fault, however, is found with the evidence covering the time between his disclosure in November and his return to New York in 1914. We have already called attention to the work done anterior to March, 1913, when he employed a new draftsman, one Hawkins. In addition, it should be stated that at the time of the disclosure, he made arrangements with Block to supply finances for the development of his ideas and the manufacture of a model embodying them. Hawkins says that Dickinson endeavored to have him come to Indiana to carry on the work with him there, but that he had transactions in New York, from which he could not separate himself; that he was in continuous communication with Dickinson during his absence, concerning different phases of the work, and that the work on the machine drawings was carried on "without interruption during his (Dickinson's) absence." Mansuy, an experienced tire constructor, corroborates Dickinson and Hawkins in many important respects. He says that between August, 1912, and the time he was testifying, Dickinson called on him frequently and thoroughly discussed with him the construction of the machine and the drawings therefor. The First Assistant Commissioner criticizes this testimony on the ground that it is too general and adds that in his view the drawings introduced in evidence did not indicate that any such period of time as the witnesses said was necessary for their preparation. Perhaps not, but the drawings in evidence were not the only ones upon which work had been done. Dickinson testified that—

many of the study drawings were destroyed with intent and many of the assembly and detail drawings were ruined by the overturning of a vessel of some kind containing acid. * * *

All these witnesses were intelligent men, familiar with the subject about which they testified and, with the exception of Dickinson, were disinterested. If we believe them, and there is no reason why we should not, we must conclude that during the period in question work on the machine drawings was carried on, in the language of Hawkins, "without interruption." Of course, it may be that the drawings could have been made in a shorter time, and that every moment of the inventor's time was not given to their preparation or work in connection therewith, but this was not necessary.

The law—

says Judge Drummond—

looks with indulgence upon the delays which arise from the circumstances of the parties, who may make an invention, and it is only when the invention is inten-

tionally abandoned or neglected that the law declares they shall not be protected in their invention. (*Sayles v. Chicago & N. W. R. R. Co.*, 1 Bls., 468.)

There is nothing here to indicate intentional abandonment or neglect. Everything points to the contrary.

Swinehart does not claim conception and disclosure prior to February, 1913, and, according to his own testimony, did not make a frame on which to wind the cord in forming the carcass by the method called for by the issue which he "considered practical," until February, 1915. In view of this, the earliest date which can be given to him for reduction to practice, is his filing date, December 16, 1914. Dickinson, having conceived and disclosed the invention in 1912, several months before him, and having been reasonably diligent from that time down to the filing of his application, he is entitled to priority over Swinehart.

The decision of the Patent Office is therefore reversed and priority is awarded to Frederick S. Dickinson.

Reversed.

[Court of Appeals of the District of Columbia.]

THE R. M. HOLLINGSHEAD CO. v. AREA MANUFACTURING CO.

Decided February 2, 1920.

273 O. G., 408; 49 App. D. C., 229; 263 Fed. Rep. 625.

TRADE-MARKS—PRIORITY—EVIDENCE OF PRIORITY.

Where appellant, The R. M. Hollingshead Co., proved use of the mark "Gear Life" for lubricating compounds not earlier than April, 1916, and a witness on behalf of appellee, the Area Manufacturing Co., testified that in August, 1915, packages of grease were shipped bearing this mark stenciled thereon, and way-bills of shipments were produced, though not referring to the mark, and a traveling salesman testified that he took orders for "Gear Life" compound between February 1, 1916, and the following May, and that during this time he stenciled the mark on packages containing the compound and gave the names of parties to whom the goods were sold, which evidence was corroborated by other witnesses, and appellant did not avail himself of the opportunity to call any of the parties referred to in the way-bills or to whom the goods were alleged to have been sold, *Held* that the evidence was sufficient to prove priority of use by appellee.

Mr. E. H. Fairbanks for the appellant.

Mr. R. F. Steward and *Mr. Luther Johns* for the appellee.

VAN ORSDEL, J.:

This is a trade-mark interference. Each party applied for the registration of the words "Gear Life" as a trade-mark for lubricating compounds. From a decision in favor of the Area Manufacturing Company the Hollingshead Company has appealed.

It is not seriously contended that appellant company can claim use of the mark prior to April, 1916. We think the evidence clearly establishes sales by appellee company of lubricating compounds bearing the words "Gear Life" prior to April, 1916. An employee in the Soo Line Railroad office at Area, Ill., testified that early in August, 1915, boxes, kegs and barrels of grease were shipped by the appellee company from that station which were stenciled with the words "Gear Life." The way-bills of these shipments were produced, which merely showed the shipment of "grease;" but in the abbreviated form in which way-bills are usually made out no inference can be drawn from the failure to enter thereon the trade-name of the goods.

A traveling salesman for appellee company testified that he took orders for "Gear Life" compound between February 1, 1916, and the following May, and also that during that period he stenciled the words "Gear Life" on packages containing the compound of appellee company. He also gave the names of parties to whom he sold these goods during February and March, 1916. These parties, as well as the names of the consignees shown upon the way-bills, were available to appellant to disprove the very important testimony of the salesman and the railroad agent.

The foregoing evidence was corroborated by numerous witnesses, a number of whom may be considered as interested, but on the whole the proof in support of appellee company's prior right to registration must be accepted.

The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as by law required.

Affirmed.

[Court of Appeals of the District of Columbia.]

DUNCAN v. SHELLY.

Decided March 1, 1920.

273 O. G., 409; 49 App. D. C., 243; 263 Fed. Rep., 639.

1. PATENTS—PRIORITY—ABANDONMENT OF FIRST EXPERIMENTAL DEVICE.

Where S. constructed an experimental device relating to phonograph-stops in May, 1914, and tested it, but dismantled it and admitted that he had no intention of using it again, and soon thereafter caused an application to be prepared, but did not file it, although he was able to do so, and did nothing further until February, 1916, when he built a second device, which was submitted to a company interested in such attachments, which purchased the invention in March, 1916, after they had experimented with the invention of D., the other party to the interference, and caused S.'s application to be filed on April 5, 1916, *Held*, without determining whether S.'s device of 1914 was a reduction to practice, that S. is not entitled to prevail over

D., who conceived in May and reduced to practice in June, 1914, and filed his application on April 21, 1915, since he lost his right to assert priority over D. by his long delay and conduct in abandoning his experimental device.

2. SAME—REDUCTION TO PRACTICE—EXCUSE FOR FAILURE TO REDUCE—POVERTY.

A claim of financial inability to file an application for patent *Held* not sustained where it appears that during the period of such alleged inability the inventor had no one dependent upon him, was employed most of the period, and purchased a motorcycle and was paying for the same in monthly installments.

Mr. A. E. Dieterich and *Mr. C. A. Dieterich* for the appellant.

Mr. J. Edgar Bull for the appellee.

VAN ORSDEL, J.:

This appeal is from the decision of the Commissioner of Patents in an interference proceeding awarding priority of invention to appellee Shelly.

The invention relates to a stop mechanism by means of which the turn-table of a phonograph may be automatically stopped when the reproduction of sound from the record has been completed. It is unnecessary to consider the invention or the counts of the issue, since the appeal turns upon questions of law.

Appellant Duncan alleges conception of the invention in May, 1914, and reduction to practice in June, 1914. He filed his application for patent April 21, 1915. Appellee Shelly alleges conception in April, 1914, reduction to practice May 17, 1914, and a written description of the invention June 15, 1914. He filed his application April 5, 1916, and is, therefore, the junior party in this interference.

It appears that in May, 1914, Shelly produced an automatic stop for a phonograph which was experimented with and proved to be operative. There is a division of opinion in the tribunals below as to whether it amounted to a reduction to practice of the present invention. But in our view of the case this is unimportant. After this May test appellee caused an application for a patent to be prepared which was never filed. This device, the structure of which is not clearly disclosed, was not preserved. In regard to it appellee testified in answer to a question:

No sir. I did not intend to use these parts over again, because they were too bulky and clumsy. These parts were simply used to show that my theory or experiment was right.

The following question was then propounded:

By "no sir," as used in your last answer, you mean that you were not much concerned with what became of your original stop mechanism. Is that right?

To which he answered, "That is right."

It will be observed that it was at the time Shelly was experimenting with the invention that Duncan came into the field and with com-

mendable promptness reduced his invention to practice and filed his application. On April 19, 1916, Duncan granted the Thos. A. Edison, Inc., a license upon a royalty basis to use the invention on its phonographs. The device, however, had been under test in the experimental laboratory of the Edison Company since the summer of 1915, during which time negotiations were conducted leading up to the contract of the following April.

According to his own record, Shelly did nothing from June, 1914, until February, 1916, when he made a second machine, which was submitted to the Edison Company about February 18, 1916, and which was purchased outright by the Edison Company for the sum of \$540.00 by contract dated March 9, 1916. He also agreed to execute any applications for patent which the Edison Company might prepare and have prepared.

We think the assumption may be indulged that the purchase of the Shelly invention and the application for patent which inures solely to the benefit of the Edison Company, inspired the completion of the royalty contract for the use of the Duncan device for the express purpose of defeating and suppressing it. The knowledge of the Duncan invention by the Edison Company must be imputed to Shelly. Hence, the activity of the Edison Company in filing the application for the second or 1916 device is Shelly's activity. Aside from the abstract principle of law that in a case like the present the assignor and assignee must stand upon a level, it clearly appears from the record that the resurrection of the abandoned 1914 experiment by Shelly in the form of the 1916 device was inspired by the agents of the Edison Company.

This, however, is not important except in so far as it throws light upon Shelly's conduct, since, of course, the Edison Company must be held to have succeeded to whatever rights Shelly had, and the case must be determined solely from the standpoint of Shelly's right to prevail. We think, however, without determining the question of reduction to practice in 1914, Shelly, by his delay and conduct in junking the 1914 device lost his right to assert priority over Duncan. This is in harmony with a long line of decisions in this court, which has been approved by the circuit court of appeals in *Curtain Supply Co. v. National Lock Washer Co.*, (174 Fed. Rep., 45,) where the court said:

It is the settled doctrine of the Court of Appeals for the District of Columbia that when an inventor perfects and reduces to practice an invention, and fails for an unreasonable period to take steps to give it to the public, and until some one else has independently invented and patented it, the earlier inventor forfeits his rights to a patent as against the later inventor.

The same rule applies also where a patent has not issued to the other party. (*Gordon v. Wentworth*, C. D., 1908, 453; 135 O. G.,

1125; 31 App. D. C., 150; *Howard v. Bowes*, C. D., 1908, 547; 137 O. G., 733; 31 App. D. C., 619; *Dreckschmidt v. Schaefer*, C. D., 1918, 120; 246 O. G., 301; 46 App. D. C., 295; *Brown v. Campbell*, C. D., 1914, 170; 201 O. G., 905; 41 App. D. C., 499.)

The intention of Shelly to abandon the invention, we think, is clear. It seems to have gone out of his mind until he was inspired into activity by the Edison Company which was then in possession of knowledge of the Duncan invention. Abandonment in most instances can only be determined by inferences to be drawn from the conduct of the party against whom it is charged, and while it must be sustained by convincing proof (*Hubbard v. Burg*, C. D., 1913, 460; 195 O. G., 818; 40 App. D. C., 577) if the conduct, as here, discloses an intention to pursue the matter no further, abandonment may be inferred.

Some attempt has been made to account for Shelly's delay through his alleged inability to secure funds to file his application for patent. This defense totally fails. According to his own story he had the device constructed in 1914, when he had an application prepared. The attorney's fee was \$30.00. This amount, together with the filing fee in the Patent Office, was the insurmountable obstacle for almost two years and until the Edison Company came to the rescue. Shelly was a young man, single, with no one dependent upon him. He was employed most of the period in question, during which time it appears that he purchased a motorcycle and was paying for the same in monthly installments. His claim of inability through poverty to protect his rights by filing an application for patent is without merit.

The decision of the Commissioner of Patents is reversed, and the clerk is directed to certify these proceedings as by law required.

Reversed.

[Court of Appeals of the District of Columbia.]

IN RE ROBERTS.

Decided March 1, 1920.

273 O. G., 410; 49 App. D. C., 250; 263 Fed. Rep., 646.

1. PATENTS—APPLICATION—SOLE APPLICATION MAY TAKE BENEFIT OF FILING DATE OF PRIOR JOINT APPLICATION.

Where an application is filed by two parties as joint inventors, but during its pendency one of the joint applicants admitted that he had no part in the act of invention and it appears that he was joined as a coinventor through inadvertence and mistake and without fraudulent intent, a sole application afterward filed by the other joint applicant for the same subject-matter is entitled to the benefit of the filing date of the joint application.

2. SAME—SAME—CHANGING JOINT TO SOLE APPLICATION.

Where during the pendency of a joint application it is admitted by one of the joint applicants that he had no part in the act of invention and it appears that he was joined as a coinventor through inadvertence and mistake and without fraudulent intent, "it is difficult to perceive any reason for not permitting the rectification of such a mistake, by an amendment eliminating the superfluous applicant."

Mr. H. A. Toulmin for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

ROBB, J.:

Appeal from a decision of the Patent Office refusing to treat the application herein as a continuation of a joint application embracing the same subject-matter, theretofore filed by appellant and another under a mistake of fact.

On June 24, 1912, the present applicant and Park D. Roberts, his son, filed an application embracing not only subject-matter to which they jointly contributed but, as well, the subject-matter involved in the present application. An interference was declared between this joint application and a reissue application of Mr. F. A. Bruckman, and during the taking of testimony it developed that the son had nothing to do with the particular subject-matter of the present application. Thereupon, priority as to this subject-matter was awarded Bruckman by the Patent Office *on the ground that the Roberts were not joint inventors*. Just when the final decision was made does not appear, but it does appear that the present application was filed in October of 1917, as a continuation of the former joint application. The drawings, specification and claims of the present application were copied from the former. In other words, as to the subject-matter involved the present application is in substance the former application, but the Patent Office declined to consider the present application as a continuation of the former joint application, the result being that the Bruckman patent, having issued more than two years prior to the filing of the present application, became a statutory bar to its allowance. The question for our consideration, therefore, is whether, in a case like the present where it appears that a joint application has been filed through mistake or inadvertence and without fraudulent intent, the sole inventor, one of the joint applicants, is estopped from taking any advantage of that application.

The Examiners-in-Chief conceded that the result of the Patent Office ruling might be to deprive the applicant of an opportunity to contest the issue of priority, to procure a patent or assert his right thereto, and to permit his adversary—

to go hence with a patent the right to which, and the validity of which, the Patent Office will have failed to determine beforehand

The Board, however, felt constrained to follow what it conceived to be a line of decision in the Patent Office to the effect that a sole applicant is a different entity from joint applicants, and hence that a sole application may not be considered in any circumstances as a continuation of the old. The Assistant Commissioner relied upon the prior decisions of the Office and upon certain decisions of this and other Federal courts, to which we will refer later.

In *Godfrey v. Eames* (1 Wall., 317) it was ruled that where an applicant for a patent elects to withdraw his application for the purpose of filing a new application, the two applications are to be considered as parts of the same transaction, constituting one continuous application. The court was influenced by the fact that the two applications covered the same subject-matter, or that there was identity of subject-matter. In *Smith v. Goodyear Dental Vulcanite Co.*, (C. D., 1877, 171; 11 O. G., 486; 93 U. S., 486,) where an application had been rejected three times and a new application was not filed until several years thereafter, it was held that the new application, being for the same invention, was a mere continuation of the original application and not a new and independent one. While these decisions involve a somewhat different question than that before us, they evince a purpose to consider substance rather than form, to the end that the real inventor may receive recognition. That there are no insuperable obstacles in the present case is apparent from a perusal of former Rule 32 of the Patent Office, which was promulgated in 1897 and provided that new parties might be added to a pending application of joint inventors, that some of the parties might be dropped where all consented in writing—

and where the nonjoinder or misjoinder was by mistake and without fraudulent intent.

The fact that this rule was subsequently repealed does not militate against its consideration here, for it is applicable to the question before us. Section 4888, Revised Statutes, requires an inventor to file an application clearly pointing out his invention, but such was the law when the decisions were rendered in *Godfrey v. Eames* and *Smith v. Goodyear Dental Vulcanite Co.* The joint application of Roberts and Roberts answered every requirement of this section, except that one of the applicants, as it subsequently developed, did not contribute anything to the subject-matter here involved. All that was sought in the new application was the elimination of one of the joint applicants, to whom credit mistakenly had been given for the particular invention involved. There was identity of subject-matter, and it is difficult to perceive any reason for not permitting the rectification of such a mistake by an amendment eliminating the superfluous applicant. Surely, if such an amendment would have

been proper, then the filing of what in substance and effect was a duplicate application by the sole inventor should have been regarded as a continuation of the former application. When one joint applicant admitted that this particular subject-matter was the sole invention of the other applicant, to all intents and purposes the application as to this subject-matter was the application of the sole inventor, who still was a party to the proceeding. The Patent Office, in our view, has failed to give proper weight to the fact that there is identity of subject-matter here, that there is no conflict of interest, and that the second application is filed merely to correct a formal error.

The Assistant Commissioner cites our decision in *Lemp v. Randall and Bates* (C. D., 1909, 455; 146 O. G., 255; 33 App. D. C., 430) in support of his conclusion, but the question here in issue was neither involved nor discussed in that case. It there was ruled that the Patent Office should have determined whether the joint applicants were in fact joint inventors, for if it appeared they were not there would be a failure of parties; that is to say, a finding that joint applicants are without standing to contest the question of priority with another applicant destroys the basis for an award of priority. In that case the joint applicants insisted that they were joint inventors, and the court so found.

Much reliance also is placed upon the decision in *American Casting Machine Co. v. Pittsburgh Co.* (C. D., 1917, 248; 237 O. G., 621; 237 Fed. Rep., 590.) While the joint application of Uehling, Miller and Scott in that case was pending in the Patent Office here, Scott caused the invention to be patented in Great Britain. Subsequently the joint application was abandoned. More than seven months after the filing of the British application, Scott filed a sole application in this country and obtained a patent thereon. It was held that this patent was void because of the British patent. The court referred to the disclaimer that the patent in suit was a division of the abandoned application. It thus appears that after a foreign patent had been obtained on behalf of the joint inventors by one of them and the joint application for the same invention had been abandoned here, one of the joint applicants filed what was characterized by the court as "a hostile and independent application" for the same invention. Of course the court ruled that, in such circumstances, the application must stand "on its own ground." Here, however, there is no such inconsistency. No patent has been obtained under the former joint application, which the joint applicants concede was formally defective. To prevent a possible failure of justice, the present application should have been considered as a continuation of the abortive application. As already suggested, we perceive no reason why the mistake could not have been rectified by a simple amendment, but in any

event the sole inventor should not be deprived of his day in court by raising of artificial barriers against him. He claimed his invention and, through mistake, gave his son credit where no credit was due. The elimination of the son ought not to deprive the father, the sole inventor, of the benefit of his original application, and we so rule.

It perhaps is unnecessary to add that a party who seeks to correct his own mistake must act with reasonable diligence and also assume the burden of establishing his good faith.

The decision is reversed and the case remanded for further proceedings in harmony with this opinion.

Reversed and remanded.

The decision of the First Assistant Commissioner is as follows:

Applicant appeals from the decision of the Examiners-in-Chief affirming the decision of the Primary Examiner finally rejecting the claims of this application.

The rejection is based on the ground that this application cannot be regarded as a continuation of the application filed by this applicant and Park D. Roberts and that the present application was filed more than two years after the grant of the patent to Bruckman, No. 1,091,729, March 31, 1914.

In an interference involving the joint application of Roberts and Roberts and an application for the reissue of the Bruckman patent all the tribunals of the Office held that the testimony showed that the invention was not the joint invention of the joint applicants, since Park D. Roberts had no part in the alleged conception of the application of the rib member to the prior Bruckman machine. Priority was therefore awarded to Bruckman on the authority of the decisions of the Court of Appeals of the District of Columbia in *Lemp v. Randall and Bates* (C. D., 1909, 455; 146 O. G., 255; 33 App. D. C., 430) and *Mills and Conn v. Darlington* (C. D., 1912, 460; 178 O. G., 321; 38 App. D. C., 95.) No appeal was prosecuted from the decision of the Commissioner.

It is contended that the Examiner was in error in holding that this application is barred because filed more than two years after the grant of the patent to Bruckman, since it should be regarded as a continuation of the joint application of Roberts and Roberts.

It is also argued that it was an erroneous view of the law to decide priority in favor of Bruckman for the reason above stated and that the practice referred to in the case of *Mead v. Brown* (C. D., 1889, 173; 48 O. G., 397) should have been followed. In that case it was said:

"An interference was then declared between the patent to Preston and the joint application of Brown and Sheldon. This interference was decided against Preston, the Office holding that Brown alone was the original and first inventor, but that inasmuch as Brown was a joint applicant with Sheldon, no award could be made in favor of Brown alone."

The decision referred to was rendered long prior to the decision of the court of appeals in *Lemp v. Randall and Bates*, *supra*. In the latter case the Commissioner had refused to consider the question whether Randall and Bates were joint inventors, holding that that question did not relate to priority and that the question to be determined in the interference was whether, assuming Randall and Bates to be joint inventors, they or Lemp first made the invention. The court of appeals, however, held that this was an error and that if Randall and Bates were not in fact joint inventors then priority should be awarded to Lemp.

Applicant has cited no decision in which either in the Patent Office or in the courts a sole application has ever been held to be a continuation of a joint application. There has been, however, a uniform line of decisions in the Patent Office to the contrary. The reasons for this holding are fully stated in the decision of Commissioner Mitchell in *ex parte MacLay*, (C. D., 1889, 220; 49 O. G., 1043,) and he points out the distinction between a case such as the present and a case where the second application was filed by the same person as the first, as in the case of *International Tooth Crown Co. v. Richmond*, (30 Fed. Rep., 775.) A similar conclusion was reached by Commissioner Ewing in *Prioleau and Prioleau*, (123 MS. Dec., 164.)

In the *American Casting Co. v. Pittsburgh Co.* (C. D., 1917, 248; 237 O. G., 621; 237 Fed. Rep., 590) the Circuit Court of Appeals of the Third Circuit held that a patent granted on a sole application was invalid where it had been granted on an application filed more than seven months after the filing in England of a joint application by three applicants, one of whom was the sole applicant here, the English patent having been granted before the patent was granted in this country. This holding was made notwithstanding there had been filed in this Office an application by the same three applicants who filed the application in England and that this application was pending when the sole application was filed.

It is argued that that decision is in favor of applicant's contention rather than adverse to it, because the court based its holding upon the fact that the sole application was not filed as a division of the joint application. This contention is not believed to be well founded, for the reason that the record of the application on which the United States patent was granted shows, as appears from the decision of the court, that the patent was refused in view of the English patent, but afterward granted on the ground that the sole application should have the benefit of the prior joint application and that the seven months' limit would therefore not apply. The court quotes a ruling of the Patent Office in granting the patent in which it was said:

The same ruling against him which brought him within the bar of the foreign patent should be made in favor of him to put him without that bar. That being so, this applicant is entitled, for this purpose, to the date of filing of the joint application as the date of filing an application in this country for the invention of the later foreign patent.

After making this quotation, the court said:

"We cannot accede to this reasoning. * * * So far as time is concerned, the sole application had to stand on its own independent status."

In the brief filed on this appeal it is stated that there was a clear intimation in the decision of the Examiners-in-Chief that the sole application ought to be treated as a continuation of the joint application. It is not thought that the decision is susceptible of that construction. All that the Examiners-in-Chief said was that they were bound by a long and practically uniform line of decisions and that—

"If the practice in the respect just noted is to be changed it should be done by the head of the Office rather than by some subordinate tribunal."

This obviously proper statement that the Examiners-in-Chief should not undertake to reverse the decisions of the Commissioner is very far from being an intimation that they thought the practice announced in those decisions was wrong.

The decision of the Examiners-in-Chief is affirmed.

[Court of Appeals of the District of Columbia.]

WEGNER v. BOBBITT.

Decided February 2, 1920.

273 O. G., 629; 49 App. D. C., 228; 263 Fed. Rep., 480.

PATENTS—APPEAL TO COURT OF APPEALS OF THE DISTRICT OF COLUMBIA DISMISSED
FOR FAILURE TO FILE BRIEF.

Motion to dismiss an appeal for failure to file a brief within the time specified granted under Rule 8 (sec. 4 b) of the Rules of the Court of Appeals of the District of Columbia.

Mr. Wm. F. Hall for appellant.

Mr. Bruce S. Elliott for the appellee.

SMYTH, C. J.:

Wegner appeals from a decision of the Commissioner of Patents, awarding priority to Bobbitt, in an interference relating to a dust-collector. On December 28, 1918, the record on appeal was filed in this court, and was printed March 1, 1919. Wegner's time for filing his brief was, on his application, extended to September 1, 1919, but he failed to file one within the time allowed. The appeal was set for hearing on January 12th last, and due notice given to him of the fact. He has taken no action. Appellee moves to dismiss because no brief has been filed by Wegner. Rule 8 (sec. 4 b) of this court says that for failure to file a brief within the specified time "the appeal may be dismissed." In consequence, we must sustain the motion. This we do with less reluctance than we would otherwise feel since the three tribunals of the Patent Office unite in holding against Wegner on a question of fact.

The appeal is dismissed.

[Court of Appeals of the District of Columbia.]

PHILLIPS v. HUDNUT AND MACK.

Decided March 1, 1920.

273 O. G., 629; 49 App. D. C., 247; 263 Fed. Rep., 643.

1. TRADE-MARKS—ACQUISITION—EXTENT OF USE NECESSARY.

The use of a mark on a few sample-boxes of toilet power, three of which were consigned to dealers in different parts of the country without previous request by them, for which there was paid only five cents for a box intended to sell at fifty cents, does not constitute such a use of the mark as to establish any property rights therein.

2. SAME—SAME—GENERAL RULES AS TO ACQUISITION.

The common law, and not the trade-mark statutes, defines what constitutes a trade-mark. The trade-mark recognized by the common law is generally the outgrowth of a considerable period of use rather than a sud-

den invention. The exclusive right to it grows out of its use and not its mere adoption. (*Trade Mark Cases*, 100 U. S., 82.) The trader must apply the mark to a vendible commodity and must actually put the commodity so marked on the market.

3. SAME—APPEAL AND ERROR—QUESTIONS FOR REVIEW.

In a trade-mark interference proceeding involving the three parties H., M., and P., where it is adjudged by the Patent Office that H. was the first to adopt and use the mark, on appeal by P. to the court of appeals he is not entitled to be heard on the question whether the decision properly awarded priority to H. over M.

4. SAME—SAME—REVIEW OF QUESTION NOT APPEALED.

In a three-party interference involving the application of H. and the registrations of M. and P., the Examiner of Interferences held that the marks were the same and awarded priority to H. After the decision was announced H. filed a motion requesting the Examiner of Interferences to adjudge that P. was not entitled to the use of the mark at the date of his application for registration, which was denied, from which H. failed to appeal. On P.'s appeal the Commissioner reviewed this action and reversed it, ordering the cancellation of P.'s registration. This was error, as H. did not appeal, and the question was therefore not before the Commissioner.

Mr. Jos. L. Levy for the appellant.

Mr. C. E. Dunn and *Mr. Nicholas M. Goodlett* for the appellee.

SMYTH, C. J.:

This is an interference involving the right of Hudnut to obtain the registration of the word "Nara" as trade-mark for toilet articles such as talcum, sachet, and face powder. Phillips had registered the word "Nyra" and Mack the word "Myra" as marks for goods of the same descriptive properties. The Examiner of Interferences held that the respective marks were one and the same, and awarded priority to Hudnut. He was affirmed by the Assistant Commissioner. After the decision of priority was announced by the Examiner, Hudnut filed a motion requesting him to adjudge that Phillips was not entitled to the use of the mark at the date of his application for registration. This was denied. Hudnut failed to appeal. However, the Assistant Commissioner reviewed the action of the Examiner in this regard on Phillips's appeal and reversed it.

It is clearly established that Hudnut adopted the mark in question in September, 1914, and used it continuously thereafter. Phillips claims May, 1914, as the time he commenced the use of the mark. In that month he had no established place of business, but made some sample boxes of toilet powder, placed upon them the mark here involved, and then forwarded them from New York through the house for which he was then working to three dealers in goods of that character, one in Texas, one in Philadelphia and one in New Orleans. The boxes were sent without previous request by the consignees, and the price paid for each was five cents, the usual sale price of such an article being about fifty cents.

No other use of the mark was made by him until 1916. The Assistant Commissioner held that this was not—

a bona fide business transaction, was not doing business on Phillips's part, and was a mere laying basis for the filing of his application for registration, and created no trade-mark rights in Phillips.

The right to a trade-mark exists independently of the statute. Registration simply constitutes prima facie evidence that the registrant is entitled to the mark. (*Fulton Water Works Co. v. Bear Lithia Spring Co.*, C. D., 1918, 205; 255 O. G., 163; 47 App., D. C., 438.) The trade-mark statute (sec. 1, 33 Stat., 724) does not define what constitutes a trade-mark. We must go to the common law for that.

The trade-mark recognized by the common law is generally the outgrowth of a considerable period of use rather than a sudden invention * * *. The exclusive right to it grows out of its use and not its mere adoption. (*Trade Mark Cases*, C. D., 1879, 614; 16 O. G., 999; 100 U. S., 82; *Macmahon Pharmacal Co. v. Denver Chemical Mfg. Co.*, 113 Fed. Rep., 468. *American Washboard Co. v. Saginaw Mfg. Co.*, 103 Fed. Rep., 281.)

According to an authority cited by the appellant, the trader must apply the mark to a vendible commodity and "must actually put the commodity so marked on the market." (Nims on Unfair Competition and Trade-Marks, 2d ed., sec. 216.) In the light of these authorities we are persuaded that the Assistant Commissioner was right in holding that the use made by Phillips of the mark does not satisfy the statute. This being so, Hudnut is entitled to priority over him.

Phillips complains because of the action of the Office with respect to Mack, but concerning this he has no right to be heard. What matters it to him if, perchance, Mack is entitled to priority over Hudnut since he (Phillips) cannot overcome Hudnut's date?

With respect to the action of the Assistant Commissioner in overruling the decision of the Examiner denying the motion of Hudnut, we think he was wrong. Hudnut did not appeal. Therefore the question did not come before the Commissioner for consideration.

The decision of the Patent Office is reversed in so far as it relates to the action of the Examiner on Hudnut's motion, and is affirmed in all other respects.

Modified.

ROBB, J., (concurring in part:)

I concur in the ruling sustaining the decision of the Patent Office in awarding priority to Hudnut. However, Phillips having appealed to the Commissioner from the basic decision of the Examiners-in-Chief awarding priority to Hudnut, and the Commissioner having sustained the decision appealed from, it is my view that the Commissioner properly canceled the Phillips registration. The Com-

missioner's decision, which this court sustains, definitely and finally determined that Phillips had no claim to the mark and hence no right to register it. Just why Hudnut should be required to go through the idle ceremony of filing an application to have the invalid registration canceled, is not apparent to me, since such proceeding can have but one result, the question already having been determined in the other proceeding.

[Court of Appeals of the District of Columbia.]

WILLIAM WALTKE & COMPANY v. GEO. H. SCHAFER & COMPANY.

Decided March 1, 1920.

273 O. G., 630; 49 App. D. C., 254; 268 Fed. Rep., 650.

1. TRADE MARK—"LAVA," FOR SOAP, NOT DESCRIPTIVE.

The word "Lava," for soap, *Held* not descriptive. It may suggest the function of soap, being derived from "lavare," to wash, and meaning, in English, fluid rock; but it does not describe its properties. (*In re Stephens-Adamson Mfg. Co.*, ante, 147; 272 O. G., 181; 49 App. D. C. 181.)

2. SAME—GOODS OF THE SAME DESCRIPTIVE PROPERTIES—SOAP AND SHAVING-CREAM.

The owner of a mark for toilet soap has a right to extend it to shaving-cream, since in the popular mind a shaving-cream is a soap.

3. SAME—IDENTITY OF MARKS—"U-LAVO" SIMILAR TO "LAVA."

The word "U-Lavo" conflicts with "Lava," the prefix "U-" being only an arguable distinction which is not sufficient.

4. SAME—SAME—GENERAL TEST OF IDENTITY.

The test of the identity of trade-marks is not whether the words mean the same thing, but whether they are so similar in sound and appearance as to lead the public to believe that the goods on which they appear had a common origin. Conflict exists where a purchaser seeing only one and relying upon his memory of the other would likely fail to recognize the distinction, although he would do so could he see the two together.

5. SAME—OPPOSITION—NOT NECESSARY TO SHOW DAMAGE TO OPPOSER.

In order to succeed in a trade-mark opposition proceeding, it is not necessary that opposer establish damages, it being sufficient to show likelihood of confusion or mistake in the mind of the public.

6. SAME—REGISTRATION—DOUBTS RESOLVED AGAINST NEWCOMER.

Where there is doubt as to the right to register a mark in view of rights previously acquired, it should be resolved against the newcomer, since there is no excuse for a later comer to impinge upon prior rights in view of the unlimited field from which a mark may be selected.

Mr. John S. Barker and Mr. Edward E. Longan for the appellant.

Mr. Geo. H. Schafer and Mr. E. T. Brandenburg for the appellee.

SMYTH, C. J.:

Geo. H. Schafer & Company, a partnership, applied for registration of "U-Lavo" as a trade-mark on shaving-cream. Registration

was opposed by William Waltke & Company, a corporation, on the ground that "U-Lavo" was so similar to the mark "Lava," in use by it on toilet soap, that it was not registrable. The Patent Office overruled the opposition and registered the mark.

Wm. Waltke in 1858 established a soap-manufacturing business, which was continued by him and others until acquired by the opposer, who now owns it. In 1893 Wm. Waltke & Co., a partnership, the immediate predecessor of the opposer corporation, adopted, and began the use of, the word "Lava" as a trade-mark on its soap. Later its business was transferred to the corporation, and with it the right to the use of the mark. Upward of a half-million dollars have been spent by the opposer and its predecessor in advertising goods under the mark "Lava," and the corporation's plant has come to be known as "The Home of Lava Soap." Applicant did not adopt its mark until 1913.

At the outset it is urged by the applicant that the opposer's mark is descriptive and hence not entitled to registration. The word "Lava," according to *Webster's Dictionary*, comes from "lavare," to wash, and means in English, fluid rock. It may suggest the function of soap but it does not describe its properties. (*In re Stephens-Adamson Manufacturing Company*, ante, 147; 49 App. D. C., 181, and the cases therein cited.) Much stress is laid upon *Standard Paint Company v. Trinidad Asphalt Manufacturing Company* (C. D., 1911, 530; 165 O. G., 971; 220 U. S., 446) by the applicant with respect to this point, but it is easily distinguished from the case before us. In that case the word "Rubberoid" was used on goods which contained no rubber, but was in the "nature of soft, flexible rubber." It is a compound of the word "Rubber" and the suffix "Oid." "Oid" is defined by the lexicographers as meaning the form or resemblance of the thing indicated, "like," as in *anthropoid*, like man. The mark "Rubberoid" as applied to the goods in question meant that they were like rubber, which was true, and was therefore descriptive.

The owner of a trade-mark has the right not only to its exclusive use on goods which he has manufactured, but also on goods which he may afterward produce if they belong to the same general class as those upon which he has been using the mark. (*Gutta-Percha & Rubber Manufacturing Company v. Ajax Manufacturing Company*, (C. D., 1919, 146; 259 O. G., 184; 48 App. D. C., 233; *Walter Baker Co. v. Harrison*, C. D., 1909, 284; 138 O. G., 770; 32 App. D. C., 272.) No person may legally interfere with the use of the mark by him in the natural expansion of his business. (*Simplex Heating Company v. Gold Car H. & L. Co.*, C. D., 1915, 100; 218 O. G., 1117; 43 App. D. C., 28.) When chemically analyzed shaving-cream and

toilet soap may not be identical in all their elements, but in the popular mind a shaving-cream is a soap, and the manufacture of it by opposer would be a natural step in the broadening out of its business as a soap-producer. In fact it has already taken that step, for it is now manufacturing shaving-soap and shaving-cream, although it does not put them out as its own products. They are produced to be distributed by others. Toilet soap and shaving soap or cream are related materials, and since opposer has a right to use its trade-mark on toilet soap it may prevent the use of it by others on shaving-soap or shaving-cream.

But it is contended that applicant is not attempting to use opposer's mark or one similar to it, and consequently that the rule we have been discussing does not apply. The Assistant Commissioner held that there was a wide difference between the meaning of the two marks. The word "Lava," he said, suggests grit, while the word "Lavo" (a part of applicant's mark) refers to washing. Counsel for appellant assert that the word "Lavo" is Latin and means "wash or lave." The Latin word "lavare," the root of "lava," is very closely allied in meaning to the word "lavo,"—so much so that the two words may be treated as meaning substantially the same thing. However, the test is not the exact meaning of the words but whether they are so similar in appearance and sound as to lead the public to believe that the goods on which they appear had a common origin.

Undoubtedly, as urged, the prefix "U-" distinguishes the one mark from the other, but we think it is only an arguable distinction; and that is not sufficient. (*Thomas Manufacturing Co. v. Aeolian Co.*, C. D., 1918, 157; 249 O. G., 505; 47 App. D. C., 379.) "Lavo" is the dominant feature in appellant's mark and the one most likely to be remembered. Of course, if the intending purchaser could see both marks together he would readily note the difference between them; but if upon seeing only one he must rely upon his memory of the other, he would not be likely to apprehend the distinction. He acts quickly and upon impression. He is governed by a casual glance. (*Patton Paint Co. v. Orr's Zinc White, Ltd.*, C. D., 1919, 141; 258 O. G., 814; 48 App. D. C., 221, 222.) Under such circumstances he would be apt to mistake the one for the other and thus would occur the confusion against which the statute is leveled.

Opposer is not bound to establish damages in order that it may succeed. It is sufficient for it to show that the applicant's mark would be "likely to cause confusion or mistake in the mind of the public * * *." (Sec. 5, 33 Stat. L., 725; *Patton Paint Co. v. Orr's Zinc White, Ltd.*, C. D., 1919, 141; 258 O. G., 814; 48 App. D. C., 223; *Thomas Manufacturing Co. v. Aeolian Co.*, C. D., 1918, 157; 249 O. G., 505; 47 App. D. C., 378.)

The case is not free from difficulty, but where there is doubt the courts resolve it against the newcomer. (*Lambert Pharmacal Co. v. Mentho-Listine Chemical Co.*, C. D., 1918, 147; 247 O. G., 965; 47 App. D. C., 197.) The reason for this is, as has been said by this court more than once, that the field from which a person may select a trade-mark is practically unlimited and hence there is no excuse for his impinging upon or even closely approaching the mark of his business rival. (*O. & W. Thum Co. v. Dickinson*, C. D., 1917, 166; 240 O. G., 337; 46 App. D. C., 306; *Florence Manufacturing Co. v. J. C. Dowd & Co.*, 178 Fed. Rep., 75.) Where he does so he is open to the suspicion that his purpose is to appropriate to himself some of the good-will of his competitor.

From what we have said it follows that the decision of the Patent Office is reversed and the opposition of William Walthe & Company, Incorporated, sustained.

Reversed.

[Court of Appeals of the District of Columbia.]

IN RE DEMENT.

Decided March 1, 1920.

274 O. G., 203; 49 App. D. C., 261; 263 Fed. Rep., 813.

1. PATENTS—PRIORITY—ESTOPPEL BY JUDGMENT IN PRIOR INTERFERENCE INVOLVING ANOTHER APPLICATION OF SAME PARTY.

Where in a tri-party interference between P., H., and D. the interference was dissolved as to the claim because D. had no right to make it, and no appeal was taken from that decision, and at the time D. had an earlier application pending in which he could make it, but did not attempt to include the earlier application in the interference until after testimony had been taken by the other parties and the interference was before the Examiners-in-Chief on appeal from an adverse decision, *Held* that the Commissioner was right in refusing to reopen the interference at that time to include the earlier application and that D. was barred by the doctrine of *res judicata* from making the claim in his earlier application after final adverse adjudication in the interference and four years after the decision denying his right to make the claims in his later application.

2. SAME—APPEAL—REVIEW BY COURT OF APPEALS—QUESTIONS DISCRETIONARY WITH COMMISSIONER.

Where a motion brought before the Commissioner of Patents is directed to his discretion, his decision thereon must be sustained unless there was an abuse of discretion.

Mr. Reeve Lewis and *Mr. F. P. Davis* for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

SMYTH, C. J.:

Dement appeals from a decision of the Patent Office rejecting claims 20 to 31, inclusive, of his application for a patent relating to a

computing-machine. For the purposes of our opinion it is sufficient to set out claims 20 and 29. They are:

20. In a calculating machine, the combination with two groups of totalizer wheels, of means under control of the operator for transferring the number registered in either group to the other.

29. In a calculating machine, the combination of a plurality of sets of accumulators, a key mechanism whereby any one or any number of the accumulators may be caused to register one or more numbers at a time, and means whereby the accumulations on one set of accumulators may be controlled by the accumulations on another set of accumulators.

The rejection was placed upon the ground that Dement was barred by judgment, as well as by estoppel *in pais*, from making the claims.

Dement was a party to a tripartite interference wherein one Hopkins and one Peters were the other parties. In that interference, on motion of Hopkins, it was determined that claim 4 of the issue did not read on Dement's application, and the interference as to that claim was dissolved. Dement did not appeal. The interference proceeded as to the remaining claims. Hopkins and Peters took testimony. Dement, the senior party, filed no preliminary statement and took no testimony, but relied on his filing date. The Examiner of Interferences awarded priority to Hopkins. The Board of Examiners reversed his decision and ruled in favor of Dement. The Commissioner affirmed the decision of the board, but this court reversed the Commissioner and awarded priority to Hopkins. (*Hopkins v. Peters* C. D., 1914, 116; 199 O. G., 1243; 41 App. D. C., 302.)

The Dement application involved in the interference just mentioned was filed in January, 1904, but Dement had another application relating to the same subject-matter which had been filed six months before, or in July, 1903.

After the three-party interference had been argued before the Board of Examiners on appeal, Dement filed a motion, addressed to the supervisory authority of the Commissioner, asking that the proceeding be remanded to the Examiner of Interferences and reopened so that he might substitute his earlier application, the one here involved, for the application then in the interference. This motion was denied for the stated reason that it was filed too late.

Dement, in the motion just referred to, said:

This earlier application *clearly* discloses the subject-matter of all the counts of the issue now in interference except count 1.

He further stated that if this earlier application—

had been placed in the interference at the time it was declared, the decision of the Examiner of Interferences would inevitably have been in—

his favor. Thus we have established by Dement's own admission that the subject-matter of all the counts in the tri-party interference was the same, except count 1, with which we have nothing to do in this proceeding.

When the tri-party interference was pending before the Examiner of Interferences, Dement knew what Hopkins and Peters were claiming, because he had access to their files. He also knew, of course, what was in his earlier application, and as his motion discloses, that the subject-matter was the same as that in his later one, then involved in the interference. This being so, was it not his duty before the decision of the Examiner was rendered against him to have filed the motion, which he later filed, when the proceeding was pending before the Board of Examiners? We think it was. True, the Examiner might have overruled his motion, but this is not at all likely. In that respect, however, he would not be in a situation different from that of any litigant who seeks permission in court to amend his pleading. The court may or may not, in the exercise of a sound discretion, grant the motion. Since it would have been the duty of the Examiner to have permitted the amendment, having in mind the statement of Dement—that the subject-matter was the same—we must assume that he would have performed his duty, and hence that Dement would have been allowed to amend the application. If he had been, his right to make those claims, as against Hopkins and Peters, could have been decided in that interference.

We have held in *in re Marconi* (C. D. 1912, 483; 179 O. G., 577; 38 App. D. C., 286) that in a proceeding such as is now before us, where the question of *res judicata* is raised, the Commissioner stands in the place of the person who has a right to claim the protection of that principle. The case is exactly as if Hopkins was a party to the present proceeding. We have, then, a case in which the parties and the cause of action—claims to the subject-matter—are the same as they were in the tri-party interference. It has long been settled law that a judgment between the same parties upon the same cause of action is *res judicata*—

not only as to every matter which was offered and received to sustain or defeat the claim or demand, but as to any other admissible matter which might have been offered for that purpose. (*Cromwell v. County of Sac*, 94 U. S., 351. See also *in re Cutler*, 48 App. D. C., 444; *Blackford v. Wilder*, C. D., 1907, 491; 127 O. G., 1255; 28 App. D. C., 535, and *New Departure Mfg. Co. v. Robinson*, C. D. 1913, 332; 188 O. G., 1055; 39 App. D. C., 504.)

In the Blackford case the court, speaking through the late Chief Justice, ruled that it—

follows inevitably that the final decision in the first interference is conclusive unless it can be made to appear that the question upon which the determination of the second case rests is one that neither was nor could have been presented in the first case.

Following this principle the conclusion is inescapable that Dement is estopped by the decision in the tri-party interference from setting up any right to the claims which are before us.

The fact that when the proceeding was pending on appeal before the Examiners-in-Chief Dement filed a motion to reopen the interference does not affect the conclusion which we have reached. Diligence is one of the things insisted upon in the Patent Office, and rightly so. Dement permitted Hopkins and Peters to take their testimony while they were in ignorance, as he well knew, of the contents of his prior application. They shaped their case and presented their arguments before the Examiner in the belief that Dement relied upon his filing date alone to defeat them. Not until after the Examiner had decided against him and he had learned from their testimony what they could establish did he file his motion. Not only that, but he waited more than four years after the decision that he could not make claim 4, which is the same as claim 20 of the present application, before revealing his true position. During all this time he knew what Hopkins and Peters claimed, as well as what they might claim for their disclosures, because he had access to their files when the ruling on claim 4 was made; yet he made no effort to bring the claims of the earlier application into the pending interference. His motion was directed to the discretion of the Commissioner, and, unless the latter abused his discretion, which we think he did not, his action must be sustained.

Even if Dement had not admitted by his motion that the subject-matter of his first and second applications was the same, we think it would have to be so held. As the Assistant Commissioner said in deciding the case:

The issue in an interference is not merely a claim which is distinct and separable from other claims which are or may be made on the same disclosure. The contest is over an embodied invention, not a technical claim.

Again:

The thing adjudicated was no doubt a thing different from the invention now claimed; but it was different only in scope of definition, as a simple pump differs from a double-acting pump. Certainly Hopkins could have been the inventor of the one-way transfer of totalizer results, while Dement was inventor of the two-way transfer. But that is not the whole question. The question is whether, after a losing contest with Hopkins on the one-way transfer Dement may now for the first time known to Hopkins lay an earlier claim to the two-way transfer, when both he and Hopkins had all along a basis for claim to the two-way transfer, and the applicant knew it.

It was said by Chief Justice Shepard in the Blackford case (p. 544), after reviewing many decisions:

An interference in fact depends chiefly upon the subject-matter disclosed, and not merely upon the language of the respective claims.

Our decision in *in re Martin* (C. D., 1918, 213; 257 O. G., 408; 48 App. D. C., 187) in no wise conflicts with anything we have said here. It was there held that since there was no judgment of priority

against Martin he could not be said to be estopped by judgment. Here there was a decision of priority against Dement and in favor of Hopkins, and it is that decision which bars him from relitigating the questions there involved, or which might have been presented if he had filed his motion in time.

Believing that Dement is barred by the application of the doctrine of res judicata from asserting any right to the claims involved, the decision of the Commissioner of Patents is affirmed.

Affirmed.

Mr. Justice VAN ORSDEL *dissents*.

[Court of Appeals of the District of Columbia.]

DAY v. BOWER.

Decided March 1, 1920.

274 O. G., 408; 49 App. D. C., 259; 263 Fed. Rep., 655.

1. PATENTS—INTERFERENCE—ISSUE CONSTRUED—VEHICLE-GOVERNING MEANS.

In traffic-controlling systems danger-signals operated on a vehicle considered as "vehicle-governing means" in view of the admissions of the opposing party.

2. SAME—SAME—RIGHT TO MAKE CLAIMS.

Where in an interference between B. and D., relating to traffic-controlling systems, certain counts called for vehicle-controlling means having a retarding condition, B. disclosed only signals, *Held* that he had no right to make such claims, and priority awarded to D.

Mr. G. E. Cruse and Mr. J. Edgar Bull for the appellant.

Mr. J. A. Watson for the appellee.

PATENT appeals Nos. 1,280 and 1,281.

ROBB, J.:

These interferences involve the same application of each party. The Examiner of Interferences awarded priority as to all counts in each interference to Day. The Examiners-in-Chief and the Commissioner sustained the decision as to counts 1 to 6, inclusive, and to count 14, in the first interference, and as to counts 1, 2, 3, and 4, in the second interference, but as to counts 7 to 13, inclusive, and counts 15, 16, and 17, in the first interference, and counts 5, 6, 7, 8, and 9, in the second interference, reversed the decision and awarded priority to Bower. Bower has taken no appeal, and consequently we are concerned with only those counts awarded to him.

Count 7 of the first interference and count 5 of the second interference, are sufficiently illustrative and are here reproduced.

7. In combination, a railway track, a vehicle adapted to travel thereon, means on the vehicle driven in accordance with the movement of the vehicle along the trackway and capable of an operative condition toward which it is constantly driven, devices located at intervals in the trackway and adapted to coact with the

said means to reset it away from said operative condition, a vehicle governing apparatus on the vehicle controlled by the said means, when the latter reaches said operative condition.

5. In combination, a railway vehicle, apparatus on the vehicle capable of an in-operative condition and adapted to automatically change its condition by degrees progressively approaching the operative condition and to govern the vehicle when said operative condition is reached, and means extraneous to the vehicle adapted to restore said apparatus from any position or degree of said progressive change to a condition or degree more remote from operative condition, said apparatus being adapted to automatically resume the progressive change toward operative condition after each restoration.

Day relies solely upon his record date of July 10, 1911. Bower has taken testimony tending to show that he conceived the invention in 1909, but it will be unnecessary to review that testimony here, since the case turns upon the interpretation to be given the claims. The Examiner of Interferences failed to make any distinction between the two groups of claims, but the higher tribunals ruled that the first group, which as we have seen were awarded Day, call for a system in which the operation of the vehicle is automatically or mechanically controlled by the action of the run-down device, and that the claims of the other group do not contain this limitation. This conclusion was based largely upon the Day specification, in which it is pointed out that such expressions as "means for governing the vehicle" and "the traffic controlling means" include such devices as lamps, bells and whistles, as well as devices which operate the brakes and the power. On this point the Commissioner said:

The record discloses a sufficiency of admission by Day that danger signals operated on a vehicle should be considered as vehicle governing means.

We have examined the Day specification and concur in this view. For the reasons pointed out in the opinions of the Examiners-in-Chief and the Commissioner, we affirm the decision of the Commissioner in each interference.

No. 1,280 affirmed.

No. 1,281 affirmed.

[Court of Appeals of the District of Columbia.]

DE FOREST v. RICHARDS.

Decided March 1, 1920.

274 O. G., 408; 49 App. D. C., 257; 263 Fed. Rep., 653.

PATENTS—INTERFERENCE—ORIGINALITY.

Evidence considered and *Held* that Richards derived the invention from De Forest.

Mr. Samuel E. Darby and Mr. Samuel E. Darby, Jr., for the appellant.

Mr. D. C. Tanner, Mr. J. G. Roberts, and Mr. W. E. Beatty for the appellee.

ROBB, J.:

This is an appeal from the decision of an Assistant Commissioner of Patents awarding priority to Richards.

De Forest, in 1907 and 1908, was granted patents on relays of the gaseous type, known in the art as audions. The invention in issue is an improvement on an audion, and is thus described by the Examiner of Interferences:

It is an improvement on the so-called "audion" which comprises a receptacle from which substantially all gases have been removed, having therein a terminal or electrode adapted to be heated from some external source, and two cold electrodes located at relatively different distances from the hot electrode. It is unnecessary to describe the structure in detail. It is sufficient to say that under working conditions the instrument may become inoperative because of what are probably static charges upon certain of the terminals. This condition was usually indicated by a so-called "blue glow" visible between the electrodes, although under certain conditions the phenomenon seems not to be visible. In order to overcome this condition the two electrodes have been connected by a high resistance or so-called leak path, so that the charges on the electrodes may neutralize each other. It is this high resistance connection that constitutes the gist of this invention.

The invention is comprised in nine counts, of which the third and sixth are illustrative and are here reproduced.

3. An electric relay comprising an evacuated vessel, a heated member, a conducting member and a conducting plate sealed therein, an incoming circuit connected across said heated member and said conducting member, an outgoing circuit connected across said heated member and said conducting plate, and an additional metallic circuit connecting said conducting member and said plate.

6. In an electric relay, the combination with an audion, of a circuit including a resistance in shunt of two of the elements of said audion.

It will be observed that these are broad claims. As stated by the Assistant Commissioner, the invention—

might perhaps be better called a discovery that the paralysis of an audion may be removed by discharging certain charges on the terminals.

We now will turn to the evidence. De Forest, a pioneer in this art, after producing the audion covered by his patents subjected it to numerous tests which, it is conclusively established, demonstrated that under certain conditions, the audion becomes inoperative. Several witnesses, including witnesses for Richards who were present and participated in those tests, corroborate De Forest on this question, and from their testimony it conclusively appears that long prior to Richards's entry into the field De Forest not only recognized the difficulty giving rise to the invention of the issue but suggested various means to overcome it, which means accomplished the purpose. The paralyzed condition of the audion usually was neutralized by touching the terminals with the thumb and finger, thereby permitting the discharges to neutralize each other through this high

resistance connection. Liquid resistance, wet strings, gum and a carborundum rod also were used.

In October of 1912 De Forest demonstrated his audion to the Western Electric Company, and Richards, one of its engineers, was present during the demonstration. He knew practically little about the art at that time. However, he claims that the invention in issue occurred to him during this demonstration, while De Forest insists that he, De Forest, then suggested and—

pointed out and illustrated that this last condition (paralyzed condition) could be instantly corrected by touching the thumb and fingers across the grid and filament of plate binding posts on the audion instrument.

We agree with the Examiner of Interferences that the testimony and surrounding circumstances overwhelmingly sustain De Forest on this point. It is utterly inconceivable that this man who was the originator of the audion, who previously had subjected it to tests, who had discovered that under certain conditions it would become inoperative, and who also had discovered how that condition might be overcome, would have failed to impart his knowledge under the circumstances disclosed. That the information he gave Richards amounted to a complete disclosure of this invention is beyond question. Of this information De Forest says in his testimony:

This illustration was, of course, all that was necessary to show to a skilled engineer that a high resistance leakage path between the two audion electrodes would remedy or tend to remedy a condition of "paralysis" due to too large a negative charge coming on the grid.

One of Richards's witnesses was asked on cross examination what suggested to him the idea of permanently connecting a resistance between the electrodes of the audion, and answered:

The fact that a temporary resistance would discharge the audion.

In other words, the various expedients resorted to by De Forest long prior to Richards's entry into the field clearly suggested the device of the issue. As already noted, the claims are broad and general and it is not now permissible to meet the exigencies of the case by giving them a narrower interpretation. (*Geltz v. Crozier*, C. D., 1909, 313; 140 O. G., 757; 32 App. D. C., 324; *Leonard v. Horton*, C. D., 1913, 348; 189 O. G., 781; 40 App. D. C., 22; *Kirby v. Clements*, C. D., 1915, 163; 216 O. G., 1319; 44 App. D. C., 12; *Monte v. Dunkley*, C. D., 1917, 208; 245 O. G., 278; 46 App. D. C., 70.)

We rule, therefore, that De Forest and not Richards was the inventor of the subject matter of the counts, and accordingly reverse the decision of the Patent Office.

Reversed.

Mr. Chief Justice SMYTH *dissents.*

[Court of Appeals of the District of Columbia.]

SHENK AND HOLMAN *v.* CLARK.

Decided March 1, 1920.

274 O. G., 409; 49 App. D. C., 249; 263 Fed. Rep., 645.

PATENTS—INTERFERENCE—RIGHT TO MAKE CLAIM.

The Commissioners's ruling that Clark has a right to make the claim in issue reviewed and affirmed.

(For Commissioner's decision see *ante*, 16; 274 O. G., 405.)

Mr. J. M. Spear and *Mr. Ellis Spear, Jr.*, for the appellants.

Mr. C. E. Brock for the appellee.

ROBB, J.:

Appeal from a decision of the Patent Office in an interference proceeding awarding priority of invention to the senior party Clark.

The invention relates to a glass light-transmitter in an automobile-headlight and is expressed in a single count as follows:

A refractive screen for use with a headlight having a reflector comprising surfaces of variant vertical distributive dispersion and surfaces of variant lateral distributive dispersion at and beyond the intercept of the roadway.

Shenk's contention here, as below, is that Clark has no right to make the claim. The Law Examiner, the Examiners-in-Chief and the Assistant Commissioner have carefully considered this question and in separate opinions have found in Clark's application a complete disclosure of the subject-matter of this claim.

We have considered the very-carefully-prepared brief of appellant's counsel but have not been convinced that any error was committed by the Patent Office, and, therefore, without further discussion of the question involved, affirm the decision.

Affirmed.

[Court of Appeals of the District of Columbia.]

BROWN *v.* TOMLINSON.

Decided April 5, 1920.

274 O. G., 613; 49 App. D. C., 310; 265 Fed. Rep., 460.

PATENTS—INTERFERENCE—RIGHTS TO MAKE CLAIMS.

Record reviewed and *Held* that appellee, Brown, has failed to overcome the burden imposed by concurrent decisions of the Patent Office tribunals holding that Tomlinson had a right to make the claims in issue, and the decision of the Commissioner of Patents therefore affirmed.

Mr. H. A. Coombs and *Mr. E. A. Wright* for the appellant.

Mr. Frank T. Brown, *Mr. C. M. Nissen*, and *Mr. Wm. M. Cady* for the appellee.

ROBB, J.:

Appeal from concurrent decisions of the Patent Office awarding priority of invention to the senior party Tomlinson. The second of the two claims of the issue is here reproduced:

2. In an electric train coupling, the combination with a casing containing a plurality of fixed contacts adapted to be connected to train line circuits and a longitudinally movable contact slide having corresponding contacts, of fluid pressure operated means for projecting said slide to electrically connect the fixed contacts of counterpart couplings, and a manually operated element for controlling the supply of fluid to said means.

Upon the declaration of interference Brown filed a motion for its dissolution, on the ground that Tomlinson has no right to make the claims of the issue. The question was elaborately reviewed by the Law Examiner, who found in favor of Tomlinson. Thereupon the Examiner of Interferences awarded priority on the record to Tomlinson, Brown having failed to show cause why that should not be done. On appeal to the Examiners-in-Chief, the question of Tomlinson's right to make the claims was again reviewed and that right sustained. The question was again raised and considered by the Assistant Commissioner, with the same result. In such circumstances, manifest error must be made to appear to warrant this court in disturbing the decision of the Patent Office. (*Livingston v. Thompson*, C. D., 1917, 114; 235 O. G., 1055; 45 App. D. C., 522; *Hathaway & Lea v. Colman*, C. D., 1917, 229; 245 O. G., 1025; 46 App. D. C., 40.) Appellant has not met this requirement.

We agree with the Patent Office that Brown, in whose application these claims originated, is now seeking to read into them unwarranted limitations; in other words, that the invention covered by the claims is disclosed in both applications. The decision therefore is affirmed.

Affirmed.

[Court of Appeals of the District of Columbia.]

DOYLE AND HEDLEY v. TOMLINSON.

Decided April 5, 1920.

274 O. G., 613; 49 App. D. C., 311; 285 Fed. Rep., 461.

PATENTS—INTERFERENCE—RIGHT TO MAKE CLAIMS.

Record reviewed and *Held* that Tomlinson has a right to make the claims of the issue.

Mr. H. A. Coombs, Mr. W. M. Cady, and Mr. E. A. Wright for the appellants.

Mr. C. M. Nissen, Mr. Frank T. Brown, and Mr. Alpheus Crane for the appellee.

ROBB, J.:

Appeal from concurrent decisions of the Patent Office awarding priority of invention to the senior party Tomlinson. We reproduce the second of the two claims of the issue:

2. In a coupling for electric train line circuits, the combination of a casing, fixed contact fingers mounted therein and connected to the respective circuits, a movable contact carrier normally held out of operative position, and a fluid pressure mechanism for shifting said contact carrier to its operative position to establish electrical connection between said fixed contacts and the corresponding fixed contacts of an adjacent car.

Upon the declaration of the interference appellants filed a motion for its dissolution, on the ground that Tomlinson has no right to make the claims of the issue. The question was elaborately reviewed by the Law Examiner, who found in favor of Tomlinson. Thereupon the Examiner of Interferences awarded priority on the record to Tomlinson, appellants having failed to show cause why that should not be done. On appeal to the Examiners-in-Chief, the question of Tomlinson's right to make the claims was again reviewed and that right sustained. The question was again raised and considered by the Assistant Commissioner, with the same result.

For the reasons announced in the preceding case (Brown v. Tomlinson, ante, 178) we affirm the decision of the Patent Office.

Affirmed.

[Court of Appeals of the District of Columbia.]

GROVER AND BARBER v. ANTOINE AND TRAVIS.

Decided April 5, 1920.

274 O. G., 841; 49 App. D. C., 313; 265 Fed. Rep., 463.

PATENTS—INTERFERENCE—PRIORITY.

Evidence reviewed and the decision of the Commissioner of Patents awarding priority to Antoine and Travis on the ground that they were the first to conceive and reduce to practice affirmed.

(For Commissioner's decision see ante, 18; 274 O. G., 839.)

Mr. Melville Church, Mr. A. A. Thomas, and Mr. Alex. S. Stuart for the appellants.

Mr. J. H. Jochum, Jr., for the appellees.

ROBB, J.:

Appeal from a decision of the Patent Office in an interference proceeding awarding priority of invention to the junior parties, Antoine and Travis. The invention is a washer-catcher in coin-controlled vending-machines, such as are used in theaters and other

public places. The four counts of the issue will be sufficiently illustrated by the reproduction of the fourth count, as follows:

4. In a coin controlled machine, a casing having a coin slot or passage, a coin carrier normally free to rotate in a direction to carry the deposited coin into operative position within the machine, an upwardly extending yieldable member supported at its lower end and provided at its upper or free end with a head projecting normally into said coin slot or passage, whereby said head is adapted to enter the opening of a washer on said coin carrier, said head having a beveled surface and an abrupt surface so arranged that said abrupt surface unyieldingly engages the inner edge of the washer and thereby positively locks said washer and coin carrier against further movement, said beveled surface permitting reverse rotation of the coin carrier for removal of the inserted washer through said coin slot, and a hand-operable member on the front wall of said casing for operating said coin carrier.

The difference between this invention and the prior art lies in a pocket and dog, the dog being described in the claims as—

an upwardly extending yieldable member supported at its lower end and provided at its upper or free end with a head projecting normally into said coin slot or passage.

It will be unnecessary further to describe the invention. The Patent Office tribunals have found that Grover and Barber, the appellants, conceived the invention in April of 1912 and reduced it to practice in January of 1913, and we accept these findings. The Examiner of Interferences held that Antoine and Travis had not established an earlier date of conception and reduction to practice. The Examiners-in-Chief and the Commissioner, however, after a very careful review of the evidence, reached the conclusion that Antoine and Travis had proven conception of the invention in the fall of 1911 and reduction to practice in the early part of 1912. They further found that a large number of machines embodying the invention were sold and shipped to the trade immediately following reduction to practice of the invention.

An examination of the record and the exhaustive and helpful briefs of counsel have convinced us that the decision appealed from was correct.

Since the evidence has been carefully reviewed by both the Examiners-in-Chief and the Commissioner, no useful purpose would be served by its restatement here, and accordingly we affirm the decision without more.

Affirmed.

[Court of Appeals of the District of Columbia.]

IN RE MOORE AND PACK.

Decided April 5, 1920.

274 O. G., 842; 49 App. D. C., 312; 265 Fed. Rep., 462.

PATENTS—INCORPORATION OF ONE OLD DEVICE INTO ANOTHER NOT INVENTION.

The application of a rotary brush and its coöperative parts to an old carpet-cleaning device where the parts so associated operated in the old way to effect the same results does not constitute invention.

(*For Commissioner's decision see ante*, 21; 274 O. G., 840.)

Mr. J. S. Barker for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

ROBB, J.:

Appeal from a decision in the Patent Office rejecting certain patent claims for a portable cleaning-machine of the vacuum type. Claims Nos. 6 to 11, inclusive, are here involved. Claim numbered 8, sufficiently illustrates the group, and reads as follows:

8. A portable carpet-cleaning machine comprising a casing divided into two separate compartments, a dust collecting nozzle carried at the front end of the casing and positioned to lie in close engagement with the carpet being cleaned and operated to collect the lighter particles of dust and discharge them into one of the compartments of the casing, a suction-creating device carried by the casing and in communication with the nozzle through the last mentioned compartment, a drive wheel located at the rear of the casing, connections between the drive wheel and the suction-creating devices for operating the latter as the casing is moved over the surface being cleaned, and a rotary driven brush located in the other compartment of the casing and situated between the nozzle and the said drive wheel.

Appellant has done no more than apply to the Sturgeon device (Patent No. 996,810, July 4, 1911) a rotary brush and its coöperative parts shown in the Behringer device (British Patent No. 11,413, of 1908). Each element in the new combination operates in substantially the same way that it operated in the prior device, and effects substantially the same result. This is not invention. (*Grinnell Washing Company v. Johnson Company*, C. D., 1918, 363; 254 O. G., 225; 247 U. S., 426.) Nothing more was involved than the skill of the mechanic.

Since each of the Patent Office tribunals has fully considered the references, we affirm the decision without further discussion.

Affirmed.

[Court of Appeals of the District of Columbia.]

COX v. HEADLEY AND THOMPSON.

Decided May 3, 1920.

275 O. G., 419; 49 App. D. C., 341; 265 Fed. Rep., 981.

1. PATENTS—ISSUE CONSTRUED IN LIGHT OF SPECIFICATION WHEN FIRST MADE.

Counts of an interference issue must be given the broadest interpretation they reasonably will support and in the light of the specification where they originated, and this rule is not varied by the fact that the applicant in whose application the claims originated dropped out of the interference after the decision of the Examiner of Interferences.

2. SAME—SAME—ISSUE RELATING TO SUBORDINATE PART OF MACHINE—OPERATIVENESS OF MACHINE AS A WHOLE.

Where the counts of a three-party interference originated in an application where automatic operation was not contemplated, and related to a subordinate part of the entire machine, which application dropped out of the interference after the decision of the Examiner of Interferences, judgment of priority in favor of one of the remaining parties should not be based on the theory that the other party's machine was not operative as a whole and was therefore not a reduction to practice because it would not perform its functions automatically.

Mr. Fritz v. Briesen for the appellant.

Mr. C. P. Byrnes, Mr. G. H. Parmelee, and Mr. Geo. E. Stebbins for the appellee.

ROBB, J.:

Appeal from Patent Office decisions in two interference proceedings, Nos. 40,043 and 40,044, in which priority was awarded the junior parties, Headley and Thompson.

The parties to interference No. 40,043 are the appellant Cox and the appellees Headley and Thompson. The invention involved in this interference is an automatic machine for making glass bottles and is expressed in ten counts, taken from the Headley and Thompson application, of which we reproduce the first:

1. In a glass bottling machine, the combination of mold carrying means rotatably mounted, a pair of molds carried by said means opposite each other in radial alignment, a rotatable face plate journaled on a horizontal axis on said mold carrying means and carrying one mold of each set, means for rotating said face plate to place the molds carried thereby in a vertical charging position and then to place said molds in a position to permit removal from the blanks inclosed thereby and their engagement by the other molds carried by said mold-carrying means, and means for moving said mold-carrying means.

Interference No. 40,044 originally involved the applications of Headley and Thompson, Francis W. Pawling, and the appellee Cox. The two counts of this interference were copied from the Pawling application and, as there used, describe a manually rotated device

for inverting the mold and swinging open the blank mold members in a bottle making machine. We here reproduce the two counts of this interference:

1. In a glass bottling machine, the combination of a cylindrical carrier rotatable about its own axis and otherwise movable only in a horizontal plane, and having a fluid pressure chamber, a mold including two mating members at least one of which is movable relative to the other, a piston mounted in said fluid pressure chamber, connections between said piston and the movable mold member or members, and means for turning said cylindrical carrier upon its axis to invert the mold.

2. In a glass working machine, the combination of a pedestal, a mold carrier journaled thereon and axially fixed with reference thereto, a mold including two swinging mating members pivotally mounted upon the mold carrier upon an axis lying at an angle to the axis of the mold carrier, an actuating member reciprocally mounted within the journal portion of the mold carrier, connections between said actuating member and the movable mold members.

Cox is the senior party in both interferences and the record clearly discloses that he was the first to conceive the invention of the issues. Evidently realizing the handicap under which they were placed, Headley and Thompson, when the case was reached before the Examiner of Interferences, filed a motion for leave to amend their preliminary statement, but failing to state a sufficient reason therefor the motion was denied. Down to this time Headley and Thompson had filed no motion under Rule 130 of the Patent Office attacking the right of Cox to make the claims. However, after the adverse decision of the Examiner of Interferences on their application to amend their preliminary statement, they notified Cox that at final hearing they would urge that the machine upon which he bases his right to make the claims was inoperative, and hence that the claims were not patentable to him. Thereafter the Examiner of Interferences awarded priority to Cox in both interferences. Since Pawling took no testimony, he was confined to his filing date for conception and reduction to practice, and did not appeal from the decision of the Examiner of Interferences. On appeal to the Examiners-in-Chief, the right of Headley and Thompson to challenge the operativeness of the Cox device was sustained, notwithstanding their failure to file a motion under Rule 130. The Board then rules that the machine upon which Cox depended for actual reduction to practice "as an entirety" was not "satisfactory," but pointed out that—

when the case was originally filed, the Examiner required a division between claims which involved the shears, for cutting off the glass above the molds, and the rotary plunger or compacting device, which is one of the features alleged to be inoperative, and the group of claims which are involved in the interference, which all relate to the mold carrying and operating elements,

and that the Examiner had found "no necessary connection between these devices." The Board ruled that as—

the issues cover only a subordinate part of the machine which would be capable of use in other bottle blowing machines, and there is no reason to suppose that this part was inoperative, Cox can at least rely upon his constructive reduction to practice on the date of filing of his application, June 4, 1912, and was therefore the first to conceive and first to reduce to practice, which entitles him to an award of priority.

Thereupon, Pawling having dropped out of the case, a petition for rehearing was filed and the Board set aside their decision and adopted the contention of Headley and Thompson that—

the subject matter of the issues is a construction in which the molds are reversed, opened and closed and moved from one station to another *automatically*.

The Board did not attach any weight to the fact that some of the claims had originated in the Pawling application, which admittedly did not disclose an automatic structure, because Pawling had been eliminated from the interference. The Board further found that Cox had not shown that his combination was susceptible of being substituted in machines of the prior art. Thereupon, on appeal by Cox, the Assistant Commissioner sustained the ruling of the Board and awarded priority to Headley and Thompson. The Assistant Commissioner said:

Pawling is not now involved in the interference, since he took no testimony and his application was filed after the date established by Headley and Thompson. If his application were still in the interference the question of the operativeness of that device might have to be considered, but it does not follow, even if the Pawling machine is operative for the purpose for which it is intended, that necessarily the operativeness of the entire machine of Cox can not be considered or that the counts must be construed as limited to the means for opening and closing the molds irrespective of whether this means is operative in the machine shown.

We first will consider the three-party interference, that is No. 40,044. The claims of this interference, having originated in the Pawling application, must be read in the light of the Pawling specification. Over and over again has it been determined that such is the rule, and that claims must be given the broadest interpretation they reasonably will support. (*Podlesak v. McInnerney*, C. D., 1906, 558; 120 O. G., 2127; 26 App., D. C., 399; *Sobey v. Holsclaw*, C. D. 1907, 465; 126 O. G., 3041; 28 App., D. C., 65; *Miel v. Young*, C. D., 1907, 561; 128 O. G., 2532; 29 App., D. C., 481; *Kirby v. Clements*, C. D., 1915, 163; 216 O. G., 1319; 44 App., D. C., 12; *Seymour v. Molyneux*, ante, 133; 271 O. G., 688; 49 App. D. C., 216.) In the case last cited we said:

While we many times have ruled that a party will not be permitted to narrow his claims to suit the exigencies of a given situation, it is equally well settled that the meaning given to the counts of an interference must be that disclosed in the specification of the party first to make the claim.

In the Pawling specification, as the Patent Office tribunals recognized, automatic operations are not contemplated. The application assumes that the blowing operation is to be performed in accordance with the teachings of the prior art. Count No. 1 provides, and was intended to provide, mechanical means for inverting the mold and for swinging open the blank mold members. The neck-mold is not even an element of this count, nor are the plunger and specific form of suction mechanism of the Pawling structure made elements of the count. Count No. 2 differs from count No. 1 in that the pedestal is included as an element, both mold members are specified as "swinging," and the piston is referred to as "an actuating member." Clearly these counts, as used by Pawling, embrace and were intended to embrace nothing more than a distinct subdivision of a glass-blowing machine, which Pawling in his specification states—

may, of course, be incorporated in various ways in glass blowing machines involving other features.

These claims were suggested to and copied by Cox and Headley and Thompson, and in our view, they should be read now, as then, in the light of the Pawling disclosure. The elimination of Pawling can not result in the elimination or abridgement of this rule of interpretation. The reason for the rule still exists, namely, that the originator of the claims is presumed to have couched them in language setting forth his particular invention. If another claims the invention, it is only fair that the application originating the claims should be looked to in determining their scope and meaning. In the present case, merely because Pawling was defeated before the Examiner of Interferences, the Patent Office has read into the claims of that interference a limitation utterly inconsistent with the disclosure of that application. In so doing the Patent Office erred. Reading these claims in the light of the Pawling application, Cox is entitled to priority because he discloses everything there disclosed.

We come now to the decision in interference No. 40,043, wherein the narrower claims originated with Headley and Thompson. It follows from what we have said that these claims must be read in the light of the disclosure by Headley and Thompson, and we are not prepared to disturb the ruling of the Patent Office that, when so read, they are not patentable to Cox.

The decision in interference No. 40,043 is affirmed, and the decision in interference No. 40,044 is reversed and priority as to that interference awarded Cox.

Affirmed as to interference No. 40,043.

Reversed as to interference No. 40,044.

Mr. Chief Justice SMYTH *dissents in interference No. 40,044.*

[Court of Appeals of the District of Columbia.]

HARTSOUGH v. GILE.

Decided May 3, 1920.

275 O. G., 421; 49 App. D. C., 354; 265 Fed. Rep., 994.

PATENTS—PRIORITY—ABANDONED EXPERIMENT.

Where G. built a plow-tractor in the summer of 1914, took it to a farm and tested it, brought it back, and laid it aside until the spring of 1916, where it was observed by licensees of the opposing party, H., who induced G. to file an application, while H. filed his application on July 21, 1915, and promptly perfected his machine and placed it on the market, *Held* that what G. did in 1914 must be regarded as an abandoned experiment in view of his failure to act except under the stimulus of the knowledge of H.'s activity and of the further circumstances that, although the tractor was in the same condition at the time of taking testimony and the sufficiency of the test in 1914 was challenged, no attempt was made to prove its operativeness, and that after said test G. directed his attention to the construction of another machine, which was completed in 1916, and for which he immediately applied for a patent.

Mr. A. C. Paul and Mr. W. G. Henderson for the appellant.

Mr. Fred Gerlach and Mr. Percy B. Hills for the appellee.

ROBB, J.:

Appeal from a decision of an Assistant Commissioner of Patents in an interference proceeding awarding priority to the junior party Gile. The invention relates to a plow-tractor and is expressed in a single count, as follows:

In a plow tractor, the combination of a pair of coaxial traction wheels at the sides of the tractor respectively, a single front steering wheel substantially aligned longitudinally with one of the traction wheels, said longitudinally aligned steering and traction wheels being disposed at the furrow side of the tractor and adapted to travel in the same furrow, a frame supported by said traction and steering wheels, differential gearing between the traction wheels and whereby both will be driven, and a motor mounted on the frame and connected to drive said gearing, said single front wheel when traveling in a furrow acting to automatically steer the tractor, said gearing causing the traction wheels to be driven at relatively different speeds in steering the tractor responsively to the front furrow wheel.

In the summer of 1914 Gile built a tractor at Ludington, Michigan, which we will assume embodied the issue, and in October of that year this tractor was taken to a farm near Scottsville, Michigan, and there tested. In November, following, it was taken back to Ludington and, so far as the evidence discloses, was not used thereafter but found its way to a neighboring ball-park, where it remained until the spring of 1916, when it was discovered by representatives of licensees of Hartsough, whose attention was attracted to it by its resemblance to the Hartsough tractor their concern was manufacturing under license. The Examiner of Interferences found, and we concur in the

finding, that Gile was inspired to apply for a patent by representations then made to him. After the construction and test of this machine, it apparently passed out of his mind, for he directed his attention to the construction of another machine which was completed in the summer of 1916, and upon which he almost immediately applied for a patent. After a patent had inadvertently issued to Gile upon the application induced by the licensees of Hartsough, those licensees ceased paying Hartsough royalties but continued to manufacture the tractor under a license from the assignees of the Gile patent.

When Hartsough's application was filed in July 21, 1915, he not only had perfected his machine but had placed the same on the market, where it was very favorably received. Gile, whose concern manufactured and sold to Hartsough motors for his tractor and who must have known of the tractor's success, did nothing about asserting a claim to the invention, as we have seen, until after the incident to which we have alluded. The testimony relating to the character and sufficiency of the test of the Gile tractor in October of 1914 was taken in May of 1917, or more than two and one-half years after the test. The testimony tended to show that the tractor did "very good work" or, as Gile himself testified, "Well, we considered the work very good." The testimony not only is lacking in detail but is so inconsistent with what followed as to cause us to adopt the finding of the Examiner of Interferences that it falls short of proving reduction to practice. As the circuit court of appeals observed in *Griswold v. Harker et al.* (C. D., 1894, 535; 69 O. G., 369; 62 Fed. Rep., 389:)

Actions often speak louder and frequently more truthfully than words.

It is inconceivable that Gile, an intelligent man abundantly able, apparently, to take advantage of and protect and promote any invention he should make, and who admittedly was endeavoring to evolve a successful tractor, would have acted as he did had the test of this tractor been even measurably successful. When the testimony was taken the tractor was in existence and apparently as capable of being operated as in 1914, and yet it was not operated. While it is not incumbent upon a party, after satisfactorily proving reduction to practice, again to operate his device, in a case of this sort where there is a serious question as to the success of a former test, the most satisfactory way to settle the question, it occurs to us, would be again to test the machine.

There are other circumstances all tending in the same direction, to which the Examiner of Interferences alluded in his opinion but which need not be repeated here.

This court has uniformly ruled that where, as here, a machine is constructed, tested, put aside and apparently forgotten, and an-

other party in good faith enters the field and constructs a similar machine, puts it upon the market and applies for a patent, the first party, who slumbered upon his rights, must have very clear and convincing evidence that the test of his machine fully complied with the requirements as to reduction to practice, and that if he fails to sustain that burden the test will be regarded as a mere abandoned experiment and priority awarded the party through whose efforts the public received the invention. (*Warner v. Smith*, C. D., 1898, 517; 84 O. G., 311; 13 App. D. C., 111; *Adams v. Murphy*, C. D., 1901, 401; 96 O. G., 845; 18 App. D. C., 172; *Howard v. Hey*, C. D., 1901, 375; 95 O. G., 1647; 18 App. D. C., 142; *Quist v. Ostrom*, C. D., 1904, 594; 108 O. G., 2147; 23 App. D. C., 69; *Gordon v. Wentworth*, C. D., 1908, 453; 135 O. G., 1125; 31 App. D. C., 150; *Moore v. Hewitt*, C. D., 1908, 516; 136 O. G., 1535; 31 App. D. C., 577; *Collis v. Quenzer*, C. D., 1912, 502; 179 O. G., 1110; 38 App. D. C., 481.)

We rule, therefore, that Gile has not sustained the burden of proof in this case and, as he clearly was lacking in diligence, the decision is reversed and priority awarded Hartsough.

Reversed.

[Court of Appeals of the District of Columbia.]

**CHRISTO MANUFACTURING COMPANY v. THE CHRISTIAN MOERLEIN
BREWING COMPANY.**

Decided May 3, 1920.

275 O. G., 827; 49 App. D. C., 370; 265 Fed. Rep., 1010.

**TRADE-MARK—GOODS OF THE SAME DESCRIPTIVE PROPERTIES—NON-ALCOHOLIC
CEREAL BEVERAGE AND NEAR-BEER BEVERAGE.**

A non-intoxicating cereal beverage containing no malt or alcohol *Held* to constitute goods of the same descriptive properties as a "near beer" beverage.

Mr. Melville Church and Mr. A. S. Stuart for the appellant.

Mr. Titian W. Johnson for the appellee.

SMYTH, C. J.:

The Christian Moerlein Brewing Company made application for registration of the word "Chrismo," alleging that it had been adopted by it and used continuously in its business since September 25, 1916. The application is opposed by the Christo Manufacturing Company, who is the owner of the trade-mark "Christo," registered April 29, 1913. The Examiner of Interferences sustained the opposition. On motion he granted a rehearing, reëxamined the question, and decided to adhere to his first view. He was reversed on appeal, and the opposition was overruled.

The resemblance of the two marks is conceded, but it is urged by the applicant that they are not applied to goods of the same descriptive qualities. The applicant's product is, according to its application, "a non-alcoholic beverage sold as a soft drink." By agreement a circular issued by the applicant was made part of the record. It says—

that the goods of the applicant is a non-intoxicating cereal beverage containing no malt or alcohol.

No testimony was offered by the applicant. On cross-examination of one of the opposer's witnesses it was developed that the opposer manufactured "a near beer beverage" called "Christo Lager Ale," and that it had been doing so for over a year prior to the taking of the testimony. If this was not true it could easily have been contradicted, but no effort was made by the applicant to do so. Hence we must assume that it is true. In view of this there is no escape from the conclusion that the goods of the applicant possess the same descriptive qualities as those of the opposer.

And this being so, the opposition must be sustained and the decision of the Patent Office reversed. (Thomas Mfg. Co. v. Aeolian Co., C. D., 1918, 157; 249 O. G., 505; 47 App. D. C., 376; Getz Bros. & Co. v. Alaska Packers Assn., C. D., 1919, 213; 264 O. G., 534; 49 App. D. C., 54; 258 Fed. Rep., 526.)

Reversed.

[Court of Appeals of the District of Columbia.]

IN RE STADEKER.

Decided May 3, 1920.

275 O. G., 1023; 50 App. D. C., —; 267 Fed. Rep., 322.

PATENTS—INVENTION—WINDSHIELD-CLEANER.

Claims for windshield-cleaner in which the feature relied upon for patentability is a handle consisting of a wire or rod bent in zigzag form *Held* devoid of invention.

(For Commissioner's decision *see ante*, 34; 275 O. G., 1023.)

Mr. J. H. Milans and *Mr. C. T. Milans* for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

ROBB, J.:

Appeal from a decision of the Commissioner of Patents denying five claims for a patent on an automobile-windshield cleaner. Claim 5 reads as follows:

5. A device of the class specified consisting of a metallic rod bent upon itself to form a cleaning portion and a handle portion, the latter portion being pro-

vided with a series of lateral bends extending from side to side in zigzag manner to form a wide, flat, vertical, handle to permit the device to be firmly grasped and to rest flatwise against the palm of the operator's hand.

While appellant's device apparently possesses utility, we are constrained to agree with the Patent Office that its evolution did not involve invention. The patents to Wolfe, (No. 1,171,377, February 8, 1916;) Devore, (No. 525,189, August 28, 1894,) and Goodrich, (No. 1,211,698, January 9, 1917,) as found by the Commissioner, disclose every element of the device of the issue. *The decision must be affirmed.*

Affirmed.

[Court of Appeals of the District of Columbia.]

KITSELMAN v. REID, REID, AND KELLEY.

Decided May 3, 1920.

275 O. G., 1024; 49 App. D. C., 378; 266 Fed. Rep., 256.

PATENTS—INTERFERENCE—PRIORITY.

Decision of the Commissioner of Patents awarding Priority to R., R., and K. affirmed.

(For Commissioner's decision see ante, 26; 275 O. G., 623.)

Mr. Wm. S. Hodges for the appellant.

Mr. J. C. Dowell for the appellee.

SMYTH, C. J.:

From a decision by the Commissioner of Patents awarding priority to Reid, Reid, and Kelley, the senior parties, in an interference, Kitselman appeals.

The invention involved relates to double-series machines for making two rolls of fence simultaneously. This appeal is a companion of the appeal in Nos. 1303 and 1304, in which the same parties are concerned, this day decided. The three tribunals of the Patent Office concur in awarding priority to Reid, Reid, and Kelley. Where this is so, unless there is manifest error, the decision of the Commissioner should be affirmed. (*Greenawalt v. Dwight*, C. D., 1919, 234; 266 O. G., 138; 49 App. D. C., 82; 258 Fed. Rep., 982, and cases therein cited; *Hopkins v. Riegger*, ante 126; 271 O. G., 511; 49 App. D. C., 188; 262 Fed. Rep., 642; and *Kennicott v. Caps*, ante 120; 271 O. G., 361; 49 App. D. C., 187; 262 Fed. Rep., 641.)

We find no such error in this case, and therefore the decision of the Commissioner is affirmed.

Affirmed.

[Court of Appeals of the District of Columbia.]

REID, REID, AND KELLEY *v.* KITSELMAN. KITSELMAN *v.* REID, REID,
AND KELLEY.*Decided May 3, 1920.*

275 O. G., 1024; 49 App. D. C., 377; 266 Fed. Rep., 255.

PATENTS—INTERFERENCE—PRIORITY.

The decision of the Commissioner awarding certain counts to K. and others to R., R., and K. affirmed.

(For Commissioner's decision see *ante*, 28; 275 O. G., 624.)

Mr. J. C. Dowell for the appellants.

Mr. Wm. S. Hodges for the appellees.

MEMORANDUM OPINION BY CHIEF JUSTICE SMYTH.

Reid, Reid, and Kelley were placed in interference with Kitselman concerning a device for producing woven-wire fencing. There are fifty-seven counts involved. Space will not permit us to set them all out, and it is difficult to select a few that would be typical. Therefore, we refer those interested to the opinion of the Examiner of Interferences, where all the counts can be found. Some of the counts were awarded to Reid, Reid, and Kelley, and others to Kitselman. Each side appeals from so much of the decision as is against it.

The three tribunals of the Patent Office concur as to the disposition of all the claims except five, and as to those the Examiners-in-Chief and the Commissioner are in accord.

The questions involved are somewhat intricate. We have studied them with care. It is not necessary to set down here the process by which we have reached a determination, because the Examiners-in-Chief and the Commissioner have thoroughly analyzed the matter in their respective opinions, and we approve their conclusions and the reasoning upon which it rests. The Commissioner awarded Kitselman priority as to counts 1 to 18, inclusive, 20 to 36, inclusive, 38 to 45, inclusive, 48 to 52, inclusive, 54 and 55; and to Reid, Reid, and Kelley he awarded priority as to counts 19, 37, 46, 47, 53, 56, and 57. *His decision is affirmed.*

Affirmed.

[Court of Appeals of the District of Columbia.]

IN RE SORUM.

Decided May 3, 1920.

275 O. G., 1024; 49 App. D. C., 860; 285 Fed. Rep., 1000.

PATENTS—PATENTABILITY—INVENTION.

Although the prior art disclosed in one patent the combination of an adding-machine and an ejecting mechanism which would eject the smallest number of coins necessary to be dispensed to pay each item of a pay-roll and in another a machine for automatically recording the different denominations of coins and paper money necessary to make up any given amount, *Held* that is was invention to combine an adding-machine with a denominationalizer, whereby it could be determined in advance the number of bills and coins which it would be necessary to obtain at the bank to pay each item of a pay-roll, which was a new result.

Mr. H. C. Robb and *Mr. J. F. Robb* for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

ROBB, J.:

Appeal from a Patent Office decision rejecting seventeen claims, from 5 to 21, inclusive, of which claims 7 and 20 are sufficiently illustrative:

7. The combination with an adding machine comprising an accumulating mechanism and manipulating devices controlling the setting up of amounts to be accumulated, of denominational counters, and means for operating the counters automatically and incident to the operation of the accumulating mechanism to determine the number of units of different denominations or values necessary to make up each amount set up by the manipulative devices for accumulation.

20. In a machine of the class described, the combination of a plurality of counting devices, an actuator associated with each counting device, operating means for the actuators normally inoperative relative thereto, and means for initially selecting one or more of the actuators to render the same operative in respect to said operating means, and accounting mechanism including accounting instrumentalities adapted for preliminary selection by the aforesaid selecting means, and operating means for said instrumentalities actuated from the above-mentioned operating means.

The pay-rolls of large employers of labor are made up in advance and, in making up those pay-rolls, it is desirable that a printed record of each wage item be kept and a constant total of all items carried. If this is done, time and labor will be conserved, because the specific number of bills and coins required to be obtained at the bank will be known in advance. It was to meet this condition that the applicant brought together his combination. Prior to the entry of Sorum into the field, Griffen had invented a machine—

for automatically registering or recording the different denominations of coin and paper money necessary to make up any given amount. Patent 979,391, December 20, 1910.)

In other words, the function of Griffen's machine is automatically to separate a given amount into its elements. Marks (British 28,084, December 5, 1912) had evolved a combined adding-machine and ejecting mechanism; that is to say, it is necessary in the Marks machine to guess at the approximate amount needed, place it in the machine, and then have it separated into its elements. The Commissioner says of this invention:

Instead of listing on what applicant refers to as a "denominationalizing" mechanism the smallest number of coins necessary to pay the roll, the smallest number of coins are ejected to pay each item of the roll.

The Patent Office tribunals were of the view that no invention was involved—

in combining with the adding machine a denominationalizing mechanism instead of coin ejectors.

We are unable to accept this conclusion. Appellant stands forth as the originator of the idea. Up to the time he gave it expression, it apparently had occurred to no one else. He not only conceived the idea of combining an adding-machine with a denominationalizer but put that idea into effect by so combining the two machines as to bring about a new and useful result. In the circumstances, we think that what he has done amounts to invention. Inasmuch as the art is comparatively new, the machines brought into coöperation by the applicant complicated, and the advance achieved by that coöperation marked, there is ample room for the application of the general rule—

that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention. (*Webster Loom Co. v. Higgins*, C. D., 1882, 285; 21 O. G., 2031; 105 U. S., 591.)

The observation of the Court in *Diamond Rubber Co. v. Consolidated Rubber Tire Co.* (C. D., 1911, 538; 166 O. G., 251; 220 U. S., 428) is here pertinent:

the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not. It regards a change as evidence of novelty, the acceptance and utility of change as a further evidence, even as demonstration.

Under the rule announced in the *Eastwood and Harbeck* cases (C. D., 1909, 418; 144 O. G., 819; 33 App. D. C., 291, and C. D., 1913, 405; 191 O. G., 586; 39 App. D. C., 555) applicant would be entitled to a patent even if this were a doubtful case.

The decision is reversed and the case remanded for the allowance of such of the claims as will adequately cover applicant's invention.
Reversed and remanded.

The decision of the First Assistant Commissioner reads as follows:

Applicant appeals from the action of the Examiners-in-Chief affirming the action of the Primary Examiner in finally rejecting claims 5 to 21. The rejection of claims 1 to 4 was also affirmed; but no appeal was taken as to those claims.

Of the appealed claims, claims 6, 11, 16, and 20 are typical.

"6. In a machine of the class described, the combination of keys bearing indicia and adapted for setting up predetermined amounts, means for accumulating the amounts set up by the keys on operation thereof, and means operable as an incident to the accumulation of amounts for determining the number of units of different denominations of money required to make up each amount accumulated by the accumulating means aforesaid.

"11. In a machine of the class described, the combination of an adding machine, counting mechanism separate from said machine, means to control action of the counting mechanism incident to controlling of the operation of the adding machine, and means to operate the adding machine and counting mechanism conjointly and one of them alone.

"16. In a machine of the class described, the combination with an adding machine comprising keyboard manipulative devices, accumulating mechanism, controlled by said devices, an actuator for the accumulating mechanism, a plurality of counters, selector means intermediate the counters and manipulative devices aforesaid, and means to render the counters operative and inoperative with respect to the actuator.

"20. In a machine of the class described, the combination of a plurality of counting devices, an actuator associated with each counting device, operating means for the actuators normally inoperative relative thereto, and means for initially selecting one or more of the actuators to render the same operative in respect to said operating means, and accounting mechanism including accounting instrumentalities adapted for preliminary selection by the aforesaid selecting means, and operating means for said instrumentalities actuated from the above mentioned operating means."

The references cited are: Debremond, 626,528, June 6, 1899; Smith, 913,779, March 2, 1909; Kleinhans, 976,129, November 15, 1910; Morrison, 977,393, November 29, 1910; Griffen, 979,391, December 20, 1910; Foster, 1,128,594, February 16, 1915; Mark, British, 28,084, December 5, 1912.

The appealed claims relate to the combination of an adding-machine and a counting mechanism, the machine being primarily intended for use in making up pay-rolls, so that there can be determined not only the total amount of the roll and the individual items but the smallest number of coins or notes of certain denominations which must be obtained in order to make the payments. The adding-machine is not claimed to be applicant's invention, and no details of the counting mechanism are included in the claims. In his brief applicant gives as a specific instance of the operation of the the machine the following:

"Considered in another aspect, the combination machine of this case might be said properly to be one which takes an item, say, \$16.87, adds said item to previous items registered, lists said item upon a suitable tape, and divides said item into the least number of bills and coins going to make up the same. The last mentioned operation is done by moving the ten-dollar register of the denominationalizing mechanism one increment, the five-dollar register one increment, the one-dollar register one increment, the fifty-cent register one increment, the twenty-five-cent register one increment, the ten-cent register one increment, and the penny register two increments."

The British patent to Marks shows a combined adding-machine and ejecting mechanism. It differs from the structure shown in this application in that certain bars which are operated when the adding-machine is operated eject coins from coin-receptacles instead of actuating counters. In other words, instead of listing on what applicant refers to as a "denominationalizing" mechanism the smallest number of coins necessary to pay the roll the smallest number of coins are ejected to pay each item of the roll.

The real question involved in the case is whether there would be any invention in combining with the adding-machine a "denominationalizing" mechanism instead of coin-ejectors.

It was old in the art to denominationalize a pay-roll. The patent to Griffen shows a mechanism designed for this purpose. There is no adding-machine shown in this patent, but the denominationalizer is directly operated by keys. The patent to Foster was cited as showing the conversion of a key-actuated coin-discharging machine into a coin registering or counting machine by locating in the space occupied by the coin-receptacles coin-counting mechanism actuated by the coin-ejecting slides.

The Commissioner's decision in *ex parte Thomas* (C. D., 1918, 11; 251 O. G., 889) has been published since the decision of the Examiners-in-Chief, and in view of the ruling therein the Foster patent must be held to be not pertinent, since it was granted after this application was filed and no such structure as herein claimed is claimed therein.

The Examiner also cited other references as showing the use of counters in connection with coin-ejectors.

As noted above, there is no claim herein to the counting mechanism; nor is there any claim herein to the specific mechanism by which the operating-bars are caused to operate the counters. In the operation of the machine a counter is sometimes moved one step and sometimes two. There is no specific mechanism shown or described as to how this operation is brought about. After describing the operation when the counter is to be moved one step it is stated that means may be provided to cause the counter to be moved more than one step. Specifically the only means shown is a slide having two lugs thereon so placed that when an actuator comes into contact with one the counter is moved one increment and when the counter comes into contact with another the counter is moved two increments. In the machine shown there is no necessity for moving the counter more than two increments, since two counters are provided for the pennies, the dimes, and the twenty dollars.

In the machine of the British patent similar mechanism is provided whereby one coin or two coins will be ejected from the coin-chutes, according to the amount set up on the adding-machine. There would apparently be no difficulty in adapting the operating mechanism of this machine to operate a counter one or two steps rather than eject one or two coins, and, as stated above, no claim has been made to this specific detail of construction.

It is thought that the patent to Griffen, which shows a denominationalizing machine, as well as the other patents of record, except the Foster patent, showing the use of counters, would obviously suggest that the mechanism of the British patent might be modified to use the counters in place of the coin-ejectors.

It must be held, therefore, that the appealed claims state no invention over the prior art and for that reason were properly rejected.

The decision of the Examiner-in-Chief is affirmed.

[Court of Appeals of the District of Columbia.]

IN RE DUNCAN.

Decided May 3, 1920.

276 O. G., 211; 49 App. D. C., 372; 265 Fed. Rep., 1012.

PATENTS—CLAIMS—REJECTION FOR INDEFINITENESS AND REDUNDANCY.

The statute requires an applicant to so formulate his claims that the experts of the Patent Office may understand definitely what they mean, and the invention must be so distinctly described as to be understood by one ordinarily skilled in the art to which the invention belongs, and where a multiplicity of claims was presented on a simple invention, some of which were inherently indefinite, all of the claims were properly rejected for failure to point out the invention, as required by the law.

(For Commissioner's decision see ante 36; 276 O. G., 207.)

Mr. Archibald Cox, Mr. W. G. Henderson, and Mr. Harry A. English for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

VAN ORSDEL, J.:

Appeal from rejection of application for patent for improvements for speed and distance indicator records for use on railroad-locomotives.

The rejection of the appealed claims is on the ground that they fail to point out invention. The statute requires an applicant to so formulate his claims that the experts of the Patent Office may understand definitely what they mean, and the invention must be so distinctly described as to be understood by one ordinarily skilled in the art to which the invention belongs.

We agree with the tribunals below that, for the reasons suggested, the claims should be rejected. Appellant, however, has little room for complaint; since his attention was called to the condition of his claims at every stage of the proceeding. The Commissioner found that—

the applicant has an invention and is entitled to a reasonable number of claiming clauses covering it; and upon revision of the claims as herein suggested, the patent will be allowed.

On application for rehearing, the Commissioner again attempted to aid the applicant in the protection of his rights by entering the following order:

The applicant's claims have been considered twice and so far as this office is concerned they are finally rejected and patent refused in the present form of the claims. In view of the obvious good faith of the petition for rehearing, the time for the applicant to submit a small set of claims each of which dis-

tinguishes from every other in patentable substance is extended an additional thirty days. Otherwise the petition is denied.

The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as by law required.

Affirmed.

[Court of Appeals of the District of Columbia.]

IN RE SMITHEY.

Decided May 3, 1920.

276 O. G., 211; 49 App. D. C., 374; 265 Fed. Rep., 1014.

PATENTS—PATENTABILITY—AGGREGATION—DIFFERENT REGISTERS MOUNTED IN THE SAME CASING.

Two manually-operated registers adapted to keep a record of the quantity of gas and oil used in an automobile, mounted in the same casing with the ordinary speedometer and odometer, constitute but an aggregation of features, the registers being independent units.

Mr. Chas. J. Williamson for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

ROBB, J.:

Appeal from a decision of the Commissioner of Patents rejecting three claims, of which the third will serve as an example:

3. An apparatus substantially as described comprising a casing, odometers for indicating the results accomplished, said odometers being automatically operated in securing such results, and a manually operated and controlled register or registers for indicating the material or materials consumed for effecting such results.

Applicant has placed within the casing of an ordinary speedometer and odometer two manually-operated registers, the object of which is to keep a record of the quantity of gas and oil supplied to the automobile. While these two registers are within the casing of the speedometer, they are independent units and their function is no different than that of two pads and pencils. We agree with the Commissioner that—

any combination in such a case is entirely through the intelligence of the user, which is not sufficient of itself to constitute a valid combination. (*In re Davenport*, C. D., 1804, 658; 110 O. G., 2017; 23 App. D. C., 370; *Gas Machinery Co. v. United Gas Improvement Co.*, 228 Fed. Rep., 684.)

Decision affirmed.

[Court of Appeals of the District of Columbia.]

IN RE UNITED STATES RUBBER COMPANY.

Decided May 3, 1920.

276 O. G., 211; 49 App. D. C., 376; 265 Fed. Rep., 1016.

TRADE-MARKS—PUBLIC INSIGNIA—"U. S." NOT REGISTRABLE.

The meaning of "U. S." is too clearly established to permit of registration of any mark containing it as the most prominent feature in view of the provisions of section 5 of the Trade-Mark Act of 1906, denying registration to any mark which "consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation."

Mr. Chas. S. Jones for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

ROBB, J.:

Appeal from a decision of the Patent Office refusing to register as a trade-mark for shoes the letters "U. S.," written on a disk, with other less conspicuous wording around the border.

Section 5 of the Trade-Mark Act (33 Stat., 724) denies registration to any mark which—

consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation.

We agree with the Patent Office that—

the meaning of "U. S." is too clearly established to permit of registration of any mark having that as the most prominent feature. (*In re Cahn, Belt & Co.*, C. D., 1906, 627; 122 O. G., 354; 27 App. D. C., 173; *in re American Glue Co.*, C. D., 1906, 695; 123 O. G., 999; 27 App. D. C., 391.)

The decision is affirmed.

Affirmed.

[Court of Appeals of the District of Columbia.]

BROWN v. McINTOSH.

Decided May 3, 1920.

276 O. G., 405; 49 App. D. C., 371; 265 Fed. Rep., 1011.

PATENTS—PRIORITY OF INVENTION.

In an interference between Brown and McIntosh priority awarded to McIntosh as being the first to conceive and constructively reduce to practice.

Mr. E. N. Pagelsen for the appellant.

Mr. B. M. Kent, Mr. C. T. Milans, Mr. J. D. Milans, and Mr. S. C. Barnes for the appellee.

ROBB, J.:

Appeal from concurrent decisions of the Patent Office tribunals in an interference proceeding in which priority was awarded the senior party McIntosh. The interference originally involved three parties, Brown, Kritz and McIntosh. Kritz, however, did not appeal from the decision of the Assistant Commissioner.

The invention is a lock-seam channel-tubing especially adaptable to the making of automobile-windshield frames. The second of the two claims of the issue is sufficiently illustrative:

2. A channel tubing comprising a fashioned sheet metal blank having an integral inner channel and uninterrupted outer surrounding portions, the opposite edge portions of said blank meeting in the bottom portion of the channel and being bent to form a lock seam with the thickness of the seam in the space between said channel portion and the outer surrounding portion, and the depth of said channel being materially less than the depth of the outer surrounding portion so as to form a comparatively rigid brace between the said walls thereof.

In the final paragraph of the Assistant Commissioner's decision, he says:

McIntosh was the first to conceive the invention and his application was filed before Brown reduced the invention to practice, either actually or constructively. Being, therefore, the first to conceive the invention and the first to reduce it to practice, he is, under a long line of decisions of this Office and of the Court of Appeals of the District of Columbia, entitled to the award of priority.

We agree with the Patent Office tribunals and therefore affirm the decision of the Assistant Commissioner.

Affirmed.

[Court of Appeals of the District of Columbia.]

MAREMONT v. OLSON.

Decided May 3, 1920.

276 O. G., 406; 49 App. D. C., 369; 265 Fed. Rep., 1009.

MEMORANDUM OPINION.

PATENTS—PRIORITY.

Decision of the Assistant Commissioner of Patents awarding priority of invention to Olson affirmed.

(For Commissioner's decision see ante, 44, 276 O. G., 405.)

Mr. F. M. Phelps for the appellant.

Mr. O. F. Bartel for the appellee.

This is an appeal from a decision of the Patent Office awarding priority in an interference to Nels L. Olson. The matter involved is an auxiliary spring attachable at the opposite ends of the axle-hous-

ing of a Ford automobile, for the purpose of converting a light car into a truck. The invention is set forth in two counts as follows:

1. A spring structure for attachment to a vehicle having axle flanges, comprising a spring supporting yoke having a face portion arranged for attachment to an axle flange, a spring parallel to the yoke face portion, and means securing the spring to the yoke.

2. A spring structure for attachment to a vehicle having axle flanges, comprising a spring supporting yoke having a face portion for attachment to an axle flange and an upstanding portion carrying an extension outstanding at right angles thereto, a spring parallel to the yoke face portion, and means securing the spring to the outstanding portion of the spring supporting yoke.

Maremont filed June 8, 1916; Holland and Wilson filed April 24, 1916, and Olson April 14, same year. Holland and Wilson having taken no testimony cannot prevail, since they filed after Olson. Maremont being junior to Olson, the burden is on him to establish his claim. The three tribunals of the Patent Office unite in holding against him and in awarding priority to Olson. Where this is so, we will not disturb their decision, unless it is clearly wrong, and we find no basis for saying that it is in this case. (*Kennicott v. Caps*, ante, 120; 49 App. D. C., 187; 262 Fed. Rep., 651; *Jobski v. Johnson*, C. D., 1918, 140; 247 O. G., 479; 47 App. D. C., 230; *Bourn v. Hill*, C. D., 1906, 699; 123 O. G., 1284; 27 App. D. C., 291; *Flora v. Powrie*, C. D., 1904, 636; 109 O. G., 2443; 23 App. D. C., 195; *Gammeter v. Thropp*, C. D., 1915, 59; 210 O. G., 1397; 42 App. D. C., 564.) On the contrary, we believe that it is in harmony with right.

The decision of the Assistant Commissioner of Patents is affirmed. Affirmed.

[Court of Appeals of the District of Columbia.]

R. H. MACY & COMPANY v. NEW YORK GROCERY COMPANY.

Decided June 2, 1920.

276 O. G., 596; 50 App. D. C., —; 267 Fed. Rep., 749.

1. TRADE-MARKS—SIMILARITY—"WHITE LILY"—"LILY WHITE"

"White Lily" and "Lily White" are so similar as to be likely to lead to confusion.

2. SAME—SIMILARITY OF GOODS—COFFEE AND TEA.

Registration of the words "White Lily" for coffee canceled in view of the prior use of "Lily White" on tea and other groceries, the goods, although different in themselves, being used for the same purpose.

Mr. E. W. Bradford for the appellant.

Mr. Benj. P. Fishburne for the appellee.

VAN ORSDEL, J.:

This is an appeal from the decision of the Commissioner of Patents denying the petition of appellants for cancelation of the trade-mark

"White Lily" for coffee, registered by appellee company September 18, 1917. Appellants have used "Lily White" as a trade-mark for tea and a large line of groceries since 1895.

The marks are so similar as to be likely to lead to confusion, and the goods, while different in themselves, are used for the same purpose. The case must, therefore, be reversed upon the authority of *Walter Baker & Co. v. Harrison*, (C. D., 1909, 284; 138 O. G., 770; 32 App. D. C., 272.)

The decision of the Commissioner of Patents is reversed, and the clerk is directed to certify these proceedings as by law required.
Reversed.

Dissenting opinion by Chief Justice SMYTH:

The single question in this case as I view it is whether coffee and tea possess the same descriptive properties. Both tribunals of the Patent Office held that they do not. If Macy & Company had originated the mark, they undoubtedly would be entitled to the exclusive use of it, because tea and coffee belong to the same general class; but they did not originate it and therefore to succeed they must establish that the articles possess the same descriptive properties. The mere fact that confusion might result or that the goods are used for the same purpose, is immaterial under the statute. It is only when the marks are "appropriated to merchandise of the same descriptive properties," that the matter of probable confusion becomes important. If the fact that they are used for the same purpose is controlling, then the mark could be extended to milk, or lemonade, or even wine and beer, if they were still on the market. They, as coffee and tea, are beverages. Besides, the statute says nothing about the use to which articles are put, and the court should follow the statute.

Tea as it appears in the container to which the mark is applied, is a dried, rolled leaf. Coffee is a dried seed or berry. The appearance, taste, and odor of the articles are markedly different; tea is strongly astringent, coffee is not. The properties by which the one may be described are not the same as those by which the other may be identified.

The fact that in *Walter Baker Co. Case* (C. D., 1909, 284; 138 O. G., 770; 32 App. D. C., 272) it was held that cocoa and coffee possessed like descriptive properties, does not establish that tea and coffee do.

I think the Patent Office was right, and hence I dissent.

The decision of the Assistant Commissioner reads as follows:

CLAY, Assistant Commissioner.

R. H. Macy & Co. appeal from a ruling of the Examiner of Trade-Mark Interferences refusing the appellant's motion to cancel the registration No. 118,502,

September 18, 1917, to the New York Grocery Company, of a mark consisting of the words "White Lily" and the picture of a white lily, for coffee; Macy & Co. having set up and proven previous use of the trade-mark "Lily White" for tea. The Examiner refused to cancel because he held that tea and coffee were not goods of the same descriptive properties and under the circumstances there was no likelihood of confusion.

The registrant appellee, the New York Grocery Company, says in its brief:

"If Macy & Co. had coined or originated the mark as a trade-mark for goods generally sold over grocers' counters and had built up their business about that mark so that purchasers would naturally consider such goods to be the product of Macy & Co., the registrant would concede that they were entitled to wide latitude in determining what fell within the natural expansion of their business; *but such is not the case*. The record in this case shows that as early as 1874 this identical mark was registered for flour and that marks practically identical therewith have since been registered for many articles sold over grocers' counters." (See footnote.)

The case is not without difficulty on account of this fact that Macy & Co. were never entitled to broadly monopolize their mark, as in the case where one originates a new device having no meaning until the trader, by his own usage, gave it a meaning. The case cannot turn solely upon any definite ruling as to whether tea and coffee are goods of the same descriptive properties, for this phrase, "goods of the same descriptive properties" has a very elastic and uncertain meaning, depending, in each case, upon the circumstances.

Section 5 of the trade-mark law refers at first to "goods of the same class"; then, in specifying what marks may be refused registration, it uses the expression "same descriptive properties." Section 13, which provides for cancellation proceedings, uses neither expression, but refers broadly to the question whether the registrant "was entitled to the use" of the mark at the date of his application for registration. This, of course, means such exclusive use, of such goods, and in such a way, as would not have illegally interfered with the business of Macy & Co. That is, the registrant's mark should not be canceled unless at the time it applied for registration in 1917, Macy & Co. were another party who had acquired the right to use this mark in this trade. The difficulty in this case as in many other cases, arises from the uncertainty as to what must be considered to be the trade in question, and the bearing on that question of the scope of Macy & Co.'s previous trade-mark rights. If Macy & Co. had adopted for a particular line of groceries a newly originated trade-mark (such as "Kodak" or "Mazda") I have no doubt they would have had the right to expand the use widely, and to keep other traders from using that mark on any line of goods which the public might be at all likely to suppose to have originated with Macy & Co. Some of the English cases have even gone further than that, and have enjoined a bicycle manufacturer from calling his bicycles by the name "Kodak" at the suit of the owner of the trade-mark "Kodak" for cameras, (*Eastman Co. v. Kodak Bicycle Co.*, 15 Rpts., Pat. Cas., 105.)

This is farther than any of our courts have gone; and it should be noted that in that case the defendant used the name "Kodak" as part of its corporate name, and this would allow this company to cause confusion between it and the plaintiff company. Our courts have, however, clearly indicated that the essential question is whether one dealer has gotten himself in a position where he might palm off his goods as those of another. In *Aunt Jemima's Mills Co. v. Rigby & Co.* (247 Fed. Rep., 407) the court dealt with the trade-mark "Aunt Jemima" which had been adopted for flour. It was also the name of the plaintiffs, but it said, "obviously the public, or a large part of it, seeing this

trade-mark on a syrup, would conclude that it was made by the complainant; perhaps they might not do so if it were used for flat-irons. In this way the complainant's reputation is put in the hands of the defendants. It will enable them to get the benefit of the complainant's reputation and advertisement," (p. 410.) Of course, the court does not say syrup and flour are goods of the same descriptive properties, and of course there is no possibility of a man's being sold syrup when he wants flour. But the case illustrates the point that a new and original trade-mark must be treated very differently from a trade-mark which is generally old and well known and is only new in the association with a particular goods, such for instance as the word "Star," which has long been used as a trade-mark for hundreds of articles. (It should be noticed that the case of *Laurence v. Dowden Co.*, 178 Fed. Rep., 73, cited by the appellant, and wherein tooth-brushes and clothes-brushes were held goods of the same descriptive properties, was not a trade-mark case at all.)

There are many cases, as *Anglo-American Co. v. General Electric Co.* (C. D., 1915, 134; 215 O. G., 325; 43 App. D. C., 385,) where the right of a later trader to apply a known trade-mark to other goods was denied because "their general qualities or characteristics were so nearly identical (with the previous goods) that the vending of each by two rival manufacturers under the same trade-mark would be likely to cause confusion, to the injury of the one first to adopt the mark and to the general public." The question of course was not whether one would purchase a Mazda gas-mantle in the belief that he was purchasing a Mazda electric lamp, but was whether there would be confusion as to the origin of these different articles; that is, whether the purchaser might buy the gas-mantle in the belief that it came from the same source from which he had known the electric lamps to come, whereby the trader in gas-mantles would profit by the reputation of the owner of the Mazda electric lamp trade-mark. In all cases where this principle has been applied I think it will be found that the mark in question was an original mark—one which before was unknown in the meaning it now has. If, for example, the electric-lamp maker's trade-mark had in the last cited case been "Excelsior," I doubt whether he could have prevented the registration of "Excelsior" to another for gas-mantles, because "Excelsior" has an innate meaning, and the public is accustomed to seeing that mark for various articles, and has been educated to make distinctions with respect to it.

In the present case the name of the picture of a lily had, probably because it is the symbol of purity, been previously used by various traders. Among other things, it had been applied to lard, meat, flour, codfish, etc., before Macy & Co. adopted it for anything. Each of these previous traders had a right confined to a more or less narrow field. Macy & Co. had no room to adopt the mark for any very broad field. When they adopted it for pork and beans for instance, they did not thereby acquire the right to extend to canned meat, and when they adopted it for macaroni, they could not expand to flour. They adopted it for oyster-cocktail sauce, chili sauce, mock-turtle soup, and even clam-chowder, in the face of the previous use and registration for canned codfish. When they adopted it for tea, this was in the face of the use and previous registration of the term "Gold Lily" and the picture of a lily, for tea, (No. 17,547. Feb. 18, 1890.) The real question is then this: when one adopts a well-known and much-used symbol as a trade-mark for particular goods, after other traders have used it for other particular goods of the same general class, how broadly can he claim the right to exclude others from thereafter adopting the symbol for other particular goods of the same general category? Obviously he is not in the same position as one with an invented or originally pre-empted mark. He is not in a position to complain of the use of the mark by others on

any goods whatever which the public might suppose to have originated with him; for he has himself adopted the mark for goods which might well have been supposed to have originated with the previous users. The registrant in his brief very pertinently asks:

"Is it any more within the natural expansion of the business of Macy & Co. to extend the use of this mark to coffee than it is within the natural expansion of the business of any of these other parties? Would a purchaser, seeing a can of White Lily coffee, a can of Lane-Libbey's [White Lily] codfish, a sack of Thornton & Chester's White Lily flour, a can of Dunlevy's White Lily lard and a can of Macy's Lily White tomatoes upon a grocer's shelf be any more justified in concluding the coffee to be Macy's product than he would in concluding it to be the product of one of the other parties named?"

In cases of this sort there seems to be no escape from the necessity of speculating as to what the public would think under the circumstances. It has long been customary with this Office to regard tea and coffee as goods of different descriptive properties, in view of the fact that coffee is generally known to have originated from widely different sources and to be produced by widely different processes, and it has been a general custom to place different marks upon them. If the question were one of possible confusion of goods, there would be no difficulty; but this is a case of possible confusion of reputations, which is another thing. To justify the cancellation prayed for it must be held that in 1917, Macy & Co. had the right to apply their "Lily White" mark to coffee, and moreover, that it was an injury to them when it was applied to coffee and registered by another. The damage to Macy & Co., moreover, must be a damage due to an invasion of their right, and not merely a damage due to the fact that they adopted a mark which was not capable of covering a broad field; evidently not capable of covering everything on the grocer's shelf.

While this mark has been registered over twenty times, not only for canned groceries, but for everything from medicines to hosiery, and from whetstones to gas-engines, (see foot-note.)* and while since the use by Macy & Co. began, it has been used apparently without objection for such things as cocoa, (Zechnowitz, No. 118,610;) and while Macy & Co. appear to have used it for tea for twenty odd years, they yet never used it on their coffee, which was one of the principal lines of goods upon which they based their reputation. It is open to question whether Macy & Co. may not by laches have lost the right to object to others using a similar mark on coffee, especially since the registrant, New York Grocery Co., claims to have used the mark some fifteen years and its file shows that there was no opposition to its registration, and furthermore shows that a previous registration of the same mark for coffee (Zechnowitz, No. 80,014, Oct. 25, 1910) was canceled upon the admission of Zechnowitz that the registrant, New York Grocery Co., was the first user. There was apparently no objection by Macy & Co. to the registration for coffee or for cocoa. They themselves apparently have never registered the mark for any beverage whatever.

In view of this showing that Macy & Co. were never entitled to occupy any but a narrow field with their trade-mark "Lily White," and in view of their apparent acquiescence in the well established custom, both in the trade and in this Office, of considering tea and coffee to be goods of different descriptive properties, I can have no hesitancy in sustaining the Examiner and refusing

* The registered marks referred to are the following: Lily White W. C. Co., 18,869, Jan. 20, 1891, (washing compound); Dunlevy & Bro., 20,631, Jan. 26, 1892, (lard); Pike Mfg. Co., 23,448, Aug. 1, 1893, (whetstones); Dunlevy & Bro., 40,452, May 26, 1903, (meats); Thornton & Chester M. Co., 45,938, May 5, 1905, (flour); F. T. Hopkins, 51,813, Apr. 17, 1906, (face powder—since 1850); White Lily Waaber Co., 56,293, Sept. 4, 1906, (gas-engines); Lane-Libbey Fishing Co., 73,620, Apr. 27, 1909, (cured codfish); Townsend & Co., 83,449, Sept. 12, 1911 (hosiery.)

to cancel the mark of the New York Grocery. I have noted the decision of the Court of Appeals of the District of Columbia in the case of *Walter Baker & Co. v. Harrison*, (C. D., 1909, 284; 138 O. G., 770; 32 App. D. C., 272; Dec. 22, 1908,) where coffee and cocoa were said to be goods of the same descriptive properties. This Office is of course bound to follow the decisions of that court; but I do not consider that that decision in any way settled the question now before me. In that case the Patent Office had dismissed on demurrer an opposition to registration of a trade-mark for coffee consisting of the picture of a Quaker woman carrying a cup on a waiter, on the ground that coffee was goods not of the same descriptive properties as cocoa, and the opposer had used substantially the same picture for a great many years for cocoa. The court found the marks "substantially the same design" and said it should have been left open to proof, as to whether the goods were so similar as to create confusion. The court was undoubtedly much impressed with the apparent attempt of the applicant for registration to profit by the reputation of the older user. It cited a case in which there was a plain attempt at piracy, Ames & Sons attempting to sell shovels in Australia under the name of "Collins & Co.," who had a well established reputation for edged tools.

The party who later adopted the picture of a Quaker woman for coffee had no reason for doing so except to profit by the reputation of Baker & Co. It was clearly not a case to be dismissed without proofs, particularly when the court was "forced to the conclusion that the appellee had some sinister motive in seeking to register this mark." If, however, the court had had before it a case in which the picture of a Quaker woman carrying a cup on a waiter had been used by others before Baker & Co. adopted it, as a trade-mark, let us say, for tea; and if furthermore it had been a mark which was very common for various goods because of its innate significance; then I am satisfied the decision would have been different. Indeed, in the later case of *Nestlé & Anglo-Swiss Co. v. Baker & Co.* (C. D., 1911, 369; 167 O. G., 765; 37 App. D. C., 148) this court itself drew the distinction between an originator and a copier of a device used as a trade-mark, though it was there discussing the confusion of the marks themselves rather than confusion of the fields occupied by the marks. In short, I am satisfied that the court will determine whether two given lines of goods are "goods of the same class" or "goods of the same descriptive properties," as depending largely upon the scope of the trade-mark right of the previous user, and also upon the innate meaning, or lack of innate meaning of the trade-mark itself.

I conclude that the New York Grocery Company had the right to appropriate its mark "White Lily" for coffee at the time of its application for registration, and therefore affirm the decision of the examiner.

[Court of Appeals of the District of Columbia.]

IN RE SCHOLL MANUFACTURING COMPANY, INC.

Decided June 2, 1920.

276 O. G., 599; 50 App. D. C., —; 267 Fed. Rep., 348.

1. TRADE-MARKS—DESCRIPTIVE REPRESENTATION OF ARCH-SUPPORT.

A mark for instep-supports consisting of a representation of the outline of a shoe broken away at the bottom and disclosing at the portion broken away an arch-support supported by the thumb, index and middle fingers of

a hand, *Held* merely descriptive; *Held* also that even if it were permissible to disclaim the representation of the arch-support it would still be descriptive.

2. SAME—REGISTRABILITY—DISCLAIMER OF INTEGRAL PART OF MARK NOT PERMISSIBLE.

Registration of a mark for instep-supports consisting of a representation of the outline of a shoe broken away at the bottom and disclosing at the portion broken away an arch-support supported by the thumb, index and middle fingers of a hand, *Held* not registrable upon disclaimer of the representation of the arch-support, because what is left would not be the mark which had been used and because the remaining part of the mark is also descriptive.

3. SAME—EVIDENCE OF EXTENSIVE USE NOT PERTINENT ON QUESTION OF DESCRIPTIVENESS.

Evidence of extensive use of a mark or that several traders have not heard of its use by others does not tend to prove in the least that it is not descriptive.

Mr. J. H. Milans and *Mr. C. T. Milans* for the appellant.

Mr. T. A. Hostetler for the Commissioner of Patents.

SMYTH, C. J.:

Scholl applied to have registered as a trade-mark for instep-supports a drawing of which this is a copy:



He alleged use of the mark from 1912. In the statement accompanying the application he said that he made no claim to the representation of the arch-support. The application was rejected on the ground that the mark was a descriptive device. The trade-mark statute (33 Stat. L., 725, chap. 592, sec. 5) declares that—

no mark which consists merely in words or devices which are descriptive of the goods with which they are used—

shall be registered. The mark of the applicant is a device and is merely descriptive. We agree with the Examiner of Trade-Marks and Designs that it is—

an apt and convenient way of describing the characteristics of the arch support and of the benefits to be derived from using the same, and it would be most

natural for other manufacturers to use or want to use the same sort of picture to describe or advertise a similar mark.

The disclaimer does not help the applicant, for two reasons: (1) What would remain after the representation of the arch-support had been removed would not be the mark which he had used on his goods, but only a part of it. It would be a different mark—one that he had not used, and hence he would not be entitled to register it. (*Id.*, sec. 1.) (2) Even if that were not so, the remaining part would “still inform the beholder,” as the Assistant Commissioner ruled, “that the goods so marked were supports for the instep,” and hence would be descriptive.

It is immaterial that the device has been extensively used by the applicant, or that several traders have not heard of its being used by others, for these things do not tend to prove, even in the least, that it is not descriptive. Being descriptive, the statute forbids its registration.

The decision of the Commissioner of Patents is affirmed.
Affirmed.

[Court of Appeals of the District of Columbia.]

DU RELL *v.* HALEY.

Decided June 2, 1920.

276 O. G., 778; 50 App. D. C., —; 267 Fed. Rep., 351.

PATENTS—INTERFERENCE—DILIGENCE LACKING.

Evidence considered and *Held* that Du Rell's early experiments did not amount to a reduction to practice and that as he did nothing thereafter for almost two years, while in the meantime Haley reduced the invention to practice, Haley is entitled to an award of priority.

(*For Commissioner's decision see ante, 53; 276 O. G., 776.*)

Mr. T. K. Bryant for the appellant.

Mr. Dean S. Edmonds and *Mr. J. B. Hull* for the appellee.

ROBB, J.:

Appeal from concurrent decisions of the Patent Office tribunals in an interference proceeding in which priority was awarded the junior party.

The invention involves a process and apparatus for concentration of ores. The claims are twelve in number but it is unnecessary to repeat them here. Each of the Patent Office tribunals has held that appellant's early efforts did not amount to reduction to practice and that, as he did nothing thereafter for almost two years and appellee entered the field meanwhile, he was lacking in diligence.

Each of those tribunals has carefully and satisfactorily discussed the evidence in behalf of appellant, and for the reasons stated by them we affirm the decision from which this appeal was taken.

Affirmed.

[Court of Appeals of the District of Columbia.]

GAMMETER v. BACKDAHL.

Decided June 2, 1920.

276 O. G., 778; 50 App. D. C., —; 267 Fed. Rep., 347.

PATENTS—PRIORITY—DILIGENCE.

In considering the bearing of experiments made to perfect an invention on the question of diligence the test is not whether such experiments led to anything as far as benefiting the public is concerned, but whether such tests were so unnecessary as to constitute evidence of bad faith. An inventor is to be commended rather than condemned for taking reasonable time to perfect his invention. (*Griffin v. Swenson*, C. D., 1899, 440; 89 O. G., 919; 15 App. D. C., 135.)

Mr. H. A. Dodge and *Mr. R. M. Pierson* for the appellant.

Mr. W. Lee Helms and *Mr. Chas. S. Jones* for the appellee.

ROBB, J.:

Appeal from a decision of an Assistant Commissioner of Patents in an interference proceeding awarding priority to the senior party Backdahl. The invention relates to mandrels or cores for the formation and curing of pneumatic tires. Counts 1, 3, and 6 are sufficiently illustrative of the six counts of the issue and are here reproduced:

1. A fluid tight, hollow, stretchable, metallic mandrel.
3. A tire-making mandrel comprising a fluid-tight, hollow, lead annulus provided with an inlet for introducing an expanding fluid.
6. A tire-making mandrel comprising an inner rigid metallic ring adapted to fit between the halves of a tire mold, and an outer, annular, hollow, lead mandrel-body thereon, provided with a fluid inlet pipe extending through said ring.

Backdahl is restricted to his filing date of December 14, 1915, for conception, disclosure and constructive reduction to practice.

Each of the Patent Office tribunals has found, and the evidence fully supports the finding, that Gammeter conceived and disclosed the invention September 7, 1915. The evidence clearly shows that from that time until the early part of June, 1916, he was endeavoring to evolve a fluid-tight and expansible lead core adapted to produce a cord tire as well as a fabric tire. A core that would produce either would be within the issue. The application drawings were com-

menced the latter part of May and completed late in June, when they were turned over to a patent attorney, who was very busy at the time and later took a vacation extending over a month. There was further activity on the part of Gammeter in August of 1916 and the application was filed on November 8th, following.

The Examiner of Interferences and the Board of Examiners-in-Chief held that Gammeter was diligent at the time Backdahl entered the field and reasonably diligent from that time until the filing of his application. The Assistant Commissioner disagreed with this finding and therefore reversed the decisions of the lower tribunals.

Where, as here, it clearly appears that the party first to conceive the invention was in good faith engaged in perfecting it at the time his adversary entered the field, that party should not be deprived of the fruits of his discovery because his efforts were not as successful as he hoped they would be. The Assistant Commissioner reached the conclusion that Gammeter's further—

experiments lead to nothing so far as benefitting the public goes,

but that is not the test. The question is whether further tests were so unnecessary as to constitute evidence of negligence or bad faith. Many times we have stated that an inventor is to be commended rather than condemned for taking reasonable time to perfect his invention,

to prevent the Patent Office from being overloaded with applications for patents for crude and incomplete devices. (*Griffin v. Swenson*, C. D., 1899, 440; 89 O. G., 919; 15 App. D. C., 135.)

For the reasons stated by the Examiner of Interferences and the Board of Examiners-in-Chief, we are clearly of the view that Gammeter was not lacking in diligence. We are satisfied from the evidence that from the date of disclosure to the time his application was filed he was proceeding with reasonable diligence to perfect and patent his invention. As stated in *Woods v. Poor*, (C. D., 1907, 651; 130 O. G., 1313; 29 App. D. C., 397,) there is no arbitrary rule or standard by which diligence may be measured, and each case must be considered and decided in the light of surrounding circumstances.

Being fully convinced of Gammeter's good faith, we reverse the decision of the Assistant Commissioner and award priority to him.
Reversed.

The decision of the Assistant Commissioner reads as follows:

CLAY, *Assistant Commissioner*:

Backdahl appeals from the affirmance by the Examiners-in-Chief of an award of priority to the junior party Gammeter, on an invention broadly defined as follows:

"1. A fluid-tight, hollow, stretchable, metallic mandrel.

"3. A tire-making mandrel comprising a fluid-tight, hollow, lead annulus provided with an inlet for introducing an expanded fluid.

"5. A tire-making mandrel comprising a rigid metallic tongue-ring divided circumferentially into segments, and an expansible, hollow, lead mandrel-body seated thereon."

Gammeter filed application nearly a year after Backdahl, but is shown to have had a conception of the invention prior to Backdahl's filing date, whereas Backdahl is confined to his filing date, having made his invention abroad. There seems to be no question that Gammeter disclosed his invention in September, 1915, over two months before Backdahl's date of constructive reduction to practice; but Backdahl insists that Gammeter was not diligent in perfecting his invention. Careful attention to the nature of the invention is necessary to determine this matter.

The invention Gammeter discloses is simply a lead pipe used as an expansible mandrel in a mold for vulcanizing tire casings, that is, "a core or mandrel of sufficient rigidity to enable the article to be formed thereover, but also capable of being stretched by fluid pressure to expand the formed article and press it against a mold * * *." He shows and describes a coil of ordinary lead pipe with a turn sawed off, its ends soldered together and an inlet tube soldered into it. It is set in the trough on the outside of the sectional tongue ring held by clamps and assembled between the halves of a mold. On being expanded in the mold to give it a smooth surface and the proper size, it is ready for use to build up a tire casing thereon in the usual way, after which the tire and lead mandrel and supporting ring are placed in a vulcanizing mold and the casing stretched and properly held for the purpose of vulcanizing. Afterward the lead of the pipe is remelted and used over again. Nothing is said about the thickness of the pipe or any particular form of it, and Gammeter claimed in the broadest terms, a hollow lead mandrel. There was also claimed the method of making the lead mandrel by sawing and joining rings from a coil of pipe as above described, but these latter claims were dropped. It will be noticed that the invention has nothing to do with the manufacture of lead piping, nor anything to do with any particular form of lead pipe or mandrel.

The process of invention probably always includes the steps of conception of a function, conception of a general way to accomplish the function, designing and adapting means to accomplish the function; and finally testing these means to prove both that the function may be attained and that the means chosen are capable of attaining it; in other words, that the thing will work. This is one continuous mental process from conception to testing, and with rare exceptions an invention is not complete until the thing is proven by test, though this last step the law presumes to be accomplished by the filing of an allowable application for patent. After Gammeter's conception of a hollow expansible metal mandrel, rigid enough to build on, and made of lead so that it will be both rigid and expansible, and after he had conceived a way of making the lead tube, he still had to prove that it would work as a mandrel for curing tires. Instead of making a tube and trying it out, as the evidence shows he could easily have done, without any more ado, he went to work on quite a different problem—namely, to devise a new use for such a mandrel. That is, he was going to make a form of mandrel which was adapted to a peculiar form of support in order that it might be used in making a peculiar kind of tire. As to the hollow lead mandrel for tire molds generally, he did nothing. He experimented for over a year, but when all his experimenting was done he was exactly where he started, so far as concerns the invention of a hollow lead mandrel for tire molds, and

he had not yet tried to prove that this thing would work. He filed his application finally, still relying upon the theoretical working and upon the constructive reduction to practice. That is, from about the middle of September, 1915, until November 8, 1916, Gammeter was making unsuccessful attempts, first to cast a lead mandrel in a mold, and then to make one by squirting molten lead through a specially formed pipe, both of which attempts were for the purpose of providing a specially formed groove and thickened portion on the inside of the lead tube, as shown in Gammeter's sketch, Exhibit Z, and in the photograph, Exhibit K. The main part of the work was in designing and building the die shown in his Exhibit L. It is fair to notice that Gammeter was a busy man in a responsible position as an experimental engineer, for a large company and that his attorney, who delayed filing his application over four months, was a busy attorney with many cases to attend to.

In Gammeter's brief it is said that "There is no evidence of any intention on the part of Gammeter to abandon the invention." Considering what the invention was I am not satisfied with this statement of fact; but however that may be, it is hardly a statement of the proper mental attitude toward the question of diligence. The burden was upon Gammeter, not merely to negative a charge of laches, but to positively show diligence. (*Watson v. Thomas*, C. D., 1908, 370; 106 O. G., 1776.) The burden was on him to connect his conception with his final reduction to practice by a course of activity which, as the court said in *Twentieth Century Machinery Co. v. Loew Mfg. Co.*, (243 Fed. Rep., 373, at page 384,) "must consist of a degree of effort that can fairly be characterized as 'substantially one continuous act,'" and that act must be the act of inventing "a fluid-tight, hollow, stretchable, metallic mandrel"—not inventing a particular form of lead pipe from which a special mandrel may be constructed for a particular purpose. After December 14, 1915, when Backdahl reduced to practice, nothing Gammeter could do could make him the inventor. He must have been the inventor from a time running back of this and reaching forward until nearly a year later when he filed his own application. "Diligence is of the essence of a proper relation between the conception and the reduction to practice of an invention." As illustrating this fact it has frequently been held that business convenience and the working out of auxiliary devices to make the invention more commercial and efficient will not excuse the delay. (*Stapleton v. Kinney*, C. D., 1901, 414; 96 O. G., 1432.) Nor is delay excusable when caused by the inventor's building a plant and the machinery with which to make use of the invention, especially when his application was finally filed without making any test. (*Slick v. Hansen*, C. D., 1912, 551; 181 O. G., 1076; 39 App. D. C., 131.) Again, "it has been repeatedly held that work upon one form of a device cannot be considered as diligence in the reduction to practice of another form." (*Taylor v. Gilman*, C. D., 1910, 167; 158 O. G. 883.) As to the part of the delay due to the attorney, it is not to be excused merely because he was busy or on a vacation. (*Briggs v. Lillie v. Cooke v. Jones & Taylor*, C. D., 1905, 168; 116 O. G., 871.)

If there was something in Gammeter's disclosure by which the public could benefit from the experiments he made on the special form of mandrel for use with a cord tire, his case would have more equity. But as a matter of fact his disclosure is just what it would have been if he had filed his application in September, 1915. What he was experimenting with was a further improvement subsidiary to the invention in issue, and this improvement he neither at any time reduced to practice nor disclosed when he came finally after the experiments to file an application for patent. His experiments led to nothing so far as benefiting the public goes.

It is in evidence that Gammeter had every facility for making a test of his invention at the beginning. He could have obtained in commerce, ready made, a lead pipe exactly as disclosed in his application and he could have made a test of the workability of the invention within a few days. Also he could have filed his application promptly.

The form of the invention as disclosed by Backdahl seems to have been somewhat more highly developed. He proposed a mandrel partly of iron and partly of lead, the skin or "mantle" of lead, 19' in Fig. 5 being made of a complete flattened lead pipe, supported on an iron ring 1 and the convex half of it extended in the female mold 16. In the form of Fig. 4 the lead pipe is split and drawn over the iron mandrel and its edges clamped by rings 20; the fluid for expansion being introduced between the iron mandrel and the lead skin.

Under these circumstances, and especially considering that the public did not benefit from the experimenting done by Gammeter after his complete conception and disclosure in September, 1915, I must conclude that it was error, in view of the decisions of the court, to hold Gammeter has proven himself diligent as against Backdahl who was the first to reduce to practice. In the case of *O'Connell v. Schmidt* (C. D., 1906, 662; 122 O. G., 2065; 27 App. D. C., 77,) the court was liberal on the question of diligence, not only because the delay was short and well excused, but because O'Connell had built a model; had done something tangible and beneficial, and had virtually proved his invention and put it in such condition that if the inventor had died, his invention would nevertheless have survived. The present is a very different case from that, and from the case of *Woods v. Poor*, (C. D., 1907, 651; 130 O. G., 1313; 29 App. D. C., 397.) In the case of *Courson v. O'Connor* (C. D., 1916, 250; 224 O. G., 1057; 227 Fed. Rep., 890) there was only a delay of three months, and this, it will be noticed, was after an actual reduction to practice.

The decision of the Examiners-in-Chief is reversed, and priority awarded to the senior party, Backdahl.

[Court of Appeals of the District of Columbia.]

GRUS, JR., v. EYNON.

Decided June 2, 1920.

276 O. G., 780; 50 App. D. C., —; 287 Fed. Rep., 850.

PATENTS—INTERFERENCE—PRIORITY.

Evidence considered and *Held* that priority of invention was properly awarded to Eynon.

(*For Commissioner's decision see ante, 49; 276 O. G., 775.*)

Mr. Frank T. Brown and Mr. C. M. Nissen for the appellant.

Mr. J. B. Hull for the appellee.

ROBB, J.:

Appeal from concurrent decisions of the Patent Office tribunals in an interference proceeding awarding priority to the senior party. The invention relates to automobile-leaf-spring lubricators. The issue is stated in five counts, of which the second will serve as an example:

2. In a leaf spring lubricator, a pad of absorbent material, a casing fitting over the absorbent material having a recess in its bottom and a perimetric wall, and

means for pressing the casing against the edges of the leaves of a spring to compress the pad of its edges more than in the center.

The Patent Office tribunals have very carefully reviewed the evidence and found that appellant has not sustained the burden of proof. As we fully agree with the conclusion reached, we deem it unnecessary further to discuss the evidence, and accordingly affirm the decision.

Affirmed.

[Court of Appeals of the District of Columbia.]

FRENCH BATTERY & CARBON COMPANY v. THE PREST-O-LITE COMPANY, INC. THE PREST-O-LITE COMPANY, INC., v. FRENCH BATTERY & CARBON COMPANY.

Decided May 3, 1920.

277 O. G., 182; 49 App. D. C., 373; 265 Fed. Rep., 1018.

1. TRADE-MARKS—SIMILARITY—"RAY-O-LITE" AND "PREST-O-LITE."

The word "Ray-O-Lite," for storage batteries, *Held* not registrable in view of the prior use of "Prest-O-Lite" on the same goods.

2. SAME—SAME—SAME—REGISTRATION BY OTHERS OF SIMILAR MARKS.

Held that "Ray-O-Lite" may be registered for electric lamps notwithstanding the prior use by the opposer of "Prest-O-Lite" on storage batteries where other marks about as near to "Prest-O-Lite" as is "Ray-O-Lite" had been registered by others for electric lamps prior to its use by the opposer for storage batteries.

Mr. D. B. Cheever for the appellant.

Mr. E. W. Bradford for the appellee.

ROBB, J.:

These appeals are from a decision of the Patent Office sustaining the opposition of the Prest-O-Lite Company, Inc., to the registration by the French Battery & Carbon Company of the words "Ray-O-Lite," in connection with the sale of storage batteries, and permitting such registration as to electric lamps. The French Battery & Carbon Company appeals from the former ruling, while the Prest-O-Lite Company, Inc., appeals from the latter.

When "Ray-O-Lite" was adopted in 1917, "Prest-O-Lite" had been in extensive use on storage batteries by the Prest-O-Lite Company, Inc., for several years, and many thousands of dollars had been expended in advertising these batteries. We agree with the Commissioner that the registration of "Ray-O-Lite" for use on storage batteries would be likely to cause confusion. (*Thomas Mfg. Co. v. Aeolian Co.*, C. D. 1918, 157; 249 O. G., 505; 47 App. D. C., 376.) But since it appears that before the Prest-O-Lite Company extended its business to include storage batteries, other concerns had

registered marks for electric lamps which, as found by the Commissioner, "are about as near to Prest-O-Lite as is Ray-O-Lite," we also agree with the Commissioner that the Prest-O-Lite Company is not in a position to prevent the registration of "Ray-O-Lite" for use on electric lamps. (*Alaska Packers Assoc. v. Admiralty Trading Co.*, C. D. 1915, 117; 214 O. G., 1025; 43 App. D. C., 198.)

The decision of the Commissioner is affirmed.

Affirmed.

[Court of Appeals of the District of Columbia.]

IN RE ZENK.

Decided June 2. 1920.

277 O. G., 183; 50 App. D. C., —; 267 Fed. Rep., 327.

PATENTS—DOUBLE PATENTING—PROCESS AND PRODUCT.

A patent for a commutator comprising metal commutator-bars and a body of heat-hardened resinous condensation product holding said bars in place is not a bar to the allowance to the same inventor of a patent for the process of producing the article, involving the conception of softening the moldable material, positioning the bars radially and longitudinally, and forming a complete insulating-body simultaneously under heat and pressure, which was foreign to the processes of the prior art.

Mr. E. B. H. Tower, Jr., and Mr. R. O. Hinkle for the appellant.
Mr. T. A. Hostetler for the Commissioner of Patents.

VAN ORSDEL, J.:

This appeal is from the decision of the Commissioner of Patents rejecting the application of appellant Zenk for a patent for a mold and method or process of making commutators for electric generators and motors. Of the seven claims, the following three are illustrative:

1. The method of making a commutator which consists in arranging commutator segment bars circumferentially in spaced relations, surrounding certain sides of said bars with insulating material having the property of hardening under the action of heat and pressure, and applying heat and pressure to harden said material and unite it into a solid body for insulating the bars and holding them together.

6. The method of making a commutator which consists in arranging commutator segment bars circumferentially in spaced relation with a strip of insulating material between each of the bars, surrounding the inner edges and ends of the bars with an insulating material having the property of hardening under the action of heat and pressure, and applying heat and pressure to harden said material into a body which insulates said bars and firmly holds them in position.

7. A commutator mold comprising an annular outer shell having spaced notches in its inner periphery for receiving strips of insulation, an inner shell having notches therein for receiving the inner edges of commutator segment

bars, the outer edges of said bars being received between the strips of insulating material positioned on the inner periphery of the outer shell, and means for supporting said shells and holding them in position so that the spaces between the commutator bars may be filled with insulating material and heat and pressure applied thereto.

In the prior art commutators were constructed of circumferentially-arranged bars or segments supported by strips of insulation and held together by clamping-rings or bolts or screws. Appellant was the first to successfully produce a purely molded commutator wherein the molded insulating material served both to insulate and hold the bars in place, dispensing entirely with mechanical support.

A patent was granted for the article produced, and the present application is confined to the process and mold. The scope of the claims of the patent, as affecting the present application, is stated by the Assistant Commissioner in his opinion, as follows:

Applicant has been allowed a patent, No. 1,255,681, on the article. Claim 1 of the patent, which was granted on the application of which the present application is a division, reads as follows:

"1. A commutator comprising metal commutator bars and a body of heat hardened resinous condensation product holding said bars in place."

Claim 4 includes the limitation that the body of resinous condensation product is molded about the bars.

These claims were allowed in view of evidence presented that no one prior to this applicant had been able to make a successful molded commutator, and that there was therefore invention in using a resinous condensation product specifically, "bakelite," as the insulating material.

We think the allowance of these claims in the Patent Office does not foreclose appellant from making the present method or process claims, unless barred by the prior art. We are of opinion that appellant's mold contains nothing patentable over the prior art. As held by the Assistant Commissioner:

Claim 7 is for the commutator mold and the only feature of this claim not found in the mold of Lundell (September 8, 1891) is the slots in the inner and outer shell by which the commutator segments are held in position. As pointed out by the Examiners-in-Chief the slots shown in the patent to Lorimer (March 5, 1912) perform the same function as is performed by applicant's slots.

Therefore, claim 7 should be disallowed; but as to the process claims, we feel constrained to differ from the holding of the Patent Office. The present application was a division of, and was copending with, the application which resulted in the patent for the article. The patent is, therefore, not a bar even if the method or process was disclosed, inasmuch as it was not claimed. (*The Suffolk Co. v. Hayden*, 3 Wall., 315; *Ide v. Trorlicht Carpet Co.*, 115 Fed. Rep., 137.)

The mere fact that the process and product claims might have been consolidated in a single patent furnishes no ground for the rejection

of the process claims. Separate patents may be issued for the product and the process.

A single exercise of the inventive faculties may produce both a process and its product, a machine and the manufacture it creates, a composition of matter and the art by which it is applied to its intended use. In all such cases, if the inventions are truly separable, the inventor is entitled to a monopoly for each, although neither could have been discovered and been made available without the other. A patent for but one, though it may necessarily describe the other, is thus no hindrance to an application for a patent for the unsecured invention; but the new application must be judged according to its own intrinsic merits, as if no previous patent had been granted. (Rob. on Pats., sec. 466.)

Leaving out of consideration the product patent, and considering the process claims independently, we are of opinion that this feature of the invention is not anticipated in the prior art. Appellant's process produced the first successful molded commutator. The success over the prior art consisted in producing a commutator which would withstand the rigorous use required of it without the support of rings, bolts or screws. This was accomplished by the novel method of manufacture devised by appellant. After the assembled bars and rings in which the bars are circumferentially spaced are placed in the mold, "powdered 'bakelite'" is forced "into the crevices and recesses of the mold." When this is completed, the mold is subjected simultaneously to pressure and a high degree of heat, resulting in the softening of the moldable material, the accurate positioning of the bars and the forcing of the moldable material into a compact solid "body which insulates said bars and firmly holds them in position." The basis of the Commissioner's disallowance of the process claims is stated in his opinion as follows:

Claims 1 to 6 cover a process of making a commutator. Claim 7 is for the mold used in making this commutator. Claims 1 to 5 differentiate from the patent to Lundell only by the statement that the insulating material which is placed between the segment bars has the property of hardening under heat and pressure and that the heat and pressure are applied to harden this material.

It is this step in the process which, we think, constitutes invention.

Coming to the references, the Lieb patent of September 2, 1890, discloses a process in which the insulating material is first prepared "as a fluid, a plastic, or a semi-plastic mass," and when the bars are spaced—

the insulating material is allowed to flow in or is pressed in to the interior of the ring of bars.

It will be observed that the conception of softening the moldable material, positioning the bars radially and longitudinally, and forming a complete insulating-body simultaneously under heat and pressure, was totally foreign to Lieb.

The disclosure of Lundell is still more remote. When he has the sections or segments arranged in the form of a ring, the ring is forced into a receptacle, when, as he states—

having thus arranged the several parts, I pour into the annular space a suitable insulating material, which, on cooling or drying, becomes hard.

He had no conception of accomplishing the result by simultaneous heat and pressure.

While the question of patentability is not entirely free from doubt, we are disposed, in accordance with our rule in such cases, to resolve the doubt in favor of the inventor.

The decision of the Commissioner of Patents is affirmed as to count 7, and reversed as to counts 1 to 6, inclusive, and the clerk is directed to certify these proceedings as by law required.

Affirmed as to count 7, and reversed as to counts 1 to 6, inclusive.

[Court of Appeals of the District of Columbia.]

PEMBROKE v. SULZER.

Decided May 3, 1920.

277 O. G., 396; 49 App. D. C., 356; 265 Fed. Rep., 996.

PATENTS—INTERFERENCE—DISCLOSURE BY ONE CONTESTANT TO THE OTHER.

In an interference between S. and P. relating to a process of making stencil-paper for use with a sensitized photographic film and to the article made by such process *Held* the evidence of disclosure by S. to P. only proved disclosure of the result to be accomplished rather than the specific article of the issue and the process of producing the same.

Mr. S. T. Cameron, Mr. W. B. Kerkam, and Mr. Taylor E. Brown for the appellant.

Mr. F. F. Church and Mr. G. W. Rich for the appellee.

ROBB, J.:

Appeal from a decision of an Assistant Commissioner of Patents in an interference proceeding reversing the decision of the Examiners-in-Chief and awarding priority to Sulzer, whose application was not filed until more than two years after he claims to have made the invention and two months after a patent had been issued to Pembroke, the appellant. The invention relates to stencil-paper and the process of making it. It is defined in six counts, of which the first and fourth will serve as examples:

1. The process of making flexible opaque stencil paper having an opaque coating which can be removed at a single stroke of the stylus which consists in first making a translucent paper non-absorbent, then coating said paper with an opaque coating that will adhere to said paper without penetrating the fiber of

the paper said coating being as flexible as the paper but brittle enough to be practically all removed from the paper by a single stroke of the stylus.

4. An article of manufacture consisting of a translucent paper web made water proof by a translucent coating and then coated on one side thereof with a combination of waxy material and opaque pigment.

Sulzer was general superintendent of film manufacture for the Eastman Kodak Company, to which company the application in interference was assigned by him. That company obtained a license and option to purchase the Gaisman process for marking photographic-film negatives. The film-cartridge used by Gaisman includes, in addition to the film and red-paper back, a strip of carbon-paper interposed between them, with the carbon side toward the backing-paper. In practising the process the operator opens a small door or slide in the back of the camera, thus exposing the backing-paper, upon which he writes the desired notation with a stylus. The pressure of the stylus transfers the carbon to the backing-paper and permits the light to penetrate the stencil-paper and photographically imprint the notation upon the film. Sulzer was directed to produce film-rolls for carrying out this process, but he found that ordinary carbon-paper was unsatisfactory for use in connection therewith. On the evening of February 13, 1914, therefore, Mr. Pembroke, highly skilled in the art and president of the Kee-Lox Company, (large manufacturers of carbon-paper,) was informed by Mr. Haste, manager of the Kodak Park Works of the Eastman Kodak Company, that the company required a special carbon-paper which should have certain properties. To quote from the testimony of Mr. Haste:

It should be opaque and free from defects like pinholes and that it should have the property of the carbon being easily removed when written upon with a pencil or stylus, as distinguished from the ordinary carbon paper of which it was required that as many impressions as possible could be taken.

This was the extent of the information given Pembroke by Haste. He did not tell Pembroke of the Gaisman invention or of the purpose for which the desired carbon-paper was to be used, nor did he inform him that it should be waterproof. In other words, Pembroke was told in very general terms that a carbon-paper was desired possessing some, but not all, of the properties mentioned in the claims of the interference. We fully agree with the Examiners-in-Chief that nothing more was disclosed to Pembroke by Sulzer's agent Haste than a result to be accomplished, and that Pembroke is the real inventor of the subject-matter of these claims. (*Sendelback v. Gillette*, C. D., 1904, 597; 109 O. G., 276; 22 App. D. C., 168; *Anderson v. Wells*, C. D., 1906, 667; 122 O. G., 3014; 27 App. D. C., 115; *Robinson v. McCormick*, C. D., 1907, 574; 128 O. G., 3289; 29 App. D. C., 98; *McKeen v. Jerdone*, C. D., 1910, 333; 153

O. G., 272; 34 App. D. C., 163; *Hart & Barber v. Wiig*, C. D., 1919, 218; 265 O. G., 147; 49 App. D. C., 78.)

After the completion of his invention, but before manufacturing paper embodying it for the Eastman Kodak Company, Pembroke required and obtained from that company an agreement not to analyze his coating or "dope." Thereafter large quantities of paper were manufactured and sold by him to that company. Having waited until after the issuance of the Pembroke patent to file his application, the burden is upon Sulzer to establish his case beyond a reasonable doubt. Not only has he failed to do this but, in our view, he has failed to establish by even a preponderance of evidence that he and not Pembroke is the inventor of the claims of the issue.

We therefore adopt the carefully-prepared and satisfactory opinion of the Examiners-in-Chief, reverse the decision of the Assistant Commissioner, and award priority to Pembroke.

Reversed.

[Court of Appeals of the District of Columbia.]

ERREN v. YARDLEY.

Decided June 2, 1920.

277 O. G., 396; App. D. C., —; 267 Fed. Rep., 345.

1. PATENTS—INTERFERENCE—PRIORITY AWARDED TO FIRST TO CONCEIVE AND REDUCE TO PRACTICE.

In an interference contest a finding that one of the parties was prior to the other in conception and reduction to practice is a sufficient basis for an award of priority to him. In this proceeding it is unnecessary to determine what right either party ultimately might have to a patent, the only question involved being that of priority between the parties to the interference.

2. SAME—SAME—ACCESS TO AFFIDAVITS FILED UNDER RULE 75.

Where claims forming the issue of an interference had been rejected in view of a prior patent and the rejection withdrawn by the Examiner in view of affidavits filed under Rule 75, which were then sealed up, upon motion to dissolve, alleging non-patentability in view of such patent, it was not error for the Patent Office to refuse access by the moving party to such affidavits, since the issue raised by the affidavits—patentability—was one in which the moving party had no interest in the interference proceeding.

3. SAME—SAME—ISSUE THAT OF PRIORITY ONLY.

In an interference contest the only question involved on appeal to the Court of Appeals of the District of Columbia is that of priority of invention between the parties, the losing party having no standing to contend that the issue is not patentable, that a third party was the prior inventor, or that there is a statutory bar to the issuance of a patent.

Mr. A. G. Davis and *Mr. Melville Church* for the appellant.

Mr. W. G. Carr for the appellee.

ROBB, J.:

Appeal from a Patent Office decision in an interference proceeding awarding priority to the senior party Yardley. The invention relates to synchronous-booster rotary converters and is expressed in two counts, which need not be reproduced here.

The Board of Examiners-in-Chief and the Assistant Commissioner, after a careful analysis of the testimony, reached the conclusion that Yardley was the first to conceive and first to reduce to practice, and we are in accord with those findings. Counsel for appellant contend here, as below, that the mere fact that Yardley was the first to conceive and first to reduce to practice is not sufficient ground upon which to base an award of priority to him. The Assistant Commissioner directed attention in his opinion to the fact that such has been the rule in the Patent Office since 1872, and that the rule has received the approval of this court in *Hubbard v. Berg* (C. D., 1913, 460; 195 O. G., 818; 40 App. D. C., 577) and *Thompson v. Storrie* (C. D., 1917, 222; 245 O. G., 845; 46 App. D. C., 324.) We can find no sufficient reason for the overturn of this long-established rule and the decision of this court approving it.

In the Patent Office each party, as frequently happens, urged the non-patentability of the issue to the other party, Erben contending that the French patent to Siemens-Schuckert, dated January 20, 1913, anticipates Yardley, and hence that the interference should be dissolved. The Law Examiner ruled against Erben's contention and declined to dissolve the interference. Yardley had satisfied the Primary Examiner on this point by filing affidavits under Rule 75 of the Patent Office, for the purpose of overcoming this reference. Erben contended below, as here, that he should have been permitted to inspect those affidavits.

In *Gueniffet v. Wictorsohn* (C. D., 1908, 367; 134 O. G., 779; 30 App. D. C., 432) we ruled that it was unnecessary to determine what right either party to an interference ultimately might have to a patent, the only question involved being that of priority between the parties to the interference. In *Lecroix v. Tiberg* (C. D., 1910, 263; 150 O. G., 267; 33 App. D. C., 586) and in *Gammeter v. Thropp* (C. D., 1915, 59; 210 O. G., 1397; 42 App. D. C., 564) we held, following our decision in *Burson v. Vogel*, (C. D., 1907, 669; 131 O. G., 942; 29 App. D. C., 388,) that the possible existence of a statutory bar of public use to the issuance of a patent to one of the parties to an interference, is not an issue in that interference. We have repeatedly held that the question of patentability is not before us in an interference proceeding. (*Sobey v. Holsclaw*, C. D., 1907, 465; 126 O. G., 3041; 28 App. D. C., 65; *Mell v. Midgley*, C. D., 1908, 512; 136 O. G., 1534; 31 App. D. C., 534, and *Norling v. Hayes*, C. D., 1911, 347; 166 O. G., 1282; 37 App. D. C., 169.)

The issue here is between the parties to the interference, and the losing party has no standing to contend that a third party really is the prior inventor. That such was the contention in the Patent Office is apparent from the Assistant Commissioner's decision, wherein it is stated:

Erben contends that the issue is not patentable to Yardley since the showing made by him to establish that he made the invention prior to the date of a certain French patent was not sufficient, and Yardley contends that what Erben did was in view of the state of the art not patentable over the disclosure made in what is known as the "Power" article. * * * Neither of these questions is properly to be considered on an appeal on priority.

The Assistant Commissioner clearly was right, for Yardley, even assuming that he was anticipated by the French patent, still would be prior to Erben. Since the issue raised by the affidavits filed by Yardley was one in which Erben had no interest in the interference proceedings, the Patent Office did not err in denying Erben's motion to inspect them.

The decision is affirmed.

Affirmed.

[Court of Appeals of the District of Columbia.]

BLAINE v. WHITE.

Decided June 2, 1920.

277 O. G., 787; 50 App. D. C., —; 267 Fed. Rep., 340.

PATENTS—INTERFERENCE—REVIEW OF CONCURRING DECISIONS OF THE PATENT OFFICE.

Where the line which separates the respective contentions of the parties to an interference is quite attenuated and not easily perceived and the just consideration of the case calls for expert knowledge, the concurring decisions of the Patent Office tribunals will not be disturbed by the court except where error very clearly appears.

Mr. L. T. Greist and Mr. W. N. Cromwell for the appellant.

Mr. J. Edgar Bull for the appellee.

SMYTH, C. J.:

Blaine appeals from an award of priority against him in an interference proceeding. The invention involved relates to a sheet-guide adjustment on a printing-press. We do not think it necessary to set out any of the counts of the issue in view of the manner in which we think the matter should be disposed of. Blaine moved to dissolve the interference on the ground that count 1 was unpatentable in view of the prior art, and that the party White had no right to make count 2 of the issue. This motion was overruled by the Law Exam-

iner. Blaine stood upon the record, took no testimony, and judgment of priority was given against him, he being the junior party. Afterward he filed several motions in the Office, all of which were denied. On appeal from the decision of the Examiner of Interferences he was defeated before the Board of Examiners, and their action was affirmed by the First Assistant Commissioner.

The subject involved is intricate, and its just consideration calls for expert knowledge. The line which separates the respective contentions of the parties is quite attenuated and not easily perceived. It is the settled rule of this court that where the three tribunals of the Patent Office concur in the disposition of such a case, the decision of the Commissioner will not be disturbed by this court except where error very clearly appears. (*Creveling v. Jepson*, C. D., 1918, 209; 256 O. G., 226; 47 App. D. C., 597; *Lindmark v. Hodgkinson*, C. D., 1908, 540; 137 O. G., 228; 31 App. D. C., 612; *Murphy v. Meissner*, C. D., 1905, 592; 114 O. G., 1830; 24 App. D. C., 260; *Stone v. Pupin*, C. D., 1902, 550; 100 O. G., 1113; 19 App. D. C., 396; *Podlesak v. McInnerney*, C. D., 1906, 558; 120 O. G. 2127; 26 App. D. C., 399.)

Blaine admits the rule but denies its applicability. He says that the three tribunals, while reaching the same conclusion, did so by different routes, some of which are inconsistent, or at least are not identical with the others. We think not. The Law Examiner held that the counts were patentable and readable upon the disclosures of both parties. In this he was affirmed by the Examiner of Interferences. On appeal the Board of Examiners rejected Blaine's contention that the counts were inconsistent, and refused to consider the prior art, because the meaning of the counts were not obscure and therefore needed no construction.

The necessity for judicial construction never arises until uncertainty is encountered. *Mayo v. Whedon*, 47 App. D. C., 138.

The Board sustained the lower tribunals in their holding that the counts were patentable and readable on the claims of both parties. In this they were affirmed by the Assistant Commissioner, who held that Blaine had in no way established that the claims were not readable on the application of White. Having failed to do this, White was necessarily entitled to priority, being the senior party, and Blaine taking no testimony to overcome his date. We think the rule pertinent, and that there is a total absence of such error as would warrant us in overruling the Commissioner.

There is nothing in *Podlesak v. McInnerney* (C. D., 1906, 558; 120 O. G., 2127; 26 App. D. C., 399) requiring a different conclusion. It was there ruled that if a certain course was followed in construing the claims, it might be found that there was no interference in fact, and the court sent the matter back to the Patent Office "for further

consideration as to the identity of invention." Between this and what was held in the instant case we perceive no conflict.

For the reasons stated the decision of the Patent Office is affirmed and priority is awarded to Joseph White, the senior party.
Affirmed.

[Court of Appeals of the District of Columbia.]

BRUCKMAN v. MILLER.

Decided June 2, 1920.

277 O. G., 787; 50 App. D. C., —; 267 Fed. Rep., 338.

1. PATENTS—INTERFERENCE—REOPENING AFTER APPEAL TO COMMISSIONER TO TAKE FURTHER PROOFS.

In an interference between B. and M., in which the question was one of originality, where, after hearing on appeal to the Commissioner from a decision of the Examiners-in-Chief awarding priority to M., B. filed a motion to reopen the interference to take the testimony of M., supporting the motion by affidavits executed by M. to the effect that B. disclosed the invention to him, it was error to refuse the motion to reopen.

2. SAME—SAME—POWER OF COMMISSIONER TO REOPEN INTERFERENCE TO TAKE ADDITIONAL TESTIMONY.

Interference proceedings are of an equitable nature, and so long as a case is pending in the Patent Office it is within the supervision of the Commissioner, who is charged with the duty of seeing that full justice is done, and he may, under his supervisory power, order a case reopened for the taking of additional testimony.

3. SAME—SAME—ORIGINALITY.

In an interference between B. and M., involving the question of originality, evidence considered and *Held* that B. disclosed the invention in issue to M.

Mr. A. E. Dieterich for the appellant.

Mr. F. S. Geisler for the appellee.

VAN ORSDER, J.:

The issue of this interference relates to the invention of a machine for making cones used as receptacles for ice-cream.

It is unnecessary to set out the claims or to consider the invention in detail, since the appeal turns wholly upon the question of originality.

It is urged by appellant, the junior party, that appellee Miller derived from him the information which enabled him to file his application for patent.

Certain conceded facts are important. Both parties were employed by the Crystal Ice & Storage Company, of Portland, Oreg. Miller had access to the room where Bruckman was engaged in

building a rotary cone-making machine which he had invented, and of which the present invention is a modification. Miller admits that he frequently visited the room where Bruckman was at work, and admits that Bruckman disclosed to him the broad idea of the present invention, but denies that he derived from him any information as to the details by which the problem could be solved.

The Examiner of Interferences found in favor of Bruckman, but was reversed by the Board of Examiners-in-Chief and the Assistant Commissioner, upon the ground, as stated by the Commissioner—

if the claims cover broadly the mere reversal of the moving parts (the molds and the batter carriage) in the machine of this patent, then it is clear that either there was no invention, or that Miller got the broad idea from Bruckman. If, on the other hand, the invention is more narrowly the specific means of operating; that is to say, the solution of the problem of reversing the relative motions of the heavy and light parts,—then Bruckman entirely fails to show any disclosure to Miller.

We are convinced from a careful review of the testimony that Bruckman not only disclosed to Miller the broad idea of the invention, but the means of operation, to enable Miller, with the additional knowledge he had of the Bruckman rotary machine then in course of construction, and with the assistance of counsel, to prepare his application for patent. In these matters Miller stands alone, while Bruckman is amply corroborated. This deduction from the testimony is verified, however, by the sworn admissions of Miller. When the case was pending on appeal before the Assistant Commissioner, Miller voluntarily made two affidavits in which he admitted that he derived the whole invention from Bruckman. He states in the first affidavit as follows:

I make this affidavit for the reason that I have been instrumental in causing Mr. Bruckman a good deal of trouble and expense and that Mr. Bruckman originated the idea of the machine I have been heretofore claiming as my own.

In the second affidavit, after stating in detail the circumstances under which he derived the information from Bruckman, he says:

As heretofore stated, I made this affidavit and the affidavit dated December 25, 1918, of my own free will; that I have not received any money or property of any kind or promise of reward for making the same; that I voluntarily approached Mr. Bruckman and told him what I would do; that we have discussed what occurred, when he was working on his machine and from talking the matter over, my mind has been refreshed and matters that did not transpire have been called to mind; that I had entirely forgotten. I very much regret to make this affidavit. I feel it my duty now to make the affidavit; that I am convinced that I would not have been able to build this machine if I had not obtained the original idea from Mr. Bruckman.

The Commissioner, in denying Bruckman's motion to reopen the proofs and introduce the testimony of Miller, gave, as a reason, that in the affidavits—

Miller fails to say that Bruckman disclosed to him the real invention in issue, and also that the affidavits did not disclose newly-discovered evidence—

for not only was it open to Bruckman to take Miller's testimony at the time of taking his proofs, but Miller was bound to know when he testified, all that he now alleges he knows and proposes to testify.

These proceedings are of an equitable nature, and, so long as the case is pending in the Patent Office, it is within the supervision of the Commissioner, who is charged with the duty of seeing that full justice is done, proceeding with due regard for the requirements of the statutes and the rules of practice affecting procedure in the Patent Office. There was nothing, however, to prevent the Commissioner in the exercise of his supervisory power to order the case reopened for the taking of additional testimony.

While the denial of the motion to reopen the case constitutes reversible error, which would, standing alone, necessitate sending the case back for the taking of further testimony, we deem this course unnecessary, since on the evidence, regardless of the affidavits, Bruckman is entitled to priority.

The decision of the Commissioner of Patents is reversed, and the clerk is directed to certify these proceedings as by law required.

Reversed.

The decision of the Assistant Commissioner reads as follows:

CAY, Assistant Commissioner:

Bruckman appeals from a decision of the Examiners-in-Chief which, reversing the decision of the Examiner of Interferences, awarded priority to Miller on an issue in ten counts sufficiently illustrated by the following:

"1. In a baking machine including a carriage for conveying batter to the oven and moving adjacent the latter, an oven comprising a core, a conforming mold for said core comprising separable parts, pivoted arms operating the separable parts, means for heating the oven, and means on the carriage for operating said pivoted arms, whereby said molds are opened and closed in time with the movement of the carriage.

"3. In a machine of the class described, a plurality of sets of molding devices relatively stationarily located, a carriage adapted to be passed along from one set of molding devices to another, each of said molding devices including parison molds and cores therefor, and mold-section securing latches, a batter reservoir on the carriage, devices on the carriage for engaging said mold-section securing devices to unlock the same and open the molds, devices on the carriage for raising the cores in the molds to strip the molded product from the same, a device on the carriage for engaging the mold securing means to reclose the parison mold sections, instrumentalities on the carriage for transferring the batter from the reservoir to the molding devices.

"6. In a machine of the class described, a plurality of sets of molding devices relatively stationarily located and each comprising a pair of female half molds and a core for the same, devices connecting said half molds together, a carriage

designed to be passed by said molds, a batter reservoir on said carriage, means on said carriage for engaging said half-mold connecting means to open the half-mold sections, means on said carriage for raising the cores to strip the cones from the same, means on said carriage for engaging said half mold connecting means to reclose said half mold members, and mechanism on the carriage coöperating with the molding devices for supplying batter thereto, said molding devices including heat applying instrumentalities for baking purposes.

"9. In a machine of the class described, a plurality of sets of molding devices arranged in a row, each set of molding devices comprising sectional molds and cores for the same, a carriage arranged to be passed along by the molds, batter supplying instrumentalities on said carriage, mold opening and closing mechanism on the carriage, and means for holding the carriage in position with respect to the different molds while effecting the operation of charging the molds with batter."

The main question seems to be one of originality; but a proper determination of this requires a clear delineation of the invention in issue. The Examiner held that Bruckman had disclosed it to Miller. The Examiners-in-Chief held this to be error. In reaching their conclusions these tribunals attributed to the claims very different scopes. Bruckman developed the rotary machine of his patent, No. 1,071,027, August 26, 1913. If the claims cover broadly the mere reversal of the moving parts (the molds and the batter-carriage) in the machine of this patent, then it is clear that either there was no invention or that Miller got the broad idea from Bruckman. If, on the other hand, the invention is more narrowly the specific means of operating—that is to say, the solution of the problem of reversing the relative motions of the heavy and light parts—then Bruckman entirely fails to show any disclosure to Miller.

The claims originated in part in each of the applications; but it is obvious from the histories of both applications that the invention is not broad enough to read upon a mere reversal of the parts in Bruckman's patented rotary machine. There was no invention in the mere idea of making the mold stationary and moving the carriage for the batter; but the invention was in the means of successfully accomplishing this desired end. Yet what Bruckman disclosed to Miller, even according to his own testimony, was just this. This was a statement of the problem, not its solution. Not only does Miller flatly deny Bruckman's statement that Bruckman disclosed the invention to him, but I think Bruckman himself corroborates Miller's position. Over and over again he says that he disclosed only the general idea of the stationary mold and the moving carriage as an alternative form of his own rotary machine, which had traveling molds. Bruckman says at page 25 that in 1909 he conceived two ways of making an automatic cone-baking machine:

One way was to place the molds on a bench or in a row and operating them with a carriage with devices for operating the molds, or by placing the molds

on a rotatable wheel and have the operating devices stationary, which would operate the molds as they passed.

He went on and developed the rotary machine of the patent referred to and abandoned the reciprocating machine. In Miller's machine the mold or "oven" (Figures 6 and 7) is composed of the two halves *m* on pivoted arms *n* and a core *i*, which has a vertical reciprocation to strip off the cone when the female mold is open. The whole mold remains in place, while the carriage *p* passes under it, acting to open the mold by means of a cam *q*, lifting the slotted cam-plate *k*. Before this the core *i* is raised, as in Fig. 7, so that the baked cone may drop off. Thereupon, the carriage being now stopped and the female mold out of the way, the batter-dipper *s'* is raised to coat the core *i* with new batter. Both parts of the mold carry electric heating devices. This machine is in many ways different from Bruckman's patented machine, and Bruckman is in error in thinking that it is—

simply a reversal of the parts; that is, in the rotary machine the parts that are movable are stationary in the reciprocating type and the parts that are movable in the reciprocating type are stationary in the rotary, (p. 30.)

All Bruckman's testimony rests on this error. At page 32 he agrees with the Examiner's attempted testimony that the invention in issue is this mere reversal of parts. While he says at page 42 that he had the idea of lifting the batter-cup to apply batter to the cone, he says that he gave up that idea and that he never built any machine of that type at all, (p. 43 and p. 59.) He seems reluctant (p. 63) to state that the machine of his present application was patentable over the patented machine.

I think it reasonably clear that whatever specific idea Bruckman may have had at the time of his conference with Miller he deliberately abandoned it in favor of the rotary type of machine. (See X-Q. 16, p. 67.)

As to what he actually described to Miller, he says, (p. 70:)

I don't remember whether I had any drawings or not. I think, though, I made some sketches in order to explain to him how I had planned on building it. * * * They would only show the broad construction of it. I would not draw out any detail work on it; simply showing the difference between how the machine could be constructed in this form of a reciprocating type rather than the rotary.

What he explained to Miller was just what he explained to others, (p. 68.) When specially urged to state definitely just what he disclosed to Miller, he was unable to recollect anything more than the mere matter of reversibility, broadly considered. (R. D. Q. 2, p. 80.) Nowhere in his record is there any statement of any particular construction disclosed to Miller.

To construe the issues to mean what Bruckman disclosed to Miller is to construe them out of existence, for in that case there is no invention involved. On the other hand, the broadest of the claims in issue requires a batter-conveying carriage moving past an oven which comprises a core and a female mold in separable parts mounted on pivoted arms and devices on the carriage for operating said arms, together with heating means for the oven. In the machines of both parties this heating means for the oven is a part of or fixed to the oven and has no relative motion, as is the case of the gas-jets in the rotary machine of the patent. Supposing one to have the patent before him and to be told that the parts might be reversed, so as to leave the molds stationary and move the battery-carriage relatively thereto, he would still have about as much of a problem to solve in order to arrive at the invention in issue as if he had had the disclosure of the patent alone.

Not only does Bruckman's testimony entirely fail to show a disclosure to Miller of the particular construction which constitutes the invention in issue, but I think what Bruckman and his witnesses do say substantially corroborates Miller's testimony that Bruckman did not disclose the invention to him. Bruckman's brother, L. A. Bruckman, although attempting to state on hearsay that Miller got his ideas from Bruckman, is yet unable himself to relate any conversation in which Miller could have gotten anything more than the bare suggestion—

that the movable parts on the rotary machine would be stationary and placed on a bench on a straight line and some kind of a device to travel along to open and close it and operate it, (p. 111.)

Witness Fosdick not only makes it clear that Bruckman abandoned the idea of the reciprocating machine, but he says that from the information he got from Bruckman he would still "have had to work out the dimensions and all the details," (p. 120.) He nowhere states anything definite as being disclosed even to him, and it is obvious that he does not because he cannot.

After hearing was had on this appeal Bruckman filed a motion to reopen the proofs and introduce testimony of Miller to the effect that he, Miller, received a disclosure from Bruckman. The motion is supported by affidavits of Miller attempting a disclaimer of inventorship; but even in this attempted disclaimer Miller fails to say that Bruckman disclosed to him the real invention in issue. After saying—

I lost track of the fact that I got the idea of my machine from Mr. Bruckman, and although he has, since giving his testimony, discussed with Bruckman what occurred at the time of the alleged disclosure of

Bruckman to Miller and although he has had his mind refreshed and says he—

felt convinced that he would not have been able to build this machine if he had not obtained the original idea from Bruckman,

yet when he comes to state what idea he did get from Bruckman he does not state any idea that constitutes the invention in issue. With the rotary machine before them both, he says, Bruckman—

stepped over to the bench and he demonstrated how he could take these ovens and set them spaced the proper distance apart in a longitudinal way, or in other words, side by side on this bench and then have a carriage or device which I can operate by hand or operate the molds that would travel forward and backward and operate the different cams much better than as set up on this frame or round wheel. (Affidavit dated December 25, 1918, p. 2.)

This is all of the description, and it falls short of covering the invention in issue. There is not in the entire record any description of any means for operating the reciprocating machine, as in the applications of the parties hereto nor as contemplated by the issues.

It is clear enough that Miller would be estopped to deny that he is the inventor so far as such denial is detrimental to the interests of his assignee and as against that assignee, (Rob. on Pats., Vol. III, p. 250;) but I know of no law by which the estoppel could bind Bruckman unless there is some privity between Miller and Bruckman. (A. and E. Encycl., Vol. II, p. 439.) Bruckman was at the proper time entitled to use any witness he could find to prove his disclosure to Miller and could have used Miller himself. Thus if on cross-examination Miller had admitted that Bruckman disclosed to him that would certainly have been admissible evidence for Bruckman, notwithstanding it operated in derogation of the rights of Miller's assignee, the real party in interest against Bruckman. In other words, the estoppel against Miller does not go to the extent of making his testimony inadmissible to show that he was not the inventor when that testimony is taken for the benefit of Bruckman, who was not a party to the transaction which worked the estoppel. (See *De Laval Co. v. Vermont F. M. Co.*, 135 Fed. Rep., 772.)

But Bruckman's motion to reopen is refused on other grounds. There is here no newly-discovered evidence in any such sense as would warrant a reopening, for not only was it open to Bruckman to take Miller's testimony at the time of taking his proofs, but Miller was bound to know, when he testified, all that he now alleges he knows and proposes to testify. The sources of his knowledge were the same then as now. A mere change of mind or better recollection upon further thought is no ground for reopening. Besides which, his change of mind is open to suspicion under the circumstances. No new facts have been found. His interests have changed somewhat, since he is now an employee of Bruckman's company. Moreover, in

any case his testimony would not be any stronger proof than his present attempted admission against interest, and his affidavit is not only not convincing, but even if believed it apparently shows that if he did testify he would only corroborate his previous testimony, at least so far as it is concerned with the particulars of the invention in issue. He does not state any good reason why he was mistaken in the first place or why his testimony on this point now would better accord with the rest of his testimony.

The motion to reopen the proofs being denied, I am satisfied that Miller was the first inventor of the issue for the reasons more fully given by the Examiners-in-Chief. I entirely agree with them, and their decision is affirmed.

[Court of Appeals of the District of Columbia.]

THE PREST-O-LITE COMPANY, INC., v. PLAY-O-LITE COMPANY, INC

Decided June 2, 1920.

277 O. G., 790; 50 App. D. C., —; 267 Fed. Rep., 350.

TRADE-MARKS—"PREST-O-LITE"—RIGHT TO PREVENT REGISTRATION OF "PLAY-O-LITE" IN FIELD OCCUPIED BY SIMILAR MARKS.

Where opposer adopted the mark "Prest-O-Lite" in 1904 for use on gas-tanks and did not extend its use to storage batteries until 1915, it is not entitled to successfully maintain opposition to the registration of "Play-O-Lite," adopted by applicant in 1917 for electric lamps, where others had adopted and used the words "Linolite," "Tubolite," "Portalite," and "Pract-El-Lite" prior to opposer's extension of its mark to storage batteries and had registered the same.

Mr. E. W. Bradford for the appellant.

Mr. Wm. F. Hall for the appellee.

ROBB, J.:

Appeal from concurrent decisions of the Patent Office in a trade-mark opposition proceeding.

In 1904 appellant adopted the mark "Prest-O-Lite" for use on gas-tanks, and in 1915 it applied the same mark to the manufacture of storage batteries. In 1917 appellee adopted the mark "Play-O-Lite" for use on electric lamps for illuminating the front of pianos. The record shows that "Linolite" was registered for use on incandescent electric lamps in 1907, the application showing use of the mark since 1902. "Tubolite" was registered in 1909 for the same goods, the date of use being 1906. "Portalite" for use on electric lamps was registered in 1912, while "Pract-El-Lite" for incandescent electric lights was registered in 1915, with July of 1914 as the date of use. So far as appears, all these marks are in use and were in use when appellant extended its business to cover or include stor-

age batteries. We have just ruled, in *French Battery & Carbon Company v. The Prest-O-Lite Company*, See *ante*, 214, present term, where the facts were the same, that the Prest-O-Lite Company was not in a position to prevent the registration of "Ray-O-Lite" for use on electric lamps. The same reasoning applies here. When "Linolite," "Tubolite," "Portalite" and "Pract-El-Lite" were registered for use on electric lamps and lights the field was open, for at that time appellant was using its mark on gas-tanks. Appellant's subsequent use of its mark in 1915 on storage batteries did not entitle it, of course, to strike down the prior registrations made in good faith or destroy the business of the various firms securing those registrations. (See *United Drug Co. v. Rectanus*, C. D., 1918, 369; 257 O. G., 1082; 248 U. S., 90.) As the field already was occupied, it follows that appellant is not in a position to object to the registration by appellee of its mark for use on electric lights.

The decision is affirmed.

Affirmed.

[Court of Appeals of the District of Columbia.]

H. KUHN & SONS (INC.) v. LETTS.

Decided June 2, 1920.

277 O. G., 791; 50 App. D. C., —; 267 Fed. Rep., 748.

1. TRADE-MARKS—USE NECESSARY TO ESTABLISH RIGHT TO REGISTRATION.

Use of a trade-mark in interstate commerce or in commerce with foreign nations or with Indian tribes is a prerequisite to its registration, and the use contemplated is use by the applicant himself or by some one for him and not an independent or incidental use by a third party. Hence where persons outside the State of California, where appellee was doing business, procured appellee's goods through friends in California and had them sent outside that State appellee could take no benefit from such transaction, and the business being otherwise local appellee failed to show the requisite use.

2. SAME—EVIDENCE OF INTERSTATE USE—SUFFICIENCY—TAKING ADDITIONAL TESTIMONY.

Where in a trade-mark interference proceeding, an applicant is refused permission by the Commissioner to take further testimony to prove interstate commerce on the ground that the testimony in the case shows such use, and on appeal the court concluded that the testimony is insufficient for this purpose, although such use is alleged in the declaration, *Held* that the denial of the request to take further testimony was error, and the case reversed and remanded with directions to permit the introduction of the same.

Mr. Harlan Moore for the appellant.

Mr. C. J. O'Neill for the appellee.

ROBB, J.:

Appeal from a decision of the Commissioner of Patents in a trade-mark interference proceeding involving the mark "American Boy."

Appellant was granted registration of the mark in 1917, on an application filed in 1915, and its use of the mark commenced just prior to the filing of its application.

Appellee is the proprietor of a department store in Los Angeles, California, and the testimony clearly shows local use of "American Boy" as a trade-mark long prior to the earliest date claimed by appellant. The sole question is whether an interstate use has been shown. The evidence on this point tended to show that parties outside California had written to friends or relatives in Los Angeles and, through them, had purchased "American Boy" clothing, and that those purchases were shipped by such friends or relatives to their ultimate destination. Aside from vague and unsatisfactory testimony by a representative of appellee's firm, this was the evidence upon which appellee depended to show interstate use.

The Trade-Mark Act, (33 Rev. Stat., 724,) requires an applicant for registration to accompany his application—

by a written declaration verified by the applicant that such trademark is used in commerce among the several States, or with foreign nations, or with Indian tribes * * *.

Applicant complied with this provision in the present case by declaring under oath—

that said trademark is used by him in commerce among the several States of the United States.

Clearly the use contemplated by the statute is a use by the applicant himself, or by some one for him, and not an independent or incidental use by a third party, the reason being that before an applicant is entitled to registration he must show that his business extends beyond the boundaries of his own State or into the territory of an Indian tribe. Appellee's business, so far as the present record shows, was local. That persons outside the State procured appellee's goods in California and had them sent outside that State is beside the question, for appellee was in no way responsible for, and hence could not benefit by, such a transaction. The sale was local and not interstate. Appellee evidently appreciated the difficulty, for in the Patent Office he requested an opportunity to introduce further testimony "to prove interstate commerce" but the Commissioner, being of the view that appellee had "fairly proven the interstate use" of the mark, did not deem it necessary to reopen the case.

The decision must be reversed but, in the circumstances, the case will be remanded with directions to permit appellee to introduce further testimony on the question of interstate use. Reversed and remanded.

[Court of Appeals of the District of Columbia.]

HOENIG V. PARKER.

Decided June 2, 1920.

278 O. G., 367 50 App. D. C., —; 267 Fed. Rep., 323.

1. PATENTS—INTERFERENCE—REDUCTION TO PRACTICE—SIMPLE DEVICE.

A two-part insulation having means for holding the parts in assembled relationship is of such a simple nature that it needed no test to show that it would do what was claimed for it.

2. SAME—SAME—ALLEGED ABANDONMENT—BURDEN OF PROOF.

In an interference proceeding one asserting the abandonment of the invention by another party has the burden of proving it, and where the only evidence relied upon is a delay of ten months after reduction to practice in filing the application for patent the burden is not sustained where the delay is explained by evidence of financial embarrassment.

Mr. E. Hume Talbert for the appellant.

Mr. George E. Tew and *Mr. George A. Rockwell* for the appellee.

SMYTH, C. J.:

This was a tri-party interference involving the application of Parker, filed January 8, 1915; Kendig, filed in February, 1915; and Hoenig, filed in October, 1915. It embraces but a single count, which reads:

A device of the character described comprising a member with a passage; a member for attachment to a support and having a fixed head, the body of said attachment member extending through said passage, said fixed head positively preventing accidental withdrawal of the first-mentioned member from one end of said attachment member; and means to positively limit, at a predetermined point, movement of the first-mentioned member toward the tip of said attachment member.

The invention relates to two-part insulators and means for holding the parts in assembled relationship. The means consist of a nail passing through perforations in the cap and base portions, and a struck-up portion on the shank of the nail for positively limiting the movement of the nail and base in one direction. The issue is directed broadly to the means for positively limiting the movement.

The idea was to provide an insulator which could be assembled at the factory, shipped to the point of use and then readily installed. The Examiner of Interferences was of opinion that to prove reduction to practice it was necessary to show commercial use of the device, involving assembling, shipment, handling, and installation. He held that Parker and Kendig were entitled to their respective filing dates for reduction to practice, and that Hoenig should be given the last of December, 1914, for his time of conception, but that not having put the device into commercial use and because of the shortness of the nail used, he had not actually reduced to practice, and since he was

not diligent between the time of conception and the date of filing, he must be confined to the latter date. Parker, was, therefore, awarded priority. Kendig did not appeal. Hoenig did.

The Board of Examiners held that Hoenig was entitled to the date given him by the Examiner of Interferences for conception; also that the device was of such a simple nature that it needed no test to show that it would do what was claimed for it, and that Hoenig should be allowed December 31, 1914, for actual reduction to practice. Differing, however, from the Examiner of Interferences with respect to Parker, they ruled that he, having prepared his application December 24, 1914, and filed it with due diligence January 8, 1915, was entitled to December 24 as the date of his invention, and, hence, to priority over Hoenig. The First Assistant Commissioner, ignoring Parker's application date, ruled that he was limited to his filing date, January 8, 1915, for constructive reduction to practice; rejected the testimony on behalf of Hoenig with respect to a conception and reduction to practice in December, 1914, and held that he had failed to establish that he had disclosed the invention prior to Parker's filing date, January 8, 1915. In consequence he awarded priority to Parker.

Parker asserts that he conceived and reduced to practice in 1913. We agree with the First Assistant Commissioner that the record does not sustain him in this. He is not entitled to any date before December 24, 1914, the date accorded him by the Board of Examiners.

Hoenig claims that about the middle of November he went to Pittsburgh to pay interest on a note given to the Baird Machinery Company in part payment for a large machine that he had previously purchased. While there he had a conversation with the purchasing agent of the Iron City Electrical Company, who spoke of the salability of a two-piece porcelain knob if it was economically put together for shipping and resale. Hoenig, who had extensive experience in porcelain-die making, says that shortly after his return from Pittsburgh he conceived the device of the issue, and about November 18 or 20, commenced to make a die to be used in producing it. He completed the die near January, 1915. On cross-examination he exhibited a canceled check dated November 18, 1914, and payable to the Baird Machinery Company, for the purpose of supporting his statement that he had paid the company money at that time. After completing the die he assembled, he says, two knobs—the insulators are sometimes spoken of as knobs—in the manner called for by the claim of the issue. This was done, he declared, in the presence of C. C. Smith, Worthen, and Lyde. The next day he showed the assembled knobs to Hellyer, J. T. Smith, and Hetzel.

C. C. Smith fully corroborated him in important particulars. He testified that he was a porcelain-die maker of several years' experi-

ence; that he was employed by Hoenig, and commenced work on the dies about the 1st of December, 1914. Hoenig supplied him sketches from which he worked. Along near the middle of December he learned that the dies on which he was employed were for the purpose of producing the device of the issue. One of the means by which he recalled the dates was the fact that at the time he worked on the dies, he also did some work for the Louthan Supply Company. This he remembers because from the work done for that company Hoenig, who was financially embarrassed, procured the money to pay him wages which were past due and for which he had been compelled to institute suit against Hoenig before one Bennett (presumably a justice of the peace, though he calls him a notary public) some time before Christmas, 1914. He says that he saw Hoenig put a die on the press and crimp two nails on it some two weeks after work on the dies had been started by him. Having described the die which was used, he then described the fins produced by it on the nail. He said in that connection that two halves of a knob were put together with a nail through it, and after the nail had been punched it left two little fins—the struck-up parts—one on each side of the nail. He thus indicated the invention of the issue. His testimony shows conception and disclosure by Hoenig before the middle of December, 1914, and reduction to practice as early as January 1, 1915.

J. T. Smith, after describing the invention by saying that it was a nail put through two parts of a knob, with two little "wickers" pressed on the nail, declared that he first saw it in Hoenig's machine-shop the first week in January, 1915, and he fixes the time by the circumstance that Hoenig was then back in his payments for some real estate which he had purchased from Smith in 1913. Hoenig in attempting to excuse his failure to make the payments when they became due, showed Smith the knob as a thing out of which he might get the money necessary to discharge the debt.

Worthen testified that he was also an employee of Hoenig; that he had talked with him about a patent knob in which he was interested, and then he described the knob by saying that it had a nail run through it—

and flattened out on the end or near the end. after it was assembled.

He fixes the time of the conversation by a job done by him for one Hammerton, but the year in which he did it is not satisfactorily established.

The other persons referred to above as being cognizant of what Hoenig had done were not called, but there is nothing to show that they were not available to Parker if he desired them. If C. C. Smith's story that he sued Hoenig for his wages near Christmas, 1914, was

not true, it was very easy for Parker to contradict it. He tied his testimony to Christmas. It is most improbable that the things related took place at Christmas, 1915, for that was after all the parties to the interference had filed. On the other hand, if they transpired at Christmas, 1913, it would place Hoenig ahead of his rivals beyond a doubt. Hoenig and his witnesses were not mistaken. They either told the truth or deliberately falsified, and there is nothing in the record which would warrant so harsh a conclusion as the latter. We agree with the Board of Examiners that the invention is a simple one and that any person by trying a specimen could determine at once whether or not it would stand the strains to which it would be subjected in actual use. The record establishes that Hoenig conceived and disclosed the invention before the middle of December, 1914; that he reduced to practice as early as January 1, 1915, and was diligent in the meantime.

It is asserted by Parker that even if Hoenig was the first to conceive and reduce to practice, he abandoned his invention. We do not think so. The burden of affirmatively providing abandonment is on him who asserts it. (*Hathanway v. Field*, C. D., 1919, 177; 261 O. G., 413, 48 App. D. C., 370, and cases there cited.) The only evidence upon which Parker relies in this regard is the failure of Hoenig for about ten months after reducing to practice to file his application. This failure, we think, is sufficiently explained by his financial condition already referred to.

The decision of the Patent Office is reversed and priority awarded to Harry Edward Hoenig.

Reversed.

Mr. Justice VAN ORSDER took no part in the consideration or decision of this case.

[Court of Appeals of the District of Columbia.]

LAMBERT v. HOPE AND LAMBERT.

Decided June 2, 1920.

278 O. G., 369; 50 App. D. C., —; 267 Fed. Rep., 342.

1. PATENTS—INTERFERENCE—BURDEN OF PROOF—INADVERTENTLY-GRANTED PATENT.

In an interference between an inadvertently-granted patent and an application filed jointly by the patentee and another prior to the filing of the application on which the patent was granted the burden of proof is heavily upon the patentee.

2. SAME—SAME—EVIDENCE OF JOINT OR SOLE INVENTORSHIP.

In an interference between Lambert, whose patent was inadvertently granted during the pendency of an application filed jointly by him and

Hope, evidence considered and *Held* that it failed to sustain Lambert's contention that he was the sole inventor.

Mr. Chas. C. Stauffer for the appellant.

Mr. Hervey S. Knight for the appellee.

VAN ORSDDEL, J.:

This appeal is from an award of priority to appellees Hope and Lambert for an invention relating to an apparatus for drying wood veneer, consisting of a rectangular housing in which the material to be dried is placed, and heated air, acting directly upon the material, is drawn through the housing by means of a radiator in one end of the housing and a fan in the other. The single count of the issue reads as follows:

A dry kiln comprising a rectangular shaped housing, a radiator located in one end of said housing forming an end way thereof and provided with opening through which air may be drawn, the opposite end of said housing closed by an end wall, and an exhaust fan connecting with the interior of said housing through said wall.

It appears that Hope and Lambert filed a joint application November 29, 1915, and thereafter Lambert filed an individual application on May 8, 1916, which inadvertently went to patent June 5, 1917, while the joint application was copending. Lambert gains nothing by the issue of the patent to him, and, being the junior party and in the position of assailing a prior application in which he joined as joint inventor, the burden is heavily upon him.

In view of the prior art, the Commissioner expresses doubt as to the disclosure of a patentable invention, but by reason of the issuance of the patent to Lambert sustains the interference on the authority of *in re Orcutt*, (C. D., 1909, 334; 141 O. G., 567; 32 App. D. C., 345.) On this point the Commissioner said:

The small advance over the prior art in accordance with this decision shall be assumed for the purpose of this controversy to be patentable, but the very small advance should be kept in mind in reading the testimony, for example, Lambert criticizes Hope because he (Hope) does not state specifically the feature or features he contributed or suggested to the joint invention of Hope and Lambert. In view of these references (patent to Zappert of May 19, 1896, and patent to Soverhill of October 10, 1893) it is questioned if Lambert can specifically state what novel features he has added to the prior art and as he is entitled to claim only what is novel as his invention, his testimony as to what he invented must be weighed in the light of the prior art.

The testimony has taken a wide range, but considering only that material to the very narrow advancement over the prior art, we find no basis upon which the contention of Lambert can be sustained. He totally fails in his attempt to carry reduction to practice back to an earlier structure of 1894. In his effort to eliminate Hope from inventive coöperation in the present 1915 structure, he stands alone;

while Hope is corroborated directly by his father and indirectly by Brown, the attorney, who prepared the joint application.

Without stopping to review the somewhat voluminous testimony, we fully agree with the conclusion of the Commissioner that—

Lambert joined Hope in executing the joint oath that they were joint inventors. As against Lambert's statement that this oath was fraudulently obtained, the two Hopes and Brown, the latter Lambert's own witness, deny this. The joint oath was not repudiated until Hope and Lambert quarreled, when Lambert filed his sole application. There is not a word of testimony to show that Lambert instead of Hope and Lambert invented anything novel over the prior art.

The decision of the Commissioner of Patents is affirmed, and the clerk is directed to certify these proceedings as by law required.

Affirmed.

[Court of Appeals of the District of Columbia.]

THE PROCTER AND GAMBLE COMPANY v. ENEY SHORTENING COMPANY.

Decided June 2, 1920.

278 O. G., 869; 50 App. D. C., —; 267 Fed. Rep., 844.

1. TRADE-MARKS—SIMILARITY—"ESCO" AND "CRISCO."

The mark "Esco" is so similar to "Crisco" as to be likely to cause confusion when used on substantially identical goods.

2. SAME—SAME—ORIGIN HAS NO BEARING ON QUESTION OF IDENTITY.

That a mark is made up of the initials of the corporation applying for registration with the termination "Co." has no bearing on the question of its identity with another mark.

Mr. Paul Finckel for the appellant.

Mr. E. T. Fenwick for the appellee.

SMYTH, C. J.:

From a decision of the Patent Office overruling the opposition of The Procter and Gamble Company to the application of Eney Shortening Company for the registration of the sign "Esco" as a trade-mark for a lard substitute, the former appeals.

The opposer shows that it is the owner of the sign "Crisco" as a trade-mark for a lard substitute, and alleges that as its goods are of the same descriptive qualities as the goods of the applicant, the marks being similar, confusion would be likely to result in the minds of the public with respect to the origin of the goods upon which the marks appeared, and that, in consequence, the opposer would be damaged thereby, (33 Stat. L., 725, chap. 592, secs. 5 and 6.) The Examiner of Interferences sustained the opposer, but he was reversed

by the First Assistant Commissioner, who held that no likelihood of confusion had been shown.

It is conceded that the goods are substantially identical. The only question, then, is as to whether or not the two marks are so similar as to be likely to produce confusion in the minds of purchasers with respect to the origin of the goods upon which they are used. As no testimony was taken we must determine it by an inspection of the marks themselves. What constitutes objectionable similarity in marks has been so often considered by this court (*Wayne County Preserving Co. v. Burt Olney Canning Co.*, C. D., 1909, 318; 140 O. G., 1003; 32 App. D. C., 279; *Phoenix Paint & Varnish Co. v. John T. Lewis & Bros. Co.*, C. D., 1909, 303; 139 O. G., 990; 32 App. D. C., 285; *Kaut-Reith Shoe Co. v. International Shoe Co.*, C. D., 1917, 162; 239 O. G., 939; 45 App. D. C., 545; *Thomas Manufacturing Co. v. Aeolian Co.*, C. D., 1918, 157; 249 O. G., 505; 47 App. D. C., 376; *William Waltke & Co. v. George H. Schafer & Co.*, see *ante*, 167; 263 Fed. Rep., 650) that we do not deem it necessary to enter upon a discussion of it here. For the reasons given in those decisions we hold that the use of the marks before us upon the goods to which they are applied in this case would be likely to produce confusion. Even if we doubted it, we would still rule in favor of the opposition on the authority of *William Waltke & Co. v. George H. Schafer & Co.*, *supra*, and *Lambert Pharmacal Co. v. Mentho-Listine Chem. Co.*, (C. D., 1918, 147; 247 O. G., 965; 47 App. D. C., 197).

The applicant says that its mark is made up "of the initials of the corporation with the termination Co.; Eney Shortening Co., Esco," and seems to think that there is something in that which should entitle it to have the mark registered, but we perceive no force in the suggestion. The trade-mark statute takes no account of the origin of a mark. The question is, Would its use be likely to result in confusion? If so, it is unregistrable. As was said by the Examiner of Interferences, the—

consuming public know little and care less about the origin of any mark and very seldom if ever take it into consideration.

The statute does not contemplate that the public should do so.

The decision of the Patent Office must be reversed and the opposition sustained.

Reversed.

[Court of Appeals of the District of Columbia.]

HOENIG v. KENDIG.

Decided June 2, 1920.

278 O. G., 545; 50 App. D. C., —; 267 Fed. Rep., 326.

PATENTS—INTERFERENCE—PRIORITY.

In an interference between H. and K. priority of invention awarded to H. on the ground that he was the first to conceive and was diligent up to the time of his reduction to practice.

Mr. E. Hume Talbert for the appellant.

Mr. J. C. Bradley for the appellee.

SMYTH, C. J.:

Hoenig appeals from a decision of the Patent Office awarding priority to Kendig. The invention relates to two-part insulators and means for holding the parts in assembled relationship. It is expressed in one count:

In combination in an insulator, base and cap portions having perforations extending therethrough, and a metal fastening member comprising a shank extending through the perforations and provided at the end carrying the cap with an integral head which will not pass through the perforation in the cap and provided at the other end with a point, the said shank being provided with a struck-up portion positioned so as to engage the base and prevent the withdrawal of the fastening member therefrom.

The means consist of a nail passing through perforations in the cap and base portions, and a struck-up portion on the shank of the nail for engaging the base to prevent the withdrawal of the nail therefrom. This interference is a companion of the interference between *Hoenig v. Parker*, this day decided, (*ante*, 234,) and was submitted on the same testimony. The Examiner of Interferences decided in favor of Kendig. The Board of Examiners reversed him and awarded priority to Hoenig. The First Assistant Commissioner overruled the Board and affirmed the action of the Examiner of Interferences.

Hoenig claims conception about the middle of November, 1914, and reduction to practice not later than January 1, 1915. Kendig's earliest date is February 20, 1915. In the companion case we held that Hoenig was entitled to conception and disclosure before the middle of December, 1914, and reduction to practice as early as January 1, 1915, and that he was diligent in the meantime. Our view of the testimony and the law in that case is controlling here.

The decision of the Patent Office is reversed, and priority awarded to Harry Edward Hoenig.

Reversed.

Mr. Justice VAN ORSDER took no part in the consideration or decision of this case.

[Court of Appeals of the District of Columbia.]

WELLS AND HUNTER v. HONIGMANN.

Decided June 2, 1920.

280 O. G., 590; 50 App. D. C., —; 287 Fed. Rep., 743.

1. PATENTS—RENEWAL APPLICATION ENTITLED TO BENEFIT OF DATE OF ORIGINAL AS A CONSTRUCTIVE REDUCTION TO PRACTICE.

A renewal application, although filed twenty-three months after the allowance of the original application, is entitled to the benefit of the filing date of the original as a constructive reduction to practice, notwithstanding the fact that another had been granted a patent for the same invention during the period of forfeiture, in the absence of proof of facts showing an abandonment of the invention.

2. SAME—RENEWAL APPLICATION—PATENT GRANTED DURING FORFEITURE—ABANDONMENT OF INVENTION A QUESTION OF FACT.

The failure of an applicant to renew a forfeited application for twenty-three months after allowance of the original does not of itself effect an abandonment of the invention even in favor of one who takes out a patent for the same invention during the period of forfeiture, the question of abandonment being one of fact, which must affirmatively appear and cannot be presumed from mere delay.

3. SAME—ESTOPPEL—COPYING CLAIMS OF A PATENT.

The time for filing a divisional application for matter claimed in a patent taken out by another, fixed by the Court of Appeals of the District of Columbia in *Rowntree v. Sloan*, (C. D. 1916, 192; 227 O. G., 744; 45 App. D. C., 207) and *Wintroath v. Chapman* (C. D., 1918, 154; 248 O. G., 1004; 47 App. D. C., 428) at one year from the date of the patent, in analogy to the provisions of Revised Statutes, 4894, was extended by the Supreme Court to two years by analogy to other statutes which were regarded as more pertinent.

4. SAME—SAME.

The ruling of *Rowntree v. Sloan* (C. D., 1916, 192; 227 O. G., 744; 45 App. D. C., 207) could not properly be applied to the case of a renewal application, since the statute (sec. 4897, Rev. Stats.) expressly gives two years within which a renewal application may be filed.

Mr. Melville Church for the appellants.

Mr. A. S. Pattison for the appellee

VAN ORSDEL, J.

This appeal is from the decision of the Commissioner of Patents awarding priority of invention to appellee Honigmann. The counts involved in the appeal relate to certain improvements in printing-presses. It is unnecessary to set out the counts or explain the invention, since the appeal turns upon questions of law.

The application here involved was filed September 2, 1914, by Frederick W. Hunter and the estate of Pierson L. Wells, deceased. It is a renewal of an application filed by Wells and Hunter Decem-

ber 16, 1907, and allowed September 28, 1912, but which became forfeited March 28, 1913. On December 1, 1914, the Patent Office called to the attention of Wells and Hunter certain claims of a patent issued to Honigmann on October 7, 1913. Wells and Hunter promptly adopted the claims, and the present interference was declared.

Honigmann's alleged date of conception was subsequent to the date of the original Wells and Hunter application. Hence, he was ordered to show cause why priority should not be awarded Wells and Hunter on the face of the record. Honigmann responded with a motion to dissolve the interference on the ground that Wells and Hunter could not make the claims. This motion was denied by the Law Examiner, and, upon final hearing before the Examiner of Interferences, priority was awarded to Wells and Hunter.

An appeal was taken to the Board of Examiners-in-Chief. But, after argument, and before decision was reached, Honigmann filed a motion for reargument. The case had been submitted upon the single ground of the right of Wells and Hunter to make the claims, but the motion contested their right to make the claims in view of a disclaimer filed February 8, 1910, of certain claims in the original application; and on the further grounds of abandonment, because the Wells and Hunter application had remained in a forfeited condition for twenty-three months; and laches, in that Wells and Hunter did not adopt the claims of the Honigmann patent until more than a year had elapsed after the issue of the patent. Reargument was granted, and the Board held that Wells and Hunter had a right to make the claims, and that such right was not affected by the disclaimer. On the grounds of abandonment and laches the holding was in favor of Honigmann. On motion of Wells and Hunter, the Commissioner of Patents remanded the case to the Examiner of Interferences to take testimony on the questions of abandonment and laches.

The Examiner, on the testimony taken, decided the case adversely to Wells and Hunter on the issues of abandonment and laches. On appeal, the Board of Examiners-in-Chief reaffirmed their previous decision holding that Wells and Hunter had the right to make the claims and were not barred by the disclaimer or guilty of laches; but affirmed the Examiner on the ground that there had been an abandonment between the forfeiture of Wells and Hunter's original application and the filing of the renewal.

On appeal, the Commissioner held that the issuance of the Honigmann patent during the time the Wells and Hunter application remained forfeited amounted to abandonment of their right to give the renewal application the benefit of the filing date of the original

application as a date of constructive reduction to practice, and further that they were guilty of laches in not making the claims of the Honigmann patent until seventeen months after its issue.

We agree with the tribunals below in holding that Wells and Hunter have a right to make the claims in issue and that they are not estopped from making the claims of the present issue by the disclaimer of February 8, 1910. The Commissioner, holding the disclaimed claims broader than the counts of the issue, and therefore, not a bar, declared that the—

disclaimed matter is in broader terms than the counts, and although this broad invention might have been made by Wells alone, that does not negative the proposition that the more specific subject of the issue was invented by Wells and Hunter jointly, but even if the disclaimer had covered the identical invention, that would not prevent Wells and Hunter from recalling and cancelling the disclaimer provided it was done before the public or a third party came into possession of the invention, and, as pointed out by the Examiners-in-Chief, Wells and Hunter in filing their preliminary statement, as well as in their act of making these claims, would have set aside the effect of this disclaimer, even if the disclaimer had reached to the subject-matter of the counts which it did not for reasons before pointed out.

We come now to the more difficult question of forfeiture or abandonment. It appears that Wells and Hunter permitted their application to become forfeited on March 28, 1913. A renewal application was filed September 2, 1914, about twenty-three months from the date of the allowance of the original application. Abandonment is predicated upon the delay in filing the renewal, and also upon the fact that the Honigmann patent was issued during the period when the Wells and Hunter application remained forfeited. Section 4897, Revised Statutes United States, provides:

Any person who has an interest in an invention or a discovery, whether as an inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. But no person shall be held responsible in damages for the manufacture and use of any article or thing for which a patent was ordered to issue under such renewed application prior to the issue of the patent. And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact.

It is clear that Wells and Hunter had two years from the date of the allowance of the original application to file a renewal, subject to the single condition of abandonment, which, however, can only "be considered as a question of fact." It is not seriously contended that the evidence discloses any intention on the part of Wells and Hunter

to abandon their invention. The original application was forfeited upon the advice of counsel, and during the period of forfeiture one Merrick, who contracted with Hunter and the Wells estate for an interest in the patents to be secured, was engaged in bringing the machine into marketable form. Though Merrick seems to have made slow progress, Hunter and one Watson, on behalf of the Wells estate, were constantly urging Merrick to speedier action. No proof has been adduced from which the intention of abandonment can be inferred.

The tribunals below also based their finding of abandonment upon the fact that during the period of forfeiture Honigmann's patent was issued. Wells and Hunter are here standing upon an affirmative statutory right, of which they cannot be divested except in a way provided in the statute. In *Cutler v. Leonard* (C. D., 1908, 483; 136 O. G., 438; 31 App. D. C., 297) this court, considering the rights conferred by section 4897, said :

This right can be taken away only by a finding of abandonment, which, the statute ordains, must be determined as a question of fact. Where an affirmative right is conferred by law, we think a finding of abandonment must be predicated (upon) facts and circumstances warranting such a finding, and not upon mere presumption.

Speaking generally of the rights conferred by Congress upon inventors through the patent statutes, the Court, in *United States v. Telephone Co.*, (C. D., 1897, 442; 79 O. G., 1362; 167 U. S., 224) said :

A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public.

This is not the case of a secreted invention brought to light by the issuance of a patent to another, as in *Mason v. Hepburn*, (C. D., 1898, 510; 84 O. G., 147; 13 App. D. C., 86.) There, the first inventor was not protected by an express statutory period, as in the present case. The mere issuance of a patent to another will not interfere with the rights of an inventor during the period of forfeiture provided by section 4897, except upon the single ground of abandonment as matter of fact, which does not appear in this case.

But the Commissioner held Wells and Hunter estopped under our decisions in *Rowntree v. Sloan*, (C. D., 1916, 192; 227 O. G., 744; 45 App. D. C., 207,) and *Wintroath v. Chapman*, (C. D., 1918, 154; 244 O. G., 1004; 47 App. D. C., 428.) Our position in these cases has been rejected by the Supreme Court in the recent case of *Chapman v. Wintroath*, (*post*, 465; 272 O. G., 913; 252 U. S., 126,

present term.) In these cases we held that where an original application discloses, but does not claim, matter contained in a later patent, the time for filing a divisional application should be limited to one year by analogy to the time fixed for filing amendments. (Rev. Stat. U. S., sec. 4894.) This time was extended to two years by the higher court by analogy to other statutes which were regarded as more pertinent.

There was, however, no basis here for the application of the Rown-tree case, since the statute (sec. 4897) expressly gives two years within which a renewal application may be filed. Hence, there is no room for the rule of analogy. At the date of filing the renewal, less than two years had elapsed from the allowance of the original application, and as abandonment in fact has not been established, Wells and Hunter were well within their statutory rights.

The decision of the Commissioner of Patents is reversed, and the clerk is directed to certify these proceedings as by law required.

Reversed.

[U. S. Circuit Court of Appeals—Sixth Circuit.]

D'ARCY SPRING CO. *et al.* v. MARSHALL VENTILATED MATTRESS CO.

Decided January 7, 1919.

270 O. G., 347; 259 Fed. Rep., 236.

1. PATENTS—CONSTRUCTION—VALIDITY.

The Marshall patent, No. 685,160, for a mattress comprising a cover and a plurality of transversely-extending strips of material stitched at intervals to form pockets, etc., and spiral springs arranged in such pockets, *Held* valid, showing invention.

2. SAME—DESCRIPTION—SUFFICIENCY.

Though the patentee did not anticipate the use to which the patented article could be and was put, he is entitled to protection for such use where the adaptability was inherent in the structure shown and described in claims and specifications.

3. SAME—CLAIMS—LIMITATION.

Where a claim defines an element in terms of its form, material, location, or function, thereby apparently creating an express limitation, and the limitation pertains to the inventive step rather than to its environment and imports a substantial function which the patentee considered of importance, forms excluded cannot be considered covered by the patent under the doctrine of equivalency.

4. SAME—INSTRUCTION—LIMITATIONS.

The Marshall patent, No. 685,160, for a mattress comprising a cover and a plurality of transversely-extending strips of material stitched at intervals to form pockets, the pocket of one strip alternating with those of adjacent strip, and spiral springs arranged in such pockets, *Held* limited therein to that form of arrangement and not to be infringed by a mattress

similarly constructed where the pockets were arranged with centers equidistant in right-angled directions, so that there was no nesting of the springs.

5. SAME—INFRINGEMENT—DAMAGES.

The president and general manager of a corporation which infringed a patent is not individually liable for damages and profits on infringement unless he inflicted the damages or received the profits otherwise than through the usual relations between officer and corporation.

6. SAME—INFRINGEMENT SUIT—DEFENDANT.

In a suit against a corporation for infringement of patent the president and general manager, in active control of the corporate affairs, may be made defendant, so that he may be personally bound and enjoined.

APPEAL from the District Court of the United States for the Southern Division of the Western District of Michigan; Clarence W. Sessions, judge.

Suit by the Marshall Ventilated Mattress Company against the D'Arcy Spring Company and others. *From a decree for complainant, defendants appeal. Decree reversed, in order that new decree may be entered, modified according to the opinion.*

Mr. Otis A. Earl for the appellants.

Mr. Taylor E. Brown for the appellee.

Before WARRINGTON, KNAPPEN, and DENISON, Circuit Judges.

DENISON, *Cir. J.*:

Patent No. 685,160 was issued October 22, 1901, to Marshall, and became the property of appellee, who was plaintiff below. It disclosed a mattress or other cushion having a suitable cover, and the resilient body of which was composed of a mass of vertical spiral springs; each spring being contained in a cylindrical pocket of fabric closed at the top and bottom, and several of the pockets being fastened together at their sides, so that they constituted a strip or row of pockets. This was accomplished by taking two strips of fabric of suitable width and imposing one upon the other, or by folding longitudinally upon itself a strip twice as wide, and then stitching transversely at intervals across this double strip. Thus a row of pockets was created, and, after the springs were inserted therein, the ends were closed by whatever further stitching might be necessary. The single claim is:

A mattress comprising a cover and a plurality of transversely extending strips of textile material arranged therein and stitched at intervals to form pockets having closed ends, the pockets of one strip alternating with those of the adjacent strip, and spiral springs arranged in said pockets, substantially as described.

The court below found validity and infringement, and the defendants bring this appeal.

(1,2) We agree with the court below that the patent involves invention and should be sustained. A strip of fabric, thus transformed into a unitary series of pockets containing springs, was new, and it has proved to have large commercial utility. Perhaps this utility and extensive use have developed from a method of business not described in the patent or anticipated by the patentee, viz. selling the prepared spring-containing strip as raw material suitable to be made up into a mattress or cushion; but this adaptability was inherent in the structure shown and described, and the patentee's lack of complete prevision is not important. (*Goshen Co. v. Bissell Co.*, C. C. A. 6; 72 Fed. Rep., 67; 19 C. C. A., 13.)

(3,4) We cannot give to the presence in the claim of the element, "a cover," the limiting effect which defendants attribute to it. The mattress-cover shown in the drawing represented only the familiar environment or field provided for the operation of the mass of covered springs which represented the substance of the invention; and any of the varieties of cover found in the defendants' structures (when finished as intended) must be considered within the inventor's meaning, when he referred to a "cover."

The difficult question is presented by the clause of the claim which reads, "the pockets of one strip alternating with those of the adjacent strip." Obviously, there are two ways in which these rows or strips of pockets may be assembled in order to make a quasi-unitary support for a cushion-top: They may be put together alined, with pocket-centers equidistant in both right-angled directions, or the second row may be moved longitudinally one-half the width of a pocket, and then each pocket will enter partially between two pockets of the first row. In the former case, the rows are wholly distinct from each other and are spaced in both directions the extreme width of the pocket; in the latter case, the pockets of one strip alternate with those of the adjacent strip and the strips have broken joints, or it may be said that the pockets are staggered and nested. The question is whether the finding of infringement should be confined to those structures which have the pockets thus staggered (defendants' first form,) or whether those which have the pockets of the first class described (defendants' second form) are so fully the equivalent of the staggered style that they cannot escape. The trial court adopted the latter view.

The rule that an express limitation may not be disregarded and the rule that a form equivalent to a specified form also infringes often seem to come into conflict. There is no fixed formula by which this conflict can be settled, but it must be determined by finding the true meaning of "equivalency" in the case to be decided. In a very fair sense and as to most of the functions involved, it is immaterial

whether strips of pockets are arranged in alternate or opposite mutual relation. Considering the scope of the actual invention and of claims which might well have been formulated, there would be little difficulty in finding in defendants' second form the necessary equivalency upon which to predicate infringement, if it were not for the expressly stated requirement about the relative positions of the strips. We assume, as hereafter stated, that this requirement was not inserted under such circumstances as to estop the patentee from asserting his present theory. It follows that the case is to be treated as one of voluntary and unnecessary limitation.

It seems worth while to review briefly some of the controlling or leading cases upon each side of the subject and upon which the parties, respectively, rely. In *Winans v. Denmead* (15 How., 341; 14 L. Ed., 717) a claim to the frustum of a cone was held to include as an equivalent the frustum of an octagonal pyramid. It is doubtful whether there was so much discrepancy between the letter of the claim and the defendant's form as has been thought, since a cone is a pyramid with an infinite number of sides, or, as cited in the opinion, "a polygon of many sides would be equivalent to a circle;" but, passing by this feature of identity, it is clear that the difference was merely in form, and that, in operation and functions and effect, the two were identical. The difference in form did not stand for anything else, and a rule of equivalency so strict as to exclude from the monopoly one form and include the other would tend to raise doubt as to the existence of any patentable invention.

In *Metallic Co. v. Brown* (C. C. A., 18; 104 Fed. Rep., 845; 43 C. C. A., 568) the claim called for an element located at the side of the horizontal roasting-chamber, but the rule of equivalency served to bring within this claim a structure in which this element was underneath the chamber. Here, also, it may be noted that there was not even a literal inconsistency, since the word "side" is often applied to the top and bottom sides as well as to the horizontal sides; but again there was no function whatever indicated by the location at the horizontal side as distinguished from the location underneath. There was no room to suppose that the inventor could have thought that the location be specified was material to his invention and thus no room to say that he intended to make it material. The conclusion was not to be escaped that the inventor used the term only because it was appropriate for the specific form which happened to be before him.

In *Bundy Co. v. Detroit Co.* (94 Fed. Rep., 524; 36 C. C. A., 375) this court disregarded the superficial distinction between a key which is rotated and one which is pushed longitudinally. Here, again, there was nothing whatever new in the form or motion of the key; the inventor's forward step pertained to another feature of the mechanism and was to be operated equally well by either form of key. It

was in effect held that the specific form of claim reference to an element which was not an inherent part of the new step, but only pertained to a working field therefor, would not be permitted to dominate except in the plainest case.

In *Schieble Co. v. Clark* (C. C. A. 6; 217 Fed. Rep., 760; 133 C. C. A., 490) the claim called for a driving-shaft in combination with two pairs of running wheels, and the defendant brought the driving-shaft into direct relation with one pair of running wheels only; but he had had the other two running wheels upon his structure, and all their functions with relation to the driving-shaft were performed by a pair of supplementary and otherwise unnecessary rollers. The case does not go as far as some of the others do in disregarding distinctions plausibly claimed.

In *Keystone Co. v. Phoenix Co.* (C. D., 1887, 384; 12 O. G., 980; 95 U. S., 274; 24 L. Ed., 344) the claim called for "wide and thin drilled eyebars * * * applied on edge." Defendant used round bars, flattened at the ends where eyes were drilled, and (apparently) placed on edge. Though the two forms were equivalent enough in a general way, yet since it appeared that the "wide and thin" form had thereby additional utility, the claim was limited to the form specified.

In *White v. Dunbar* (C. D., 1886, 494; 37 O. G., 1002; 119 U. S., 47; 7 Sup. Ct., 72) the claim specified a lining of textile fabric; defendant used a lining of paper. The main object of the invention was accomplished just as well by the paper as by the cloth; but the court, in its often-cited "nose of wax" opinion, held that they were not equivalents. The principle seems to be that since cloth and paper are not always equivalent and since cloth has distinctive qualities which the patentee might have considered important, he would not be allowed to escape his express declaration that he claimed cloth only. This court has often applied the same rule.

A recent instance is found in *Arnold-Creager Co. v. Barkwill Co.*, (246 Fed. Rep., 441; 158 C. C. A., 505.) Here the claim provided that certain elements should be located on the end of the material-reservoir, while defendant located them upon the side. This court considered the change sufficient to escape infringement, even though, in a broad sense, there was equivalency. We thought that, by his specification, the inventor had indicated his intent that the elements should be upon the end and his belief that there was substantial and material advantage in having them so located; and we observed that to transfer these elements to the side would require considerable reorganization of the machine and would entirely do away with certain simplicities of construction and directness of action which the inventor had believed important. Under those circumstances, we thought we could not disregard the distinction which the patentee had adopted.

Two of our decisions are urged upon us—one by each party—as controlling; but we do not so regard either, when applied to a case of voluntary limitation. *Vanmannen v. Leonard* (248 Fed. Rep., 939; 161 C. C. A., 57) was a case of estoppel by proceedings in the Patent Office. Whether the patentee would have been held so closely to his specified form if his selection had been voluntary and casual, rather than as evidencing the ground upon which he distinguished the reference and secured his patent, need not be considered. The *Vrooman-Penhollow Case* (179 Fed. Rep., 296; 102 C. C. A., 484) is also rightly to be thought of as presenting the question of estoppel. The patent issued with a requirement that one named roller should be of “much smaller diameter” than another named roller, and the defendant had the two of the same size. This requirement was inserted after a certain reference had been made, but the court thought it did not in fact serve to distinguish from the reference, and that since it could not have been plausibly thought to import differentiation and since the reference was amply distinguished otherwise, and the difference in size had no function whatever, the patentee could not be charged with having represented the relative size of the rollers to be a patentable difference. It was therefore held that there was no estoppel to prevent the patentee from afterward claiming that the two forms were equivalent. If it had appeared to the court that the “smaller diameter” was—or that the inventor probably thought it was—important to the full accomplishment of his theory of the machine, there would have been a different case presented.

From a review of these and other familiar cases, we think it is safe to deduce the proposition that where the claim defines an element in terms of its form, material, location or function, thereby apparently creating an express limitation, where that limitation pertains to the inventive step rather than to its mere environment, and where it imports a substantial function which the patentee considered of importance to his invention, the court cannot be permitted to say that other forms, which the inventor thus declared not equivalent to what he claimed as his invention, are nevertheless to be treated as equivalent, even though the court may conclude that his actual invention was of a scope which would have permitted the broader equivalency. Applying this rule, we find that placing the transverse rows of pockets in this alternate nested relation requires the rows to be set about one-fourth closer together than if alined, and therefore increases the cost of filling the required cushion-surface. Certainly this disadvantage would not have been specified, unless it was important. Its distinct utility lies in the fact that a large part of the space which would otherwise be unoccupied between the upper coils of the springs is filled with similar springs, so that the supporting-

surface becomes considerably more unitary and the effect is correspondingly smoother and more uniform, and in the further fact that when the springs are thus placed in much closer contact, the pocket is more especially useful in preventing intermeshing of the springs. and in the further fact that when thus placed the spring-containing pockets mutually support each other in their upright position in distinctly-greater degree than if they did not have the close-fitting alternate relationship.

We think the conclusion must follow that the expressly-stated limitation cannot be overcome by applying the rule of equivalency, and that the patentee intended and understood his monopoly to be confined to a structure in which the springs had the alternate relationship which he specified. We are confirmed in this conclusion as to his intent by what occurred in the Patent Office. He urged upon the Examiner the presence of this limitation as a reason for distinguishing from a reference; the Examiner replied that the distinction did not import patentable novelty, and the subject-matter was thereafter dropped from discussion, yet the limitation was retained until the end; and Marshall, therefore, after the subject had come to his attention, declared his belief that the distinction was important. Though there may not be much real difference between relying upon an existing claim detail to avoid a reference and inserting a new detail for the same purpose, yet it is the latter action which creates the ordinary estoppel, and we assume, without deciding, that the record does not show that technical estoppel which often has been developed in this class of cases.

Plaintiff urges that this limitation pertains not to a mechanical element but only to a matter of location, and, hence, that a more liberal rule of equivalency should be applied. We cannot see that it is doctrinally important whether the element said to be missing in defendants' structure is a mechanical element or any other kind of an element. The matter of location or mutual arrangement may be less often vital than the matter of presence of a mechanical part, but this will be because of the peculiar facts of the case and not because of any general rule. Plaintiff also urges that the claim is sufficiently met if the pockets are capable of alternation, even though not so assembled, and says that the pockets which are alined in defendants' cushion (second form), as marketed, will, with use, fall into nested position. If this result happens, it is incidental and accidental. Owning to the difference in top area occupied by the springs in the two methods, it is evident that any partial shifting from the alined to the nested position injures the cushion. This cannot be intended. Marshall's thought that the cushion-cover needed that more perfect support given by the nested, as compared with the alined, form is

further shown by his later patent, issued on a copending application, in which he showed and claimed the alined form, provided with supplementary smaller springs, arranged to fill the openings between the larger ones.

The second form must be held to be non-infringing.

(5, 6) The individual defendant, D'Arcy, the president and general manager of the corporation, was held personally liable for accounting as well as for injunction. This is complained of here, although it is not entirely clear that the point was ever brought to the attention of the district judge. It is the rule in this circuit that such individual liability for damages and profits on infringement does not exist unless the officer inflicted the damages or received the profits otherwise than through the usual relations between officer and corporation. (*McSherry Co. v. Dowagiac Co.*, 160 Fed. Rep., 948; 89 C. C. A., 26.) There is neither allegation nor proof of any extraordinary relation in this respect, and the accounting for profits and damages should not have been ordered against D'Arcy. As to the propriety of making such a managing and directing officer as D'Arcy was a defendant in order that he may be personally bound and enjoined, we have already expressed our approval of the view in the first circuit, rather than that in the seventh. (*National Co. v. Leland*, C. C. A., 194 Fed. Rep., 502; 37 C. C. A., 372; *Cazier v. Mackie Co.*, C. C. A., 7; 138 Fed. Rep., 654; 71 C. C. A., 104; *Proudfit Co. v. Kalamazoo Co.*, C. C. A., 6; 230 Fed. Rep., 120; 144 C. C. A., 418.) For this purpose and to this extent we consider D'Arcy an "active participant," within the exception specified in *Western Co. v. Northern Co.*, (C. C. A., 6; 135 Fed. Rep., 80; 67 C. C. A., 553.) If so, he is liable for the costs of the defense which he actively directed. The exemption from costs which we sanctioned in *Ohmer Co. v. Ohmer* (238 Fed. Rep., 182; 151 C. C. A., 258) had reference to the costs of this court on appeal.

An injunction is now immaterial, the patent having expired. The decree should be modified, by excepting therefrom articles like plaintiff's Exhibit 17 and by denying D'Arcy's liability to account; in other respects, it should be affirmed.

We do not undertake to consider the extent of damages involved in a cushion in which part of the strips were in alternate relation and part were not. That question has not been argued and can not be considered as arising on this record.

The decree below is reversed, in order that a new decree may be entered, modified according to this opinion. Appellants will recover costs.

[U. S. Circuit Court of Appeals—Seventh Circuit.]

KNIGHT SODA FOUNTAIN CO. v. WALRUS MFG. CO.

Decided April 4, 1919.

270 O. G., 350; 258 Fed. Rep., 929.

1. PATENTS—VALIDITY AND INFRINGEMENT—COMBINED JAR AND DIPPER.

The Faries patent, No. 779,271, for a jar and dipper for serving crushed fruit, etc., claim 3 *Held* not infringed. Claims 4 and 5 *Held* invalid for indefiniteness in view of the prior art.

2. SAME—MEASURE OF INVENTION—DEFINITENESS OF CLAIMS.

A patent is sustained not for what the inventor may have done, in effect, but for what is pointed out clearly and distinctly in his claims. As much as is not so claimed belongs to the public.

APPEAL from the District Court of the United States for the Eastern Division of the Northern District of Illinois.

Suit in equity by the Walrus Manufacturing Company against the Knight Soda Fountain Company. *Decree for complainant, and defendant appeals. Reversed.*

Mr. Donald M. Carter for the appellant.

Mr. Harry Lea Dodson for the appellee.

Before BAKER, ALSCHULER, and EVANS, Circuit Judges.

EVANS, *Cir. J.*:

The patent to Faries, No. 779,271, relates to a jar and dipper for serving crushed fruit, etc. Claims 3, 4, and 5, held valid and infringed, read as follows:

3. The combination of a jar, a cover for the jar, a rod extending below the cover, a dipper on the lower end of the rod, with its dipping edge extended away therefrom, and a handle above the cover, rigidly connected with the rod and shaped to aid in lifting the dipper in a proper filling and emptying position.

4. The combination of a jar having a wide mouth, a cover for the mouth of the jar, a rod attached to the cover and extended downward therefrom, and a dipper on the lower end of the rod, inclined to the rod at such an angle that, when the rod is against a side of the mouth of the jar, the dipper may be made to assume an approximately horizontal position.

5. The combination of a jar having a wide mouth, a cover for the mouth of the jar, a rod attached to the cover and extended obliquely downward therefrom, and a dipper on the lower end of the rod, inclined to the rod at such an angle that the dipper may be made to assume an approximately horizontal position inside the jar.

(1) Unquestionably the patent is very narrow. Only the precise form of construction described in each claim is protected. No wide range of mechanical equivalents can be indulged in. So construing

the claims of the patent, we conclude that claim 3 is not infringed, because neither the last-named element—

and a handle above the cover rigidly connected with the rod and shaped to aid in lifting the dipper in a proper filling and emptying position,

nor its mechanical equivalent, appears in the appellant's structures.

As to claims 4 and 5 an examination of the file-wrapper is instructive. As first presented, patentee sought a patent covering, among other claims:

The combination of a jar, a cover for the jar, a dipper adapted to be inserted into the jar, and a connection between the dipper and the cover.

Upon a division being ordered, and with several patent citations confronting him, applicant amended his specifications by inserting:

One object of the invention is to provide a jar and dipper so shaped and proportioned that the dipping edge of the dipper may be presented downward to receive a filling of the contents of the jar, and the dipper may be raised in an approximately horizontal position by placing the back of the dipper rod against a side of the mouth of the jar.

And also:

By making the bottom of the jar concave and shaping the ladle to conform in a general way to the concave surface, the entire contents of the jar may be readily removed.

Patentee struck from his specifications the language:

One object of the invention is to provide a jar with a combined cover and dipper so disposed that the cover will always be on when the dipper is in.

and—

Another object is to provide means for sustaining the jar in a vertical position, and still another object is to provide a readily attachable label plate to designate the contents of the jar.

Claims covering generally the combination of the jar, the cover, and the dipper, with the latter two connected, were withdrawn after the broadest claim heretofore quoted was rejected.

Novelty, if any exists in claim 4, resides in the combination by virtue of the last clause of the claim describing the angle formed by the attachment of the dipper to the lower end of the rod. In view of the use of the word "oblique" in claim 5, the word "downward" in claim 4 may well be construed as meaning perpendicular to the cover. It seems to us that the element—

and a dipper on the end of the rod inclined to the rod at such an angle that when the rod is against a side of the mouth of the jar the dipper may be made to assume an approximately horizontal position—

is so indefinite and vague as to necessitate rejection of this claim.

(2) A patent is the creature of the statute. The terms and conditions upon which the grant is made are fixed by the statute. Section

9432, Compiled Statutes, 1918, requires the inventor to set forth his claims in—

such full, clear, concise, and exact terms as to enable any person skilled in the art * * * to make, construct, compound, and use the same.

What is not claimed distinctly in the invention, the public possesses. A patent is sustained, not for what the inventor may have done in effect, but what is pointed out clearly and distinctly in his open letter. (*White v. Dunbar*, C. D., 1886, 494; 37 O. G., 1002; 119 U. S., 47, 51; 7 Sup. Ct., 72; *McCarty v. Lehigh Valley R. Co.*, C. D., 1895, 721; 73 O. G., 1707; 160 U. S., 110; 16 Sup. Ct., 240; *Proudfit Looseleaf Co. v. Kalamazoo Looseleaf Binder Co.*, 230 Fed. Rep., 120; 144 C. C. A., 418; *Houser v. Starr*, 203 Fed. Rep., 264; 121 C. C. A., 462; *National Cash Register Co. v. Gratigny*, 213 Fed. Rep., 463; 130 C. C. A., 109; *Harder et al. v. United States Piling Co.*, 160 Fed. Rep., 463; 87 C. C. A., 447; *Avery & Sons v. J. I. Case Plow Works*, 148 Fed. Rep., 214; 78 C. C. A., 110.)

While we may give liberal construction to the language used to protect the inventor, we cannot rewrite the claim, or insert an element or modify an element in the combination upon which alone validity depends. Words that describe a result may, of course, be adjective in character, that is, modifying in meaning, yet they must be definite and understandable. In this claim the words last quoted describe an angle formed by the rod and the dipper. Just what angle may not necessarily be defined, provided it is ascertainable by placing the rod against the mouth of the jar and the dipper assume a horizontal position. Unfortunately for claims 4 and 5, almost any angle will meet this test, especially if the mouth of the jar be made wide enough and the position of the dipper at the bottom of the jar be changed.

Had applicant included in the combination a jar with a concave bottom, and the dipper so attached to the lower end of the rod that it would fit in the concave bottom of the jar (such as was contemplated by the amended specifications,) and the other elements appeared, a different question would have been presented.

In claim 5 the rod extends obliquely downward and the dipper on the lower end of the rod is inclined at such an angle that it may be made to assume an approximately horizontal position inside the jar. Here again the angle formed by the attachment of the dipper to the rod may vary widely and the described results still be obtained, provided the mouth of the jar be relatively large or the operator change the position of the dipper.

Nor can we ignore the prior art, even though no exact anticipation appears therein. Wettstein, in his patent, No. 356,514, covered a

combination quite similar in purpose and in construction. In his specifications he says:

My invention relates to a device for measuring and conveying liquids and small loose solid substances from one bowl or receptacle into another in an easy manner, and to provide a suitable covering for the same where required—such as cream or milk pitchers, sugar bowls, or other receptacles containing liquid or solid food—the object being to exclude impurities and also flies and other insects and vermin therefrom; another object of the device being that it is so constructed that, when the spoon or scoop is replaced into its proper receptacle, the cover is placed thereon at the same time, where said scoop is used in combination with the cover.

White secured a patent covering caps and spoons for mustard-bottles. His top and his spoon were attached. Necessarily the dipper and the rod constituting the spoon formed an angle, and whether the dipper was “approximately horizontal” would depend upon the position of the rod at its place of connection with the top. Likewise the width of the mouth of the container necessarily determined to a certain degree whether the dipper would assume a horizontal position.

As the preëmpted field excluded patentee from the claims by him first made, and later withdrawn after rejection by the Patent Office, and as his advance, as set forth in his claims, is represented by the use of jars with a wide mouth (the indefinite and uncertain angle formed by the attachment of the rod and the dipper adding nothing,) we must hold claims 4 and 5 invalid.

The decree is reversed, with costs, with directions to dismiss the bill.

[U. S. Circuit Court of Appeals—Fourth Circuit.]

BISIGHT Co. *et al.* v. ONEPIECE BIFOCAL LENS Co.

Decided January 20, 1919.

270 O. G., 479; 259 Fed. Rep., 275.

1. PATENTS—VALIDITY OF CLAIM—LIMITATION.

A patent claim may be limited by reference to the specifications.

2. SAME—VALIDITY—BIFOCAL LENS.

The Connor machine patent, No. 836,486, claim 1, for making bifocal lenses, as limited by its reference to the specifications, is not invalid because too broad.

3. SAME—INFRINGEMENT—MAKING BIFOCAL LENSES.

The Connor machine patent, No. 836,486, claim 1, for making bifocal lenses, *Held* infringed.

4. SAME—VALIDITY—ANTICIPATION.

The Connor machine patent, No. 836,486, claim 1, for producing bifocal lenses, is not anticipated by grinding-machines in remote arts, such as

grinding buttons, since more than mechanical skill was required to apply the grinding process to lenses.

CROSS-APPEALS from the District Court of the United States for the District of Maryland, at Baltimore; John C. Rose, judge.

Suit by the Onepiece Bifocal Lens Company against the Bisight Company and Benjamin Mayer. *Decree for complainant, (246 Fed. Rep., 450,) and defendants appeal, with cross-appeal by complainant. Decree modified.*

Mr. Victor D. Borst (Mr. William M. Stockbridge and Mr. Cyrus N. Anderson on the brief) for the appellants and cross-appellees.

Mr. V. H. Lockwood and Mr. Edward Rector for the appellee and cross-appellant.

Before KNAPP and WOODS, Circuit Judges, and McDOWELL, District Judge.

WOODS, *Cir. J.*:

Consideration of the claims, infringements, and defenses set up in these appeals involve very fine distinctions of the application of the patent law to bifocal lenses. Study of the record and arguments satisfies us that the district judge reached just conclusions as to most of the matters in controversy, and no good end would be attained by a statement of our reasons for approving his conclusions. (246 Fed. Rep., 450.)

(1,2) We think, however, that the district court was in error in holding invalid claim 1 of the Connor machine patent, No. 836,486. That claim reads as follows:

Apparatus for producing bifocal lenses including a rotary holder for the lens crystal, and means for grinding two bifocal surfaces of different dioptries simultaneously on one face thereof, substantially as set forth.

The district court held this claim invalid, because the rotary lens-holder is old in the art and the claim was too broad, in that it covered all apparatus which will make the product described, provided only that a rotary lens-holder forms a part of them. A claim may be limited by reference to the specifications in the application. (*Seymour v. Osborne*, 11 Wall., 516; 20 L. Ed., 33; *The Corn-Planter Patent*, 6 O. G., 392; 23 Wall., 181; 23 L. Ed., 161.) We think the broad claim is so limited in this instance by the words "substantially as set forth," referring to the specifications in the application which it is conceded describe the apparatus, and that the claim is therefore valid.

(3) We are of opinion, also, that the defendant has infringed. It is true that in Connor's specifications he describes—

a crystal holder member, and rotary grinding member coöperating therewith and having a spherically disposed grinding surface and an adjacent nonspherically disposed grinding surface.

and that Mayer's machine, which the defendants operate, has both surfaces spherical. Connor's apparatus being the first to accomplish the desired end, or at least an important generic invention, should not be so narrowly construed as to permit real infringement by a variation which, if substantial, is merely an inferior application of Connor's invention. (*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, C. D., 1908, 594; 136 O. G., 1297; 210 U. S., 405; 28 Sup. Ct., 748; *King Ax Co. et al. v. Hubbard*, 97 Fed. Rep., 795; 38 C. C. A., 423.)

(4) Connor's invention cannot be regarded anticipated by grinding-machines in a remote art, such as the grinding of buttons. Evidently something more than mechanical skill was required to apply the grinding process to lenses, even if it had been suggested by the apparatus for grinding buttons. (*Hobbs v. Beach*, C. D., 1901, 311; 94 O. G., 2357; 180 U. S., 383; 21 Sup. Ct., 409.)

The decree of the district court, with this modification, protects the plaintiff in the exclusive use of all inventions covered by its patents, and meets fully the justice of the case. The decree of the district court is modified accordingly.

Modified.

[U. S. Circuit Court of Appeals—Sixth Circuit.]

DUNN WIRE-CUT LUG BRICK CO. v. TORONTO FIRE CLAY CO. *et al.*

Decided January 7, 1919; on motion to reopen May 6, 1919.

270 O. G., 480; 259 Fed. Rep., 258.

1. PATENTS—PRESUMPTION OF INVENTIVE NOVELTY FROM USE—ATTRIBUTION TO PRODUCT.

Though brick of a certain type, which have gone on the market and had a large sale, are the product of the patentee's patented machine, which has been manufactured by him and sold to brickmakers, such credit and such presumption of inventive novelty as arise from public use should be given to the product—the bricks—and not to the machine.

2. SAME—VALIDITY—INVENTIVE CHARACTER—PAVING BRICKS.

Dunn's patent, No. 918,980, for wire-cut paving-brick having wire-cut ribs on the side, *Held* valid because the concept had inventive character, as distinguished from mere skill.

3. SAME—NEW PRODUCT—VARIATIONS IN METHOD OF MAKING.

The inventor of a new and useful product or article of manufacture may have a patent covering it and giving a monopoly upon it regardless of great variations in the method of making.

4. SAME—METHOD AND PRODUCT—SEPARATE PATENTS.

In the ordinary and typical case the method of manufacture and the product manufactured are separable inventions supporting separate patents, one of which may be valid and the other not.

5. SAME—PRODUCT PATENT—INFRINGEMENT BY MANUFACTURING DEVICE.

Dunn's patent, No. 918,980, for wire-cut paving-brick having wire-cut ribs on the side, *Held* infringed by the product of defendant's manufacturing device.

6. SAME—INFRINGEMENT—WHAT CONSTITUTES.

As between plaintiff's earlier and defendant's later patent a finding that the earlier device, if later, would not have infringed the later patent is not helpful in deciding whether defendant's device infringes plaintiff's patent.

On motion to reopen.

7. SAME—LATE INTRODUCTION OF EVIDENCE—CONDITIONS OF PERMISSION.

In suit for infringement of patent where, after direction of the usual interlocutory decree on finding of infringement, defendants present foreign patents said to anticipate plaintiff's product and ask leave to apply to reopen the case and put them into the record on account of the public interest and the interest of the courts the proposed evidence will be permitted to be brought into the record on defendants' meeting additional expenses of another trial, their showing to excuse failure to put in the evidence in due time not being satisfactory.

.APPEAL from the District Court of the United States for the Eastern Division of the Southern District of Ohio; John E. Sater, judge.

Suit in equity for infringement of patent by the Dunn Wire-Cut Lug Brick Company against the Toronto Fire Clay Company and others. *From decree dismissing the bill, plaintiff appeals. Order entered that the district court have leave to reopen the case, etc.*

Mr. J. C. Sturgeon and Mr. S. H. Tolles for the appellant.

Mr. David M. Gruber and Mr. Joseph T. Harrison for the appellees.

Before WARRINGTON, KNAPPEN, and DENISON, Circuit Judges.

DENISON, *Cir. J.*:

The company which had purchased the patent appeals from the decree dismissing its infringement bill brought against the Toronto Company and Nicholson, and based upon Patent No. 918,980, issued April 20, 1909, to Dunn, for paving-brick. The trial court overruled the defense of invalidity, but held that there was no infringement, and both of these subjects must be determined.

Brick were originally made by molding or pressing in individual dies or forms. The product was a molded brick or a pressed brick. It was found to be cheaper to squeeze the plastic clay through a die shaped like a cross-section of the finished brick and producing a continuous blank from which pieces could be cut or sliced off to form separate bricks. Because it came to be the more common practice to slice off these bricks from the blank by using a moving wire as the cutting edge (either one wire at a time or several in a gang), bricks of this class came to have the name "wire-cut bricks." Whether the cutting was done by wire or a knife or a saw was not important, be-

cause these methods are, in any broad sense, obviously equivalent. A cutting-wire works like the cutting edge of a knife, and the cutting edge of a knife, is, for this purpose, a wire; hence all such brick, whether sliced by wire or knife or saw, are, in the trade, universally called "wire-cut brick."

For paving, it is desirable that the brick should not fit close together, but should be spaced slightly apart, in order that waterproofing and adhesive material may fill the interstices and make a perfect bond. Accordingly, they were made with buttons, ribs, or slight projections of other forms upon one or both of the vertical faces of the two adjacent bricks. These were formed by suitable depressions in the dies in which the pressing was done; and, up to Dunn's time, all paving-brick with lugs or ribs had been re-pressed brick. Dunn observed, and seems to have been the first fully to understand, that, for the purpose of paving, the brick were injured by this re-pressing. The surface was too smooth, the corners were not sharp enough, and the texture or lamination was distorted; but the ordinary wire-cut brick were unsuitable for this purpose, because they had no spacing-ribs. It seems fairly to be inferred that, if the idea of putting ribs on wire-cut brick had occurred to any one, it had been rejected because of the difficulties or expense involved. In ordinary hand operation, to get this result would necessarily be slow, and operating upon such material would be likely to break away parts of the brick or ribs and produce defective brick.

In this situation, it occurred to Dunn that, by the same operation by which he cut off the brick from the blank by sweeping the cutting-wire across its face, he could leave ribs along the face, and he could accomplish this result by making the cutting edge irregular, instead of straight. In the form in which he developed his idea, he carried the wire on each side of his blank of clay in a slot which was straight most of the way, but included two semicircular offsets. The result was a brick, plane upon each side, excepting where crossed by two projecting ribs. He first applied for a patent upon the machine accomplishing these results, but, while that application was pending, filed also an application for a patent upon the product of his machine. This is the patent in suit. The patent upon the machine was not issued until September 7, 1909. The first claim of the patent in suit is:

As an article of manufacture, a wire-cut brick having wire-cut ribs on the side thereof, substantially as set forth.

(1) Dunn's product has been very largely accepted as a better paving-brick than before existed. Although the brick of this type which have gone on the market and had this large and wide sale are the product of his patented machine, which has been manufactured by him and sold to brickmakers, yet such credit and such presump-

tion of inventive novelty as arise from public use should be given to the product, and not to the machine. There would be no use for the machine, unless the product were desired. We therefore give some weight to this wide public use as bearing on the patent's validity.

(2) We think Dunn's concept had inventive character as distinguished from mere skill. The fact that this very simple product, which proved to be so useful, never had been developed during all the progress of the art, goes far to give it character. Re-pressing, with its cost and disadvantages, was avoided and a better brick was produced by simple means. We agree with the district judge in saying:

His brick is new and useful, and involved invention in no mean degree, and entitles him to the breadth of equivalency pertaining to an invention of that character—

and agree also with his summary quoted in the footnote.¹

Without regard to whether a patent upon a product may be wholly independent of any thought of the means by which it is produced, there can, in this case, be no such independence. Some degree of reference to the method of the production is carried into the claim by the words "wire-cut ribs." Where a process or a machine will produce only a specific product, and where a given product can be produced only by the specific process or machine, (if there are such cases; see *Macbeth-Evans Glass Co. v. General Electric Co.*, C. D., 1918, 239; 248 O. G., 501; C. C. A. 6; 246 Fed. Rep., 695;) it is difficult to see much lack of identity between the invented process or machine and the invented product, and such situations have given rise to some rather casual and seemingly *obiter* statements that process and product or machine and product constitute only one invention, (e. g., *Downes v. Teter-Heany*, C. C. A. 3; 150 Fed. Rep., 122; 80 C. C. A., 76.) It is thought that every such case will be found to depend upon this—actual or supposed—necessary identity of the means and the result.²

¹ Dunn conceived and produced a wire-cut brick with wholly wire-cut lugs, thereby dispensing entirely with the re-pressing process and with the expenditure necessary to effect the same. The development of his concept involved much study and experimentation. He was hampered not merely by want of funds, but by the distrust, discouraging conduct, and opposition of brickmakers and engineers. However, by persistent energy and determination he overcame the obstacles encountered and eventually won recognition by practically demonstrating the commercially successful character of his brick and the mode of its production. The roughness of the sides of the brick, which at first provoked opposition, was found in actual experience to be advantageous, as the filler was thereby enabled more firmly to set and more securely to hold than is possible with the smoother surfaced brick. The demand for his brick, following the test of actual service, was such that the output rose from 2,223,000 in 1910, to 138,000,000 in 1915. In the same period he granted 33 licenses to manufacturers.

² We find no authoritative decision lending more color of support to the idea that a patent for a product is to be confined to the result of the described process, than may be derived from some of the language in *Goodyear Co. v. Davis*, (102 U. S., 222; 26 L.

(3, 4) Certain it is, in view of the weight of authority and the latest decisions, that the inventor of a new and useful product or article of manufacture may have a patent which covers it and gives a monopoly upon it regardless of great variations in the method of making (*Powder Co. v. Powder Wks.*, C. D., 1879, 356; 15 O. G., 289; 98 U. S., 126; *Leeds Co. v. Victor Co.*, C. D., 1909, 536; 144 O. G., 1089; 213 U. S., 301; 29 Sup. Ct., 495; *Durand v. Schulze*, C. C. A. 3; 61 Fed. Rep., 819; 10 C. C. A., 97; *Maurer v. Dickerson*, C. C. A. 3; 113 Fed. Rep., 870; 51 C. C. A., 494; *Lamb v. Lamb*, C. C. A. 6; 120 Fed. Rep., 267; 56 C. C. A., 547; *Sanitas Co. v. Voigt*, C. C. A. 6; 139 Fed. Rep., 551; 71 C. C. A., 535; *Acme Co. v. Commercial Co.*, C. C. A. 6; 192 Fed. Rep., 321; 112 C. C. A., 573) and that in the ordinary and typical case, the method and the product are separable inventions, supporting separate patents, one of which may be valid and the other not, (*Rubber Co. v. Goodyear*, 9 Wall., 788; 19 L. Ed., 566.) It is therefore the duty of the court to find, if it reasonably can, for a product patent some construction and scope which shall avoid, on the one hand, destroying its value—if not its validity—by confining it to the precise method of making which the patent has happened to show, and avoid, on the other hand, a construction so broad as to make it invalid because for an old product. As illustrated by the present case, if Dunn is confined to wire-cut brick with wire-cut lugs produced precisely as shown by him, the patent is commercially worthless because easily avoided; while, if it is construed to cover a wire-cut brick which, before burning, has had irregularities produced upon its face by any cutting or carving means whatever, it would be void because of common practice relating to all kinds of tile, brick and pottery.

The theory that this patent extends only to the output of the method shown in the machine patent is inconsistent with the action of the Patent Office. Dunn first claimed—

a wire-cut brick having wire-cut ribs on one side thereof formed complete during the operation of cutting the brick.

This was rejected as "claiming the article by the method of making it." The Patent Office recognized and applied the rule above stated. Dunn then substituted the claim allowed and issued.

Ed., 149.) It was there said: "The invention is a product or manufacture made in a defined manner. It is not a product alone, separated from the process by which it is created." This conclusion was the result of an exhaustive study of the facts of the particular case, and was intended to refer to those facts. The claim was for "the plate of hard rubber or vulcanite, or its equivalent." The defendant did not use hard rubber or vulcanite, and the question was whether celluloid, an article unknown when the patent issued, was an equivalent. The case does not hold that if the defendant had employed a hard rubber plate he could have escaped because he manufactured this hard rubber by a process different from that described by Cummings. Nothing which was not made by the process of vulcanization could be the equivalent of the "hard rubber or vulcanite" of the claim. The process of vulcanization was imported into the claim by its very terms.

(5) The true scope of the claim can best be developed by tracing it from the form shown in the drawing to the form used by defendant. It is, doubtless, more economical to have the same stroke of the wire or cutter sever the brick from the blank and produce the ribs; but the claim cannot be so restricted without destroying the differentiation between the patent for the machine and the patent for the product. We think it clear that the patented product would be produced just the same if Dunn took a brick which had already been severed from the blank on both sides by some other wire-cutting machine, and passed that brick through his machine, using his wire cutter to completely reshape one entire side of that brick. The brick would be wire-cut, and the ribs would be wire-cut, although one face of the brick would have been treated twice instead of once. This would not be an unnatural treatment, if it was desired to have the ribs upon any face excepting the one produced by the cutting-wire. When we admit the equivalency between the cutting-knife and the cutting-wire, we see that this supposititious treatment is that which defendant Nicholson has adopted (and the Toronto Company uses). He first cuts his blank into separate brick by the usual wire-cutting process, then passes his severed brick along a feed-table and over a cutter which he calls a knife, the form of which is shown by 29, 30 in the following Figures 3 and 6 taken from the patent issued

Fig. 3.

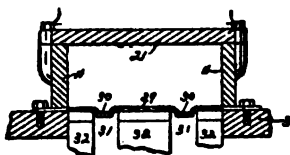
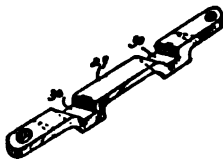


Fig. 6.



to him, No. 1,148,529 of August 3, 1915. This cutter or knife is the perfect equivalent for this purpose of a wire bent into the same form.

Defendant suggests no difference in operation excepting that he thinks such sharp corners could not be put on the ribs of a wire cutter; and this is immaterial. We must infer that this knife wholly reshapes that surface of the brick and transforms a plane surface into a surface with ribs. It seems improbable that the blank of plastic

material can travel forward over this knife, with the uncut portions or ribs depending into the depressions 30 of the cutter and with the necessary resulting distortion of the material, without filling these depressions and causing the entire ribs to be formed and shaped by the knife. If possibly this does not completely occur, yet it is certain that the sides of the ribs are thus formed and shaped, and that, at the most, only their extreme tops—a very small fraction of their whole surface—escapes this knife or wire-cutting origin, and these rib tops have already been “wire-cut.” We are convinced that, in the true sense of the patent, in the sense necessary for its right construction, the ribs on defendants’ brick are “wire-cut;” the extent to which they may fail to be so formed is comparatively negligible. Thus we see that the patent grant may fairly be construed to cover a method of production slightly variant from, but practically equivalent to, that described in the patent, and yet that its monopoly will leave untouched wire-cut brick with ribs produced by hand carving or by cutting out mere channels or by any method which is not, in substantial effect, the simultaneous creation of the plane surface and the ribs thereon by a cutting edge which sweeps through the body of the clay. Just where the dividing-line might be between that which thus infringes and that which would not, is not involved, and perhaps the question will never arise.

The defendants’ product is the result of a two-step wire-cutting process; plaintiff’s patent describes a one-step process for making his product; and it is said that for this reason infringement is avoided. We cannot find, either in the specification or claim or in the Patent Office action or in the history of the art, any reason for limiting the patent in accordance with this theory. We are convinced that to do so would not only be to disregard the basis of the existence of product patents as a class by themselves, but also would be to reissue this patent with the very claim which was rejected by the Patent Office and discarded by the applicant. The cases cited in support of restricting the patent to the one-step process are *Plummer v. Sargent*, (120 U. S., 442; 7 Sup. Ct., 640; 30 L. Ed. 737;) *Royer v. Coupe*, (C. D., 1893, 154; 62 O. G., 318; 146 U. S., 524; 13 Sup. Ct., 166;) *U. S. Glass Co. v. Atlas Glass Co.*, (C. C. A. 3; 90 Fed. Rep., 724; 33 C. C. A., 254.)

In our judgment, these cases do not support the argument. In the *Plummer* case, the patent was for a process of lacquering or japaning, consisting, according to the claim, of “the application of oil and heat, substantially as described.” In order to sustain this patent against the defense of anticipation, it was necessary to limit the process rather closely to the succession of particular steps described in the specification, and it was held that, when the patent was so

limited, defendant's process was not equivalent. In the Royer case there was also a patent for a process which was claimed as a—

treatment of the prepared rawhide in the manner and for the purposes set forth.

It was held that the process, in its broadest aspect, was old; that—the only subject-matter of invention which the plaintiff could properly claim was the whole process described in his patent, comprising the different steps therein set forth;
and that—

in that view, it must be shown that the defendant used all the different steps of that process, or there could be no infringement.

Obviously, if the patentee's finished hide had been identified by some physical characteristics, and he had claimed an article of manufacture thus identified, there would have been a different question.

In the Glass Co. case it appeared that the process patented was confined by the claim to a succession of specific steps, and that the defendant omitted two of these steps. The conclusion was inevitable that "identity of method cannot exist."

(6) It is also suggested that the device of the patent in suit, if it had been later than the patent issued to Nicholson, would not have infringed that patent, and, hence, that defendants' device does not infringe plaintiff's patent. *Electric Co. v. Pittsburgh Co.* (125 Fed. Rep., 926; 60 C. C. A., 636) is cited to support this transposition and modification of the familiar rule—"that which, if later, would infringe, will anticipate, if earlier." The case seems hardly to support the citation; the language used by Judge Coxe (125 Fed. Rep., 930; 60 C. C. A., 636) is only a method of saying that the two things were wholly foreign to each other. If we could lay out of view the fact that plaintiff's patent is for a product and Nicholson's later patent is for a machine, it would still be true that anticipation depends upon the nature and extent of the earlier disclosure while infringement depends upon the character of the grant as fixed by the claim. The later patent is necessarily relatively specific as compared to an earlier invention; and a finding whether the earlier device, if later, would have infringed the later patent, is not helpful in determining whether the device of the later patent infringes the earlier one. The two questions have no necessary relation to each other. We have had occasion to point out that in this situation equivalency is not mutual. (*General Co. v. Electric Co.*, 243 Fed. Rep., 188, 1007; 156 C. C. A., 54 664; *Curry v. Union Co.*, 230 Fed. Rep., 422; 144 C. C. A., 564.)

Nor does the fact that Nicholson uses his hands, in transferring his brick from the first wire-cutting device to the second, control the question of infringement. It is true that in *Brown v. Davis* (116 U. S., 237; 6 Sup. Ct., 379; 29 L. Ed., 659) the use of the human hand

is relied upon as demonstrating non-infringement; but in that case one of the elements of the claim sued upon was a peculiar lever, and defendant dispensed with the lever and used his hand. This was the common case of omission of one of the elements of the claim.

There should be the usual injunction and accounting as to defendants' brick produced in the manner which we have described, and to permit the entry of such decree below, the existing decree should be set aside.

ON MOTION TO REOPEN.

PER CURIAM:

(7) By opinion filed January 7, 1919, we sustained the patent in suit and directed the usual interlocutory decree. The defendants now present three German patents which are said to anticipate, and ask leave to apply to the court below to reopen the case and put these into the record. The showing to excuse the failure to find this evidence in due time is not satisfactory. It is not clear that, in the search made in preparation for the answer, any effort was made to examine foreign patents. A generally similar showing could be made in every case where there is a later discovery, and, if none but the parties were concerned, we should hesitate to grant the motion. (*Westinghouse Co. v. Stanley Co.*, C. C. A. 1; 138 Fed. Rep., 823; 71 C. C. A., 189; *Kissinger Co. v. Bradford Co.*, C. C. A. 6; 123 Fed. Rep., 91; 59 C. C. A., 221; *Novelty Co. v. Buser*, C. C. A. 6; 158 Fed. Rep., 83; 85 C. C. A., 413; 14 *Ann. Cas.*, 192.)

However, others than the parties are interested. At least one of the German patents is superficially pertinent enough so that the validity of the patent in suit would be likely to be litigated over again by the next alleged infringer, both in the trial and appellate courts. In the meantime, the public would be uncertain whether the industry was or was not subject to this burden. In the interest of the public concerned with the patent, and in the interest of the courts, we think the proposed evidence should be brought into this record, (*Firestone Co. v. Seiberling*, C. C. A., 6; 245 Fed. Rep., 937; 158 C. C. A., 225;) but the plaintiff ought not to suffer damage from what is not its fault. It will be put to the additional expense of another trial in the district court and perhaps another appeal, and a great part of this will be duplication which could have been avoided if the original defense had been more thorough. As a condition of allowing the belated defense to be now made, the defendants should meet this additional expense. The amount thereof is affected by so many uncertainties that it must be somewhat arbitrarily fixed. We apparently have the same opportunity as the trial court would have to make a reasonable estimate. We think \$300 is certainly not too much to make the plaintiff good against the greater expense and delay

which will result if the case is reopened and reheard upon the modified record, than there would have been if the entire defense had been originally presented.

The order will be that the district court have leave to reopen the case and admit the proposed evidence and such further proofs as may be offered by either party in relation thereto and thereupon again determine the issue in the case upon the record as thus supplemented—all upon condition that the defendant pay to plaintiff, within such time as the court below may fix, the sum of \$300.

[U. S. Circuit Court of Appeals—Third Circuit.]

PARAMOUNT HOSIERY FORM DRYING CO. *v.* MOORHEAD KNITTING CO.

Decided October 13, 1919.

270 O. G., 619; 260 Fed. Rep., 841.

PROCESS OF DRYING AND SHAPING HOSIERY ARTICLES—FUNCTION OF APPARATUS.

The claim of the Collis patent, No. 1,204,945, reading as follows: "A method of treating hosiery articles, consisting in heating, from within, and to a predetermined fabric-drying temperature, a metallic form having its sides relatively narrow in cross-section and converging into substantially reduced, crease-producing edges; then superposing upon said form a hosiery article and subjecting the same to the action of heat imparted internally thereto by the form for producing a substantially flattened and creased article," *Held* void as covering nothing more than the function of an apparatus which was the subject of a separate patent which had been held invalid because of prior invention and use. "The process in this case is as clearly the whole value, the sole purpose of the apparatus," as in the case of *Busch v. Jones* (C. D., 1902, 585; 99 O. G., 229; 184 U. S., 598) "the process was the whole value, the sole purpose of the press."

APPEAL from the District Court of the United States for the Middle District of Pennsylvania; Charles B. Witmer, judge.

Suit in equity by the Paramount Hosiery Form Drying Company against the Moorhead Knitting Company. *Decree for defendant, (251 Fed. Rep., 897,) and complainant appeals. Affirmed.*

Mr. Robert F. Rogers, Mr. Charles H. Howson, and Mr. Edmund H. Parry for the appellant.

Mr. Henry N. Paul and Mr. Joseph C. Fraley for the appellee.

Before BUFFINGTON, WOOLLEY, and HAIGHT, Circuit Judges.

HAIGHT, *Cir. J.*:

In the court below the appellant sued the appellee for an alleged infringement of two patents, numbered 1,114,966 and 1,204,945, granted to it as assignee of one George Collis, on October 27, 1914,

and November 14, 1916, respectively. The last patent was issued on a division of the application for the first. The earlier patent will hereafter, for convenience, be referred to as "the apparatus patent," and the later one as "the process patent." Generally speaking, one covers an apparatus for simultaneously drying and finishing hosiery articles, in the sense of stretching, shaping, smoothing, and creasing, and the other a method for accomplishing the same purpose.

In the court below the claims in suit of both patents were held to be invalid, and a decree dismissing the bill was entered. The appellant has acquiesced in the decree so far as its effect was to invalidate the apparatus patent, and appeals from only that part which dismissed the bill as to the process patent. Infringement is not seriously denied. Some question as to an estoppel was presented in the court below, and decided adversely to the appellant, as was likewise decided adversely to the appellee a counter-claim interposed by it. The appellant has abandoned its claim that the appellee is estopped to deny the validity of the process patent, and the appellee has not appealed from the decree dismissing its counter-claim. The only question, therefore, to be considered on this appeal, is the validity of the process patent.

The original application for apparatus patent was filed on June 27, 1911. After a rather stormy career in the Patent Office, a patent containing forty-five claims was issued on October 27, 1914. Three days before its issue a division of the original application was filed, which eventuated on November 14, 1916, in the process patent, containing five claims, the last three of which are in the suit. The learned judge of the court below accepted the month of September, 1910, as the date of the Collis invention. We shall do likewise. Passing for the moment the exact state of the art at the time Collis made his alleged invention, we will refer briefly to what Collis assumed that he had invented.

It had been for many years the custom to remove as much as possible of the moisture, with which dyed or bleached hosiery and other similar textile articles become saturated in the dyeing or bleaching process, by means of a centrifugal machine known as a "whizzer," and to finish the drying by drawing the articles over wooden forms or boards and then depositing them in dry-boxes. The latter were compartments supplied with interior heating-coils and fans to insure circulation of the air. After the articles had been thus thoroughly dried, they were removed from the boards, and finally shaped, smoothed, and given the crease necessary to make them marketable, by placing them in a press and there subjecting them to pressure for various periods of time, depending upon the character of press used. The apparatus described in the Collis patents was designed to, and

in practice actually did, accomplish the ultimate drying and finishing in one operation.

Without referring to the supplemental housing or casing described in the patents (which is of no materiality in this case), the Collis apparatus consists of hollow metal forms, similar in shape to the wooden forms before mentioned, and internally heated by steam or other means. Over these the wet hosiery article is drawn. The forms are narrow relatively to their width, and have their opposite narrow edges substantially sharp. The forms being heated internally, the hosiery mounted on them is dried, and the sharp edges produce the before-mentioned finish. The utility of the apparatus of the first patent, and the advance which its use in the art of finishing hosiery made, were fully recognized by the court below, and is not, as indeed it could not very well be, disputed. The court below found, however (and, as before stated, the appellant accepts such finding,) that Collis was not the first to conceive and practically develop the apparatus covered by his patent, and therefore the apparatus patent was held to be invalid. Indeed, as appears from the opinion of the learned judge of the court below, appellant abandoned during the trial any claim to the validity of that patent.

The patented prior art, as Collis admitted during the prosecution of his application for the apparatus patent, exhibits several examples of hollow metal forms designed to dry hosiery and textile articles by the application of internal heat. The evidence also abundantly demonstrates that, long prior to the earliest date claimed for the Collis invention, internally-heated metal forms with sharp edges, to produce the necessary creases, had been designed and used, although not patented, by several concerns for the finishing of silk gloves and silk hosiery. The proof of the prior uses of an apparatus similar to, if not identical in all respects with, that covered by the patent, in a suit instituted by the present appellant against one Walter Snyder and the Walter Snyder Company, was so overwhelming as to cause the appellant to voluntarily abandon that suit, although the forms manufactured and sold by the alleged infringers unquestionably infringed the Collis apparatus patent.

The process patent, in the language of the specification, describes the method sought to be covered by it as follows:

A method of treating hosiery articles, consisting in heating, from within, and to a predetermined fabric-drying temperature, a metallic form having its sides relatively narrow in cross-section and converging into substantially reduced, crease-producing edges; then superposing upon said form a hosiery article and subjecting the same to the action of heat imparted internally thereto by the form for producing a substantially flattened and creased article.

Notwithstanding the invalidity of the apparatus patent because of anticipation, it is sought to avoid a like result as to the process patent

on the theory that, although it was old in the finishing of silk gloves and silk hosiery to smooth and crease them on internally-heated metallic forms with sharp edges, and although the prior art exhibited internally-heated metal forms for the drying of hosiery, the method or process of simultaneously drying (in the sense of extracting the excess moisture acquired during the dyeing or bleaching process and not removed by the "whizzer" and ordinary evaporation) and finishing (in the sense of stretching, smoothing, and creasing) hosiery through the use of internally-heated metallic forms, with crease-producing edges, had not been conceived by any one before Collis.

It will be noted that the court below based its judgment that the process patent was invalid, both upon the ground that it covered nothing more than the function of the patented apparatus, and that the before-mentioned prior use of the forms covered by the apparatus patent anticipated the method or process of the process patent. If it be true, as appellant contends, that these sharp-edge, crease-producing forms of the prior art were not designed or used for drying hosiery in the sense before mentioned, although capable of performing that function, but only for finishing and creasing silk gloves and hosiery from which all moisture had been extracted, and which it was necessary to again dampen before the finishing, and that the process patent was not, therefore, anticipated by their prior use, (*Carnegie Steel Co. v. Cambria Iron Co.*, C. D., 1902, 592; 99 O. G., 1866; 185 U. S., 403; 22 Sup. Ct., 698,) it is apparent that the invention of that patent, if any there is, resides simply in taking that part of the prior art which exhibits apparatus for drying wet hosiery and coupling it with that part of the prior art which used the same forms, different only in that their edges were sharp, to produce the necessary crease or finish on articles which had already been dried.

We shall not pause to consider whether this constituted patentable invention, or whether the use of the prior-art crease-producing forms to finish textile articles which had already been dried, but which proper practice required should again be moistened, in order that they could be properly finished, was the practising of the process or method of the Collis process patent, or whether the process patent can relate back to the date of the filing of the original application for the apparatus patent, and thus avoid anticipation due to the use of Ermentrout's forms, because we think that the decree of the court below must be affirmed on the other ground, namely, that the process patent covers merely the function of the apparatus described and covered by the apparatus patent. In this connection, it may be well to briefly review some of the circumstances surrounding the acquisition of the Collis application by the appellant, and some of the events that transpired thereafter.

It appears that one Ermentrout, of Reading, Pa., having seen a circular put out by a concern known as the Curtin-Hebert-Anthony Company, which had before the earliest date claimed for the Collis invention manufactured and sold internally-heated, sharp-edged, crease-producing metal forms, to certain concerns engaged in manufacturing silk gloves and silk hosiery, began in the autumn of 1911 the manufacture of internally-heated hosiery-forms, substantially identical with those shown in the two Collis patents. They were designed to be used for the same purpose as the forms of the patent. Some of them found their way into the factory of the Paramount Hosiery Company, and worked so well that the officers of that concern determined to purchase Ermentrout's business and a limited patent, relating to a specific type of coupling between the form and a steam-supply pipe, which he had secured. A company was subsequently formed for the purpose of carrying on the business which had been begun by Ermentrout. In the course of selling some of such forms, the original Collis application, which was then pending in the Patent Office, was discovered. The appellant thereupon, on December 24, 1913, in order to protect itself, purchased the same for a comparatively small sum, and thereafter prosecuted the original application and the subsequent division thereof. It was not until the following June, although the application had then been pending for three years, that the division was suggested. In the meanwhile, the prior act, so far as it was accessible to the Patent Office, had been quite thoroughly reviewed, and the slight field of invention left open to Collis made manifest. In the early or middle part of 1914, Walter S. Snyder, who was engaged in manufacturing laundry machinery in Philadelphia, began the manufacture of drying-forms for laundry purposes, and subsequently extended his business to the manufacturing of these forms for hosiery manufacturers.

In 1916, the present appellant began suit against Snyder and the Walter Snyder Company, alleging that the forms which were thus being manufactured by them infringed the apparatus patent in suit in this case. That suit was voluntarily discontinued under the circumstances before mentioned. Most of the forms manufactured by the appellant are distributed to those who use them, under license agreements which provide for the payment of certain royalties, based on the amount of hosiery articles dried on the forms. The appellee had acquired, under such an agreement, a number of the appellant's forms. Subsequently it acquired some of the forms manufactured by the Walter Snyder Company, and used both in its business. After the appellant abandoned its suit against the Snyder Company, it began this suit, basing the alleged infringement upon the appellee's use of the forms which it had purchased from the Snyder Company. It is thus apparent that the appellant is attempting in this suit by

means of the process patent to secure a monopoly in the use of an apparatus which admittedly could not be the subject-matter of a valid patent at the earliest date at which it is claimed that Collis invented it, because the only way shown in the patent, or otherwise, for practising the method covered by the process patent, is the use of the particular apparatus described and covered by the apparatus patent. The process is, in reality, nothing but the use of the apparatus. That is manifest by reference to the before-quoted portion of the specification of the process patent, as well as the following extract therefrom, viz :

From the foregoing, it will be seen that the procedure followed, in treating hosiery articles under my improved method, is first to effect a heating (from within and to a predetermined drying temperature) of a hollow form, preferably constructed of metal, and having its sides narrow in cross-section and converging into substantially reduced-edge portions; then manually stretching a hosiery article longitudinally thereon and retaining the same on the form for the fabric-drying period, during which the fabric of the article is simultaneously dried, shaped, and creased at two oppositely disposed portions, and then removing or stripping the article from the form.

Moreover, the apparatus patent specifies, and in fact claims, the function of the apparatus as the simultaneous drying, creasing, and finishing of the textile article mounted on the exterior thereof. It is impossible for us to perceive how this process can be considered in any other light than the mere function of the apparatus. The inevitable result of any other conclusion would be to give validity to a patented process which consists solely in the use of an apparatus which cannot be the subject-matter of a valid patent.

It would serve no useful purpose, and would unduly burden this opinion, to review the authorities which have differentiated between the mere function of a machine or apparatus and a patentable process, which could be practised by the use of the apparatus or machine, and to attempt to distinguish those cases from this. It is sufficient, we think, to refer to *Busch v. Jones*, (C. D., 1902, 585; 99 O. G., 229; 184 U. S., 598,) and particularly to the remarks of Mr. Justice McKenna on page 607, (22 Sup. Ct., 511; 46 L. Ed., 707.) In the case at bar, the dependence is the process upon the apparatus, and not the apparatus upon the process, just as the process in that case was dependent upon the press. It is equally true that the process in this case is as clearly the whole value, the sale purpose of the apparatus, as in that case "the process was the whole value, the sole purpose of the press." We are accordingly of the opinion that the claims in suit of the process patent cover nothing but the mere function of a machine or apparatus, and hence are invalid.

The decree appealed from is therefore affirmed, with costs.

[U. S. Circuit Court of Appeals—Sixth Circuit.]

FETZER & SPIES LEATHER CO. *v* I. T. S. RUBBER CO.*Decided October 7, 1919.*

271 O. G., 157; 260 Fed. Rep., 939.

1. REISSUE—DELAY IN FILING.

A delay of about nine months in filing an application for reissue (Reissue No. 14,049, to Tufford) *Held* reasonable, no patents having been taken out or applied for and no manufacture or sale of a similar device having occurred in the interval.

2. SAME—SAME INVENTION—NEW CLAIMS ADDED—ADDITION TO DESCRIPTION AND SLIGHT CHANGES IN DRAWINGS.

The Tufford reissue patent, No. 14,049, *Held* to be for the same invention as the original patent, since the features specified in the new claims were all set out with reasonable clearness in the original specification, and the changes made in the drawing are slight and immaterial, and the additions to the specification merely bring out the idea disclosed in the original patent with greater clearness, and certain statements in the reissue application, while not strictly correct, were approximately so, and the departure from the exact truth being without any material importance.

APPEAL from the District Court of the United States for the Eastern Division of the Northern District of Ohio; D. C. Westenhaver, judge.

Suit in equity by the I. T. S. Rubber Company against the Fetzer & Spies Leather Company. *Decree for complainant, and defendant appeals. Affirmed.*

Mr. Burton W. Cary and *Mr. Horace Van Everen* for the appellant.

Mr. F. O. Richey and *Mr. Charles A. Brown* for the appellee.

Before WARRINGTON, KNAPPEN, and DENISON, Circuit Judges.

PER CURIAM:

We approve and adopt the opinion of the district judge, save in the particulars to be inferred from what we later say; but certain points have been pressed upon us by appellant with such force as to call for a summary statement of our conclusions.

1. Nerger discloses a form which we think essentially closer to Tufford than any other earlier patent shows. The substantial difference between Nerger and Tufford is that the lift of the former was scoop-shaped and that of the latter saucer-shaped. These are untechnical and not very accurate terms of description, but they serve to distinguish as well as any two words may. They may be made clearer by assuming that all the descriptive words are used with reference to the horizontally-placed plane of the bottom of the

permanent heel to which the lift is to be attached. It is characteristic of the saucer shape that there should be a somewhat centrally-disposed low spot, so that if the upper edges of the lift were put in contact with the horizontal bottom of the heel, as far as may be without using force to distort the normal shape of the lift, any contained liquid would be retained in this lowest spot, because the edge of the lift toward the breast of the heel would be higher. It is characteristic of the scoop shape, under the same conditions, that the line from the low spot to the edge of the lift at the breast would be substantially horizontal, and the liquid would run out. The effect of this distinction is that, when the central part of the depression is forced up against the bottom of the heel, there is a distinctly greater tendency with the saucer shape than with the scoop shape for the breast edges of the lift to maintain tight contact with the heel. If the surfaces are smooth enough, this excludes the air, the atmospheric pressure holds the lift, flattened out, against the heel, and we have the result called "suction."

We do not regard this suction as of decisive importance in itself, because after one or two leather lifts had been removed, the roughness of the leather and the overlapping by the rubber would make it doubtful whether the suction adherence would be of much practical use; but the suction test is of distinct value as determining whether the rubber lift has or has not that quality which distinguished Tufford from Nerger. The distinction between the two is fairly well expressed by the statement that Nerger is of concavo-convex form upon lateral cross-sections, while Tufford is of this concavo-convex form also upon longitudinal cross-sections. This advance made by Tufford over Nerger seems very small—in looking forward, it might have been thought unsubstantial; but the actual events seem to demonstrate that it was very important, and we have no doubt that it should be considered to involve invention. This conclusion is in accord with that of the Circuit Court of Appeals of the First Circuit in *I. T. S. Co. v. Panther Co.* (*post*, 283; 271 O. G., 512; 260 Fed. Rep., 934.)

The best that can be said of Nerger's patent disclosure is that it is not inconsistent with a lift concavo-convex in longitudinal cross-section also, and that his lift therefore might or might not have had that form. This uncertainty was removed by the evidence as to what Nerger did. The lifts which he made and sold were scoop-shaped, and his business was not successful. We prefer to rest the elimination of Nerger upon the difference between his form and Tufford's rather than upon the ground of abandoned experiment.

2. The original specification sufficiently discloses the ideas to which the added claims of the reissue are directed, as these claims

are interpreted in our opinion in *United States Rubber Co. v. I. T. S. Co.* (260 Fed. Rep., 947,) filed herewith. The drawing is rather blind, but the specification contains descriptive matter which appropriately applies to these features. If there were doubt about it, it would be solved by the proof that Tufford, from the beginning, never made any form of lift, excepting that form which contains these particular features, and samples of this form were the basis of the proceedings in the Patent Office. Hence it is clear that any such doubt will not defeat the reissue.

3. Plaintiff does not appeal from the award of only nominal damages.

The decree will be affirmed; but the affirmance will be without prejudice to further considering in the court below whether any of the defendant's forms escape infringement of claim 10, for the reason given in the U. S. Rubber Co. case.

The opinion below of Westenhaver, district judge, is as follows:

The bill in this case charges infringement by defendant of United States Re-issue Letters Patent No. 14,049, issued January 11, 1916, to complainant, as assignee of John G. Tufford. The defenses are: (1) that this reissue patent is void, because not for the invention covered by the original patent, and because the application therefor was unduly delayed without sufficient excuse; (2) that it is invalid for lack of invention and lack of novelty; and (3) that defendant's construction does not infringe.

Tufford's invention relates to rubber shoe heels. Technically and in the shoe trade it is called an elastic or resilient heel lift. A lift in the shoe trade is one layer of the leather making up the finished heel, and, as ordinarily applied, a rubber heel lift is approximately the depth of two layers of leather. The upper part or face of the lift is the attaching face. The forward edge is called the breast.

The rubber heel lift in common use, and the only one commercially known or sold prior to Tufford's, was of the flat type. Many disadvantages are said to exist in this type of heel lift. When attached, it has a pronounced tendency to separate at its edges from the leather heel, and also to spread and expand beyond the leather heel. This not only is unsightly in appearance, but produces a gap and offset between the rubber and leather into which dirt and water will enter. The heel becomes uneven, and its connection with the shoe heel proper is weakened. This is said to be due to several causes. One is that, if the nails be driven inwardly from the edge, so as to avoid the rows of nails in the leather, the compression in the center part of the rubber heel lift has a tendency to cause the lift at its outer edges to draw away from the leather. Furthermore, it is said, while cements are made which will firmly unite rubber to rubber and leather to leather, no cement is made which will firmly unite rubber to leather; when cement is necessary, and is used in attaching the flat type of heel lift, it is found that the action of wear and water destroys the cement and produces the objectionable gap between the rubber and leather above noted. Attaching the flat heel, in doing which cement is necessary, is also a relatively slow operation as compared with the attaching of heel lift of

the Tufford type. Attaching a lift with cement requires a careful preparation of the attaching face of the heel lift and of the surface of the leather heel proper, and an interval of some 15 to 20 minutes between the application of the cement and the time when it has dried sufficiently to be attached must be allowed in the operation.

Tufford's rubber heel lift was invented by him to overcome these difficulties. Its most important features as claimed by him are its peculiar and original shape and the suction thereby obtained when it is attached. In form it is uniformly curved on all cross-sections thereof. The upper face is concave, so that the entire heel lift lies below a plane passing through the rear upper edge and breast corners. It is of uniform thickness, and its lower or convex face lies parallel to the upper or concave face. A construction in this form of resilient or elastic rubber will, when compressed against a flat surface, adhere thereto. The air in the cavity between the concave face and the flat surface is thus excluded, and the air pressure called "suction" retains it permanently in place. The natural tendency of the heel lift thus constructed to assume its natural curved position is said to be likewise present, and, as a result of these forces, this heel lift adheres closely at the edges at all times to the leather heel proper, keeps its shape, and has unusual wearing qualities.

The specifications show other features or elements of the invention which it is not necessary to describe in detail, because the controversy here revolves around the features or elements above described. These additional features, it may, however, be noted, apply to the position of the nails distributed about the center of the heel lift and at a substantial distance from the edges, the shape and location of the washers embedded in the heel lift in which the nails are to be driven, the diminutive size of the nail holes, which are sufficient only to act as guides for the nails, and so small as to prevent the escape of any appreciable amount of air to or from the suction area of the heel lift. In addition, shallow channels are cut or molded in the concave face in the form of a shield with a cross therein, which are said to create four additional separate and distinct suction areas coöperating with the suction area of the entire upper face.

On this hearing Tufford demonstrated the manner in which he made this invention. In 1913, and for many years prior thereto, he was a cobbler in a shoe store in Elyria, Ohio. In following his trade he came to know all the different forms of rubber heel lifts, and observed the respects in which, as he says, all were more or less unsatisfactory. He conceived the idea that, if a heel lift were made having the suction features claimed for his invention, it would be an improvement over all existing types of heel. In developing this conception he provided himself with the round or globular type of a newel post, and over this top he nailed a flat disk of rubber. In the exact top of the section of a sphere thus created, he outlined first a heel lift of the desired size, and then cut and filed away the rubber within these outlines to a perfectly flat surface. He next cut out the heel lift, which, when free, immediately assumed the concave shape of his patented invention, uniformly curved on each cross-section thereof. The other side was then cut, filed, and trimmed to a uniform thickness. The finished heel lift retained its shape, and, when applied to a flat surface, adhered thereto in the manner above described. This he applied to a pair of his own shoes, which he wore continuously, and which he says gave entire satisfaction, and demonstrated all the advantages now claimed for his invention. He made two other pairs by hand, which he applied to shoes worn by two different clerks employed in the same store with him. They also were found to be satisfactory. Later, and after he had completed his device by developing the form and location of the washers and nail holes

and the channels or grooves in the form of a shield with a cross therein, as above described, he applied for a patent. His application is dated July 21, 1913, and was issued September 15, 1914.

Some time during the year 1914 Tufford presented samples of his heel to Mr. Richard Griffith, superintendent of the Miller Rubber Company of Akron, Ohio, in order to induce this company to make molds and engage in the manufacture of these heel lifts. Mr. Griffith refused, because the shape of the heel lift presented, he thought, unusual difficulties in constructing a mold, and he was not willing that the company he represented should itself undertake the task of making molds and guaranteeing a satisfactory product. He directed Mr. Tufford to invent a mold himself. Later Mr. Tufford returned with a single cavity mold of the desired shape and form, and thereupon the Miller Rubber Company had similar molds made, manufactured a number of sample heel lifts, and determined for itself that the heel lift could be made commercially in conformity to the sample presented.

The first heels for commercial use were manufactured for complainant by the Miller Rubber Company early in 1915. Complainant's first sales were made in March of that year. The commercial success of this heel lift has been phenomenal. The prices agreed upon between complainant and the Miller Rubber Company at the beginning of their business relations have continued to the time of the trial and are still in force. The prices at which the heel lifts were first sold to the trade in February, 1915, have not been changed and are still in force. Complainant has not resorted to any method of advertising, except to furnish some cards to shoe dealers and to submit occasional exhibits at shoe-finding conventions. In the early months of 1914 Mr. Tufford himself, and perhaps others, made some trips to Cleveland and elsewhere to call the lift to the attention of shoe dealers and jobbers; but, except to that extent, no force of traveling or soliciting salesmen has been employed.

The sales of the Tufford lift in February, 1915, were 6,696 pairs, and for the entire year 748,189 pairs. The sales for the year 1916 were 4,529,518 pairs; for 1917 they were 12,733,567 pairs; and for the first six months of the year 1918, 13,893,245 pairs. For the month of June alone, 1918, the number sold were 2,279,045 pairs. Complainant has put in capital from first to last of less than \$30,000. Its undivided profits January 1, 1918, were \$800,000. Its net earnings alone for the year 1917 were \$482,000. The Miller Rubber Company began with 10 or 15 persons in its press room in February, 1915, making these heel lifts; it now has 160 employees so engaged. Its investment for this purpose totals a half million dollars. It was making at the time of trial 75,000 pairs a day, and trying to reach an output of 120,000 pairs a day. Mr. Griffith says the company has never been able to keep up with the public demand for this heel lift.

Numerous witnesses support Tufford's contention that his invention has accomplished the results claimed for it. Its edges do adhere closely to the contacting leather of the heel proper. Its edges do not spread beyond the heel proper; the tendency of the edges of the flat rubber heel lift to gap from the leather is overcome, either by suction or by the tendency of the lift to crowd or compress toward the center. It may be applied quickly and easily and without the use of cement. It has unusual wearing qualities as compared with other forms of rubber heel lifts, and keeps its shape and form until it is worn down. The evidence also shows that its phenomenal sale is not due to advertising or business methods, but is exclusively due to its inherent excellence. The evidence also shows that the well-known O'Sullivan flat rubber heel has been extensively advertised in magazines and by street

car placards, but that, during the period the sales of the Tufford heel have been growing so enormously, it has merely maintained a standard volume of sales.

Invention is presumed from the issue of the Letters Patent, and defendant does not, as I understand, contend that this patent would, standing alone in the art, be void for lack of invention, but does contend that, in view of the prior art it is not a sufficient advance to be patentable, and has been anticipated by that prior art. Defendant relies on United States Letters Patent No. 638,228, issued December 5, 1889, to Cara S. Ferguson, and United States Letters Patent No. 661,129, issued November 6, 1900, to Frederick Nerger. A brief examination of each of these patents needs to be made.

The prior art embodied in these two patents was taken into consideration by Tufford in constructing his original device. In the specifications of his patent he says that he is aware that a cushion lift having a concave upper surface to be applied to the lower face of the shoe heel proper has been proposed, but that he does not believe that any practical or satisfactory means has up to the time of his invention been discovered and employed for attaching the same. One of the methods he says has been to embed circular washers in the lift and use nails or other securing elements driven through these washers into the shoe heel. These circular washers he says have been so arranged that after a short use the edges thereof will be exposed at the tread surface of the heel lift. This is an element of the Ferguson patent. His specifications and drawings disclose a circular washer of substantially the same outline as the heel lift with the center of it cut away.

Another method employed, Tufford says in his specifications, has been to embed in the heel lift a metal plate conforming in contour to the cavity of the heel lift, and then secure the heel lift in place by driving nails or screws through these plates and into the leather heel proper. In this form of construction he says that when pressure is placed on the heel it will tend to flatten out the plate, thereby causing its edges to cut through the lift, besides weakening and loosening the nails or screws. This is an element of the Nerger invention.

An examination of the drawings and specifications of the Ferguson patent shows a rubber heel lift substantially scoop-shaped in form. It is difficult to say, from an examination of the drawings and specifications, whether or not the upper face is concave on every cross-section thereof, or that it lies entirely below a plane passing through the rear edge and breast corners. Certainly it is not the shape and form of the Tufford heel. It is not uniformly curved on every cross-section, and the samples constructed of that form without the metal washer, introduced and demonstrated at this hearing, do not have the quality of adhesion or suction present at all times in the Tufford heel lift. Ferguson, it is true, anticipated in some degree Tufford's conception that a concavo-convex heel lift will cling closely to the leather of the heel, due to its natural tendency to assume its normal curved form. He depended, however, upon two important elements not present in Tufford's heel lift to accomplish this result. One of these is a raised marginal portion continuous about the margin or outline of the heel section on its concave side. Another is a metallic spring frame or washer, having the substantial outline of the heel section, with the center cut away, and which is curved or bent to correspond to the curvature of the heel lift. It was on these two elements that Ferguson relied to overcome the usual tendency of flat rubber heel lifts to draw away from the leather, creating a gap at the meeting edges. These features are both omitted from Tufford's heel lift, and are themselves wholly adequate to distinguish the two inventions.

The Ferguson patent has been considered by this court. The Panther Rubber Company, as assignee of the Ferguson patent, sued herein the I. T. S. Rubber

Company, charging that the Tufford heel lift infringed the Ferguson patent. On hearing July 8, 1916, Judge (now Mr. Justice) Clarke held that it did not infringe. On appeal to the circuit court of appeals this holding was affirmed in an opinion filed March 15, 1918. In a *per curiam* opinion that court says that the raised marginal portion in Ferguson's specifications is an important and controlling element of his invention; that not only are the two constructions very dissimilar in appearance, but that it is not conceivable that the depression in the form of a shield with a cross therein in the concave center of the lift can perform the same functions claimed for the depression within the raised marginal portion of Ferguson's heel; and that, notwithstanding it is insisted that Ferguson was original in bringing in the element of a concavo-convex lift, his patent has no claim for that feature, except in combination with the element of a raised marginal portion. This is true of the first claim, and of the second claim the element of the concavo-convex form is claimed only in combination with a correspondingly concaved spring metallic frame embedded within said heel section. Furthermore, on this hearing it appeared that the Ferguson heel had never been manufactured and sold commercially in the concavo-convex form of his patent, but that the commercial article was a flat heel with the embedded metallic frame, and with an abrupt depression in the center of the upper face; in other words, the patented construction has not been accepted by the public as a solution of the rubber heel lift problem.

Defendant's main reliance herein is on the Nerger patent. It is difficult to resist the impression that this reliance is not because Nerger more nearly anticipates than Ferguson, for the contrary is undoubtedly true, but is because of the decision of the circuit court of appeals above noted. Nerger's heel lift is described as being of concavo-convex form, but not as being concavo-convex on every cross-section thereof. The upper face does not lie, however, below a plane passing through the rear upper edge and the breast corners. All the edges are substantially straight and the deepest part of the concavity is not in the center of the lift, but on the line of its breast. Heels of this form and shape were made and sold in small quantities at retail in Chicago in the years 1901 to 1902, and samples have been produced and demonstrated before me. It is manifestly impossible that this heel could have the suction or adhering qualities of the Tufford heel, nor did the inventor attempt to obtain these qualities by the power of suction or adhesion. Nerger relied primarily on a spring metallic frame of the same curvature of the heel lift embedded therein to perform this function and to obtain a close-fitting heel lift which would not in use gap away from the leather heel proper. This metallic frame has lateral arms extending outwardly toward the edges, and this frame, it is observed, in use has a tendency to weaken and destroy the heel and to obtrude through the wearing surface of the heel lift.

I have examined the testimony in deposition form showing previous sale and use of the Nerger heel. Nerger ordered from Morgan & Wright, rubber manufacturers of Chicago, during the years 1901 and 1902, some 600 pairs of heels. These were peddled by him or one or another of his sons to shoe cobblers in and about Chicago. Nerger, his sons, and one or two other witnesses also testify that these heels gave satisfaction, adhered closely at the edges, did not gap away from the leather, and did not spread beyond the leather and wore well. Giving full weight to these statements, but taking this testimony as a whole, I am convinced that the Nerger heel lift was neither successful nor practicable, that a limited number only were sold, and that, owing to the inherent defects therein, it failed to meet or solve the problem of a desirable heel lift. Nerger brought this heel lift to the attention of different persons in his efforts to enlist their cooperation in making and selling them, but always without success. His invention must be regarded as a practical failure.

Moreover, even if the Ferguson or Nerger heel lifts had, in practice, accomplished the same results as the Tufford heel lift, the latter is, in my opinion, still such an advance over the prior art therein disclosed as would amount to patentable invention. The metallic circular washer of the Ferguson and the metallic spring frame with lateral arms of the Nerger heel are obvious disadvantages, and the evidence shows that no rubber heel lift embodying these features is or could be successful in practice. They destroy in large part the resiliency of the heel, which is the main purpose of all rubber heel lifts. They shorten the life of the heel lift, and increase the rapidity with which it wears out. They enhance substantially the cost of manufacture, for a heel lift carrying a metallic plate cannot be molded at a single operation from one piece of rubber, but must be molded in two sections with two operations.

I am of opinion that complainant's patent embodies invention and was not anticipated. The presumption of patentable invention flowing from the allowance of the application and the granting of a patent by the Patent Office authorities is strengthened to an unusual degree by the actual proceedings in this case. During the pendency of the reissue application Ferguson and Nerger were both cited against it. The Examiner repeatedly rejected the application, first because of Ferguson and Nerger patents, and later on Nerger's alone, and it was not until after he had seen, inspected, and demonstrated the Nerger and Tufford heels that he passed the application. The applicant did not modify or limit his claims as a result of these repeated rejections and finally the Examiner, upon further consideration, admitted his error and the patent was issued. In these circumstances, the granting of the patent carries more than the usual weight.

Furthermore the distinctive change in shape, form, and proportion in the Tufford heel lift over both the Ferguson and Nerger form is so great as in my opinion to amount to invention. In these respects it falls within the class of cases of which the following are types: *Faultless Rubber Co. v. Star Rubber Co.*, (C. C. A., 6; 202 Fed. Rep., 927; 121 C. C. A., 285;) *Diamond Rubber Co. v. Consolidated Rubber Co.*, (Grant rubber tire patent, C. D., 1911, 538; 166 O. G., 251; 220 U. S. 428; 31 Sup. Ct., 444.) In addition, the acceptance by the public and the phenomenal commercial success of the Tufford heel lift would, if the question of invention were otherwise doubtful, carry great, if not controlling, weight.

Defendant's contention that the reissue patent is invalid, because not for the same invention as was disclosed in the original, and because of undue delay in applying therefor, remains to be considered. Tufford's original application was filed July 21, 1913, and the patent thereon was issued September 15, 1914. The application for the reissue was filed June 22, 1915 and the patent was granted January 11, 1916; a period, it thus appears, of only nine months intervened from the granting of the original to the application for the reissue patent. The evidence also shows that this rubber heel lift, as now manufactured and sold, is precisely the same heel lift as was originally designed and invented by Tufford, and that no changes have been made in its shape form, or proportion since the first samples were made up by the Miller Rubber Company and sold to the public. The date of these first sales was February, 1915. In the interval between that date and the filing of the reissue application no patents were applied for or taken out by any other person embodying any of these features of the Tufford invention, nor did any person in this interval manufacture or sell any heel lift of like shape, form or proportion. Defendant's contention that there was undue delay in applying for the reissue, or that the reissue patent is void by reason thereof, cannot be sustained.

Defendant's contention that the reissue patent is for a new invention, not embodied in the original patent, is not sound. The original patent, it is true.

contained only four claims, and these are the first four of the reissue patent. The latter contains six additional claims, being 5 to 10, both inclusive. In the four original claims of the original patent the main features of the invention herein considered were not claimed; they are claimed in the new claims of the reissue patent. Tufford's original invention, however, not only included these features, but all of them were set out with reasonable clearness in his original specifications. The changes made in Figure 2 of the drawings of the reissue patent are slight and immaterial, and scarcely perceptible to the untrained eye. The additions made to the specifications are from lines 83 to 105, inclusive, on the second page. An examination of these added lines and a comparison thereof with the original does not show the introduction of any new idea not disclosed in substance in the original. These lines were added only to bring the same out with greater clearness.

Criticism is also made of the statement in these added lines that uniform pressure is exerted on the heel of a shoe when the lift is placed on the heel and the convex face thereof depressed to flatten the heel lift. This is said to be untrue, and, because untrue, the patent is invalid. That the pressure at the breast corners and at the rear edge of the heel is greater than at the other portions of the edges is probably true. Mechanically it is probably necessary that the heel lift should be circular in shape to get an absolute uniform pressure. The heel lift, however, when applied as directed to a flat surface, does create the impression of producing uniform pressure. The statement of the application is approximately correct, and its departure from the exact truth is, it seems to me, without any material importance.

My conclusion is that claims 5 to 10 are not for a new invention, not disclosed in the original application. All the conditions justifying a reissue patent are here present, and none of the grounds upon which such patents have been held void have been here shown to exist. Adequate authority for this conclusion is found in *American Automotoneer Co. v. Porter*, (C. C. A., 6; 232 Fed. Rep., 456; 146 C. C. A., 450.)

Coming to the question of infringement, the rubber heel lift sold by the defendant was manufactured by the Foster Rubber Company and known as the "cat's paw" heel lift. Defendant is a shoe dealer in the city of Cleveland, Ohio. Immediately upon receipt of notice from complainant of the alleged infringement, it ceased to make sales, and later returned to the Foster Rubber Company such stock as it had on hand. Defendant did not, however, enter a disclaimer as to the charge of infringement, nor give any assurance of an intention to refrain therefrom in the future. On the other hand, the defense in this action was undertaken by the Foster Rubber Company, and the validity of complainant's patent put in issue and complainant put upon full proof thereof. The infringing heel lift is of a small size, corresponding to complainant's size, "k," and is used on ladies' shoes and boots. It is an exact duplicate of complainant's heel of the same size. It is uniformly curved on every cross-section thereof. Its upper or concave face lies in a plane below the rear edge of the heel and the breast corners. It is of uniform thickness, and has the same qualities as complainant's heel lift of the same size. In my opinion infringement is fully shown.

A decree will be entered, sustaining the validity of claims 5 to 10, inclusive, of the patent, and awarding an injunction, but in view of the small sales and necessarily insignificant profits made by defendant from the infringement, an order of accounting is not justified and will not be had. In lieu of an accounting, nominal damages of \$1 are awarded, and may be included in the decree.

[U. S. Circuit Court of Appeals—First Circuit.]

I. T. S. RUBBER CO. v. PANTHER RUBBER MFG. CO.

Decided May 26, 1919; rehearing denied July 23, 1919.

271 O. G., 512; 260 Fed. Rep., 934.

1. MOLDS FOR FORMING RUBBER HEELS—PATENT VALID AND INFRINGED.

The Tufford patent, No. 1,177,833, for a mold for making rubber heels, *Held* not anticipated and to disclose patentable invention; also infringed.

2. SCOPE OF PATENT—EFFECT OF FAILURE TO STATE MODE OF OPERATION OF DEVICE.

A patentee's failure to state in the patent the new mode of operation which his device in fact contains and which produces a new and beneficial result does not prohibit the court from taking these merits into consideration in determining the scope of the invention or the validity of the patent.

3. CLAIMS—LANGUAGE CONSTRUED IN THE LIGHT OF THE SPECIFICATION.

Where the language of a claim includes elements described in general terms, the court may look to the specification for the purpose of construing the language and ascertaining its meaning. "Concave" and "convex" may be used in a restricted and technical sense or may be used loosely. In view of the specification in this case *Held* that they refer to surfaces which are spherical throughout their areas.

APPEAL from the District Court of the United States for the District of Massachusetts; Frederic Dodge, judge.

Suit in equity by the I. T. S. Rubber Company against the Panther Rubber Manufacturing Company. *Decree for defendant, and complainant appeals. Reversed.*

Mr. F. O. Richey and *Mr. Charles A. Brown* (*Mr. F. A. Tennant* on the brief) for the appellant.

Mr. Horace Van Everen (*Mr. Burton W. Cary* on the brief) for the appellee.

Before BINGHAM, JOHNSON, and ANDERSON, Circuit Judges.

BINGHAM, *Cir. J.*:

(1) The plaintiff, the I. T. S. Rubber Company, is the owner of United States Letters Patent No. 1,177,833, issued to John G. Tufford, and complains of its infringement by the defendant, the Panther Rubber Manufacturing Company. The patent is for a mold for making rubber heels. There are twelve claims in the patent, but the only one in issue is No. 11, which reads as follows:

A mold for forming heel lifts including assembled parts, one of which is provided with a molding chamber having the general outline of a heel lift, one wall of the molding chamber being concave and the opposed wall of said chamber having a convex surface coacting with said concave wall, one of said walls being provided with washer supporting devices.

In the district court it was held: (1) that the device was not patentably new as it was anticipated by the Nerger mold; (2) that, inasmuch as the claim in issue, by its terms, covered all concavo-convex molds whether the surfaces of the opposing walls were spherical or not, the claim was invalid; (3) that if the claim could be regarded as valid by being limited to the particular structure shown and described in the patent, the defendant's mold did not infringe it; and (4) if it could be regarded as valid without being thus limited, the defendant's mold did infringe.

The specification and claims as originally filed in the Patent Office related, not only to the mold to be employed in the manufacture of rubber heels, but to the method of acting upon the rubber to produce the heels. The claims for the method were later stricken out, and a patent was issued for the mold, but the description of the method was left in the specification.

In the specification the patentee declares:

The object of the invention is to produce a resilient heel, which will have its attaching face concave throughout its area whereby, when the heel or lift is placed against the flat under surface of a leather or other shoe heel and pressure applied to the resilient heel or lift, a vacuum or suction cup may be formed whereby the heel or lift will be held to the shoe temporarily until the nails can be applied. A further object of the invention is to produce a heel which, when applied to a shoe, will have a flat tread surface, and which may be equipped with fastening devices so located that the heel can be easily trimmed down to a required size.

He further states that—

the invention resides in certain novel features of a mold such as is illustrated in the accompanying drawings.

In the drawings he shows a base-plate 1, an intermediate plate 2, and a top plate 3 in which are cooperating instrumentalities whereby the complete heel is produced.

The base plate 1 is provided in its upper surface with a recess or cavity 4 which is a true section of a sphere, and from the concave surface of which rises pins 5 grouped near the deepest point or center of the recess or cavity and provided intermediate their ends with annular shoulders or supports 6. The intermediate plate or mold member 2 is formed on its under side with a convex projection, indicated at 7, of a curvature which will permit it to fit snugly in the concave recess or chamber 4 in the base plate. The upper face of the intermediate member 2 is provided with a circular depression or recess, indicated at 8, and this concave circular recess or depression alines axially with the convex projection 7 on the under side of the plate. A central opening 9 is formed through the intermediate plate or mold member, and this opening 9 has an outline corresponding to the usual outline of a shoe heel or lift. The said intermediate plate or mold member is further provided in its upper face with a shallow circular overflow cavity or recess 10, the purpose of which will presently appear. The top plate or mold member 3 is provided on its under side with a convex projection 11 the convex surface of which is a true section of a sphere and an exact complement of the concave chamber or recess 4 and

adapted to fit in the concave depression 8 of the intermediate member. Upon the apex or deepest portion of this convex projection 11, I provide ribs 12 which preferably define a space of the same shape as a shoe heel and extend parallel or concentric with the walls of the opening 9. Within the space so defined, I provide intersecting ribs 13, the purpose of which will presently appear.

In the practice of the invention, the several plates or mold members are superimposed, * * * and to cause them to aline with exactness the intermediate plate is provided on both its upper and lower surfaces with studs or lugs 14 adapted to engage openings or sockets 15 and 16 in the top plate and the base plate, respectively.

In preparing the mold for operation, the specification states:

The base plate 1 and the intermediate plate 2 are assembled in their proper positions. * * * Small metallic washers, indicated at 18, are slipped over the ends of pins 5 so as to rest upon the shoulders 6 and project beyond the edges of said shoulders either before or after the said plates are assembled, and rubber or composition is then placed in the chamber formed by the cavity 4 and the opening 9 so as to completely fill the said opening. The top plate is then placed in position over the intermediate plate with its convex projection 11 entering the depression 8 and bearing directly upon the plastic mass in the opening 9. The plates are steam heated at all times so as to be maintained at a high temperature, and after the several plates or mold members are assembled, pressure is applied to the plates by means of a hydraulic press or other machine so that the plastic mass in the opening 9 will be compressed and solidified, the heat of the plates serving to vulcanize the mass to such an extent that it will be rendered very tough and durable but, at the same time, will retain its resiliency.

After an interval sufficient to permit the desired vulcanization of the mass, the several plates are separated [and the heel is removed.]

It is further stated that—

the ribs 12 and 13 upon the top plate will * * * produce grooves in the upper face of the heel, and these grooves will mark off separate suction areas at the center of the heel, while, at the same time, the entire upper attaching face of the heel will form a suction area so that the heel may be readily placed in position upon a shoe and will set positively in its position while nails or other fastening devices are being driven through the openings formed by the pins 5—

and that—

the heel produced * * * will have a concave attaching face and a convex tread face throughout its area and, when it is placed against a flat shoe heel, a sharp blow delivered thereon will flatten its opposite faces, so that the air contained between the attaching face of the rubber heel or lift and the leather surface of the shoe will be driven out, and the rubber heel or lift held to the shoe by the suction thus produced.

The evidence shows that in practice the device is operated as follows: Washers are placed upon the washer-pins of the lower plate, forming what is termed a table; the intermediate plate is placed upon the bottom plate; a blank piece of rubber or composition, either circular in shape or having the general outline of a heel-lift, and of

sufficient volume to fill the cavity of the mold, is placed on the washer-pins; the top plate is placed in position and held in alinement by the dowel-pins shown in Figure 1, so that the convex portion 11 engages the rubber; pressure is applied to the plates by means of a hydraulic press; the plates are kept steam-heated at all times; and after a given time the pressure is released and again suddenly applied for the purpose of driving out the air and still further pressing and solidifying the material. The release and sudden application of the pressure is termed "bumping" and is repeated several times. This is the way in which the operator handles the mold, and is the way commonly pursued in the prior art, except that in operating the plaintiff's mold the bumping is repeated a greater number of times.

The evidence further shows, and we find, that the mode of operation peculiar to the plaintiff's device—that is, the treatment of the material by the mold—is as follows: The convex surface of the upper plate engages and forces itself into the center of the stock, driving the material toward the edges of the mold and trapping air beneath the stock and between it and the bottom of the cavity in the concave member of the mold; as the convex member is pressed farther down, the trapped air resists the pressure and further tends to drive the material toward the edges; the pressure compresses and solidifies the plastic mass and the heat vulcanizes it; and as a result of this mode of operation the outer edges of the heel are rendered more dense but still retain their resilient qualities.

Rubber heels thus produced wear longer and are tougher and more durable at the edges. It is the air trapped in the cavity of the lower surface, acting in conjunction with other elements, that drives the material to the outer edges of the mold and there solidifies and compresses it. The mode of operation found to exist in the plaintiff's device does not depend upon the shape of the rubber blank at the time it is placed in the cavity of the mold, for it operates upon the stock in its plastic state and forces it to the outer edges of the mold. The essential characteristic of the rubber blank is that it shall be of sufficient volume to fill the cavity of the mold. It is at the edge of the heel that the greatest wear comes, and it is especially desirable to overcome this as far as possible and still keep the heel resilient. This result was accomplished in a substantial manner through the peculiar mode of operation of the plaintiff's device, and we think it involved invention.

(2) The patent is for a structure, and the plaintiff is entitled to the benefit of all the advantages which it possesses over the prior structures intended to accomplish a similar purpose; and the patentee's failure to state in the patent the new mode of operation which his device in fact contains, and which produces a new and beneficial

result, does not prohibit the court from taking these merits into consideration in determining the scope of the invention or the validity of the patent. (*Warren Steam Pump Co. v. Blake & Knowles Steam Pump Works*, 163 Fed. Rep., 263; 91 C. C. A., 19.)

Another result accomplished was to give the heel the quality of closely attaching itself to a flat shoe-heel by suction when placed against such heel and given a sharp blow. This was a beneficial result, as it did away with the necessity of using cement and excluded dirt and water, as the clinging effect continued after the heel was permanently affixed to the shoe with nails or other attaching means.

The proofs show that the heel produced by the mold met with immediate commercial success; that the number of heels manufactured a month in 1915 was 50,000; and at the time of the trial in May, 1917, about 100,000 a day, or 3,000,000 a month; that the number of molds in use increased from 13, with 600 cavities, in March, 1915, working 10 hours a day, to 68 molds, with 3,100 cavities, in May, 1917, working 22 hours a day; and that this was due to the merit of the article rather than business enterprise.

(3) It is contended on the part of the defendant that the claim in suit is invalid, that the words "concave" and "convex" are not limited in their application to surfaces which are spherical, and that so to limit the claim would be to read into it a new element. We recognize that it is not the province of the court to add to a claim an element not embraced within its language; but, where the language of a claim includes elements described in general terms, we understand that it is the province of the court, for the purpose of construing the language and ascertaining its meaning, to look to the specification. (*Bates v. Coe*, C. D., 1879, 365; 15 O. G., 337; 98 U. S., 31; *Stillwell-Bierce & Smith-Vaile Co. v. Eufaula Cotton Oil Co.*, 117 Fed. Rep., 410; 54 C. C. A., 584; *Lamb Knit Goods Co. v. Lamb Glove & Mitten Co.*, 120 Fed. Rep., 267; 56 C. C. A., 547.) The words "concave" and "convex," as applied to surfaces, in their more restricted and technical sense, mean surfaces every line of which and at every point are concave or convex, in the manner of a sphere (*Century Dictionary*) or of an egg-shell, (*Webster's Standard Dictionary*.) They are also loosely used to define cavities or projections which do not possess concave or convex qualities throughout their surfaces. The meaning of the language employed in the claim being doubtful, we think resort may properly be had to the specification to ascertain the sense in which the words in question were used. The specification frees the matter from doubt, for there the concave and convex surfaces of the opposing walls are shown to be spherical throughout their areas.

The defendant further contends that the claim is anticipated by the prior art as shown in the mold of Nerger; but this is clearly not

so when the claim is understood in the sense in which we have construed it. The surfaces of the opposing walls of the Nerger mold are not spherical, nor are they concavo-convex, in the more restricted meaning of the words. The line of the breast of the heel in both the upper and lower plates is, no doubt, concavo-convex across the heel; but no line drawn lengthwise of these plates possesses those qualities, and the outer edges of the surfaces are in the same plane throughout. On the other hand, in the plaintiff's and the alleged infringing device of the defendant, the edges of the opposing surfaces at every point are concavo-convex. It is manifest that in the Nerger mold means for pocketing the air that will produce the mode of operation found in the plaintiff's device do not exist. We think, therefore, that neither the Nerger mold, nor any of the molds relied on in the prior art, anticipate the mold of the plaintiff.

It was found in the court below that the defendant's mold infringes claim 11 of the plaintiff's patent, if it could be regarded as valid without being limited to the particular structure shown and described in the patent. This claim does not embody certain special features shown and described in the specification pertaining to the upper and lower sides of the intermediate plate. These are mere details of construction, and not essential, as other means well known in the art may be employed. The essential means for producing this mode of operation are set out in the claim, and, as we regard it as valid, we have no hesitation in finding that it is infringed by the defendant's mold; the curvature of whose opposing surfaces are spherical throughout their areas and are mathematically the same.

The decree of the district court is reversed, and the case is remanded to that court for further proceedings not inconsistent with this opinion, with costs in this court to the appellant.

[U. S. Circuit Court of Appeals—Fifth Circuit.]

REED v. HUGHES TOOL CO.

Decided October 6, 1919; rehearing denied December 6, 1919.

272 O. G., 373; 261 Fed. Rep., 192.

1. PATENTS—PATENT FOR WELL-DRILLS VALID AND INFRINGED.

The Griffin patent, No. 1,195,209, and the Hughes patent, No. 1,124,241, each for a rotary well-boring drill, *Held* not anticipated, valid, and infringed.

2. SAME—VALIDITY OF PATENT NOT AFFECTED BY NON-USER.

The validity of a patent is not affected by non-user of the patented device if it has utility in the sense of being capable of successful mechanical operation.

3. SAME—IMPROVEMENT, THOUGH PATENTED, MAY INFRINGE PRIOR PATENT.

An improver cannot appropriate the invention of his predecessor, who has obtained a patent, as a base for his improvement without infringement, even though the improvement has been patented.

APPEAL from the District Court of the United States for the Southern District of Texas; Waller T. Burns, judge.

Suit in equity by the Hughes Tool Company against Clarence E. Reed and others. *Decree for complainant, and defendant named appeals. Affirmed.*

Mr. C. A. Teagle, Mr. Edwin T. Merrick, Mr. Ralph J. Schwarz, Mr. Philip Gensler, Jr., and Mr. William F. Hall for the appellant.

Mr. John A. Mobley and Mr. Jesse R. Stone (Messrs. Andrews, Streetman, Logue & Mobley on the brief) for the appellee.

Before WALKER and BATTS, Circuit Judges, and GRUBB, District Judge.

PER CURIAM:

This is an appeal from a decree of the District Court of the United States for the Southern District of Texas, Houston Division, in favor of the plaintiff (appellee), and against one of the defendants (appellant), establishing the validity of two certain patents sued on by the plaintiff, namely, Patent No. 1,195,209, issued to T. J. Griffin on August 22, 1916, and Patent No. 1,124,241, issued to Howard R. Hughes on January 5, 1915, and determining that the appellant, Clarence E. Reed, had infringed certain of the claims of each of the patents sued upon. The patents related to rotary boring-drills used in the drilling of oil-wells. The appellant's alleged infringing device had also been patented by him.

The principal grounds upon which the validity of each of the two patents sued upon by the appellee were assailed by the appellant were that both had been anticipated by the prior art, and a number of prior patents were cited and relied upon by the appellant to show anticipation, and that the patents in suit had never been successfully and commercially exploited by appellee.

(1) One of the two patents sued on was issued to Thos. J. Griffin on August 22, 1916, and the other was issued to Howard R. Hughes on January 5, 1915. The application for the former was, however, filed on June 11, 1913, while that for the latter was not filed until November 1, 1913. The plaintiff was the owner of both patents when the bill was filed. The inventions covered by the patents consisted of a bit for drilling wells which had a cylindrical head with two cutting-disks in the base of the head, the disks being offset relatively to the axis of rotation of the head, for the purpose of affording clearance to the bit. The claim of novelty was based on the arrange-

ment of the cutter-disks relatively to each other and the shape of the disks themselves. The plaintiff contended that this arrangement and shape of the disks performed the two functions of shearing off the material by the action of a sharp advancing edge and of pulverizing or disintegrating the sheared-off material by the action of a broad crushing-face, curved to bear across the entire width of the bore-hole, and which also prevented the rapid wearing away of the edge. The plaintiff contended that no such arrangement with corresponding functions existed in the prior art in boring-drills.

The appellant relied upon a number of prior patents, some of which covered stone-dressing tools, and some rock-boring drills. We have examined these patents, as bearing upon the state of the prior art at the time the patents in suit were applied for. Probably what is designated as the Litaker patent comes nearer to anticipating the invention disclosed by the patents in suit than any of those cited and relied upon. An examination of the claims of that patent differentiates it from the Griffin and Hughes patents in suit, in that there is an absence in the Litaker disks of any crushing-surfaces, such as are present in the disks of the Griffin and Hughes patents, and also an absence of any provision for the disintegrating of the material that is cut away by the action of the cutting-disks, so that it can be removed in suspension by the water used for flushing.

The patents in suit have the feature peculiar to them of rotary revolving disks, so placed, formed, and operated as to make a hole with a cup-shaped bottom, which is deepened by cutting or shearing or scraping material from the sides and grinding it up in the bottom so fine that it can be removed in suspension from the drill by a flushing stream of water. The Litaker patent discloses a cutting-disk that performs only the single function of cutting or shearing away the material from the bottom of the bore-hole, and is without any provision for crushing or pulverizing the material as it is cut away in the operation of the device. The Litaker drill, according to the language of its claims, provides disks only as cutting elements and for the removal of the loosened material without crushing or disintegration before removal. Certainly in the art of well-boring the patents in suit were the first that had this feature, and we think it has sufficient importance and novelty to give it the quality of invention, and that it was not anticipated by any of the earlier patents cited, including the Litaker patent.

(2) We conclude from the record that the bits constructed according to the Hughes and Griffin patents were physically operative devices capable of successful practical use. There is evidence that they had not been commercially developed, possibly because of their comparatively high cost, and the conservatism of well-drillers. The

validity of the patents is not affected by non-user of the patented devices, if they have utility in the sense of being capable of successful mechanical operation. (*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, C. D., 1908, 594; 136 O. G., 1297; 210 U. S., 405; 28 Sup. Ct., 748; *Lewis Machine Co. v. Premium Mfg. Co.*, 163 Fed. Rep., 954; 90 C. C. A., 310.)

We conclude, as did the district judge, that either the Griffin or the Hughes patent on each of which the plaintiff sued, was a valid patent.

Coming to the question of infringement, we think that the Reed drill was substantially identical in structure and functions with the drills of the patents in suit. It has a cylindrical head, with two cutting-disks housed in slots in the base of the head, and arranged with an offset in the same manner as the devices of the patent in suit. The cutting-disks are substantially the same, except that the edge of the Reed cutter is beveled. The Reed drill has an improvement upon the drills disclosed by the patents in suit, consisting of the closing of the slot at the rear edge of each of the cutting-disks, thus affording a restricted passage for the flushing-water, thereby preventing a clogging of the disks. It is conceded that this constitutes an improvement upon the drills covered by both the Griffin and Hughes patents. It is also true that a patent has been issued to Reed to cover this improvement. The Reed bit, however, appropriates for the base of this improvement the invention of the patents in suit.

(3) The law is settled that an improver cannot appropriate the invention of his predecessor, who has obtained a patent, as a base for his improvement, without the consent of the patentee, and without infringement, even though the improvement has become the subject-matter of a patent. In the case of *Cantrell v. Wallick* (C. D., 1886, 207; 35 O. G., 871; 117 U. S., 689; 6 Sup. Ct., 970) the Supreme Court said:

Two patents may both be valid, when the second is an improvement on the first, in which event, if the second includes the first, neither of the two patentees can lawfully use the invention of the other without the other's consent.

In the case of *Cochrane v. Deener* (C. D., 1877, 242; 11 O. G., 687; 94 U. S., 780) the Supreme Court said:

The defendants admit that the process produced a revolution in the manufacture of flour, but they attribute that revolution to their improvements. It may be as they say, that it is greatly due to these. But it cannot be seriously denied that Cochrane's invention lies at the bottom of these improvements, is involved in them, and was itself capable of beneficial use, and was put to such use. It had all the elements and circumstances necessary for sustaining the patent, and cannot be appropriated by the defendants, even though supplemented by and enveloped in very important and material improvements of their own.

In the case of *Yancey v. Enright* (230 Fed. Rep., 641, 647; 145 C. C. A., 51, 57) this court said:

The addition of an improving feature does not excuse the appropriation of the appellant's invention, covered by the patent, since we have construed the appellant's idea to be more than a mere improvement in form, and a distinct and valuable advance in the art.

As we are of the opinion that the patents in suit are valid patents and have been infringed by the appellant, the decree of the district court appealed from is affirmed.

BATTS, *Cir. J.*, did not take part in the decision of this case.

[U. S. Circuit Court of Appeals—Seventh Circuit.]

RODMAN CHEMICAL CO. *v.* DEEDS COMMERCIAL LABORATORIES.

Decided October 7, 1919.

272 O. G., 374; 261 Fed. Rep., 189.

1. PATENTS—PRIOR USE.

Rodman patent, No. 1,076,453, for a method for making case-hardening material, *Held* not invalid on the ground of prior use.

2. SAME—INFRINGEMENT—CASE-HARDENING MATERIAL.

The Rodman patent, No. 1,076,453, for a case-hardening material, which material was composed of carbonaceous pellets, *Held* infringed.

3. SAME—ANTICIPATION.

The Rodman patent, No. 1,076,453, for a case-hardening material, claims 1, 7, 17, 22, and 25, consisting of pellets of carbon, etc., *Held* not anticipated and to show invention.

4. SAME—CLAIM OMITTING REFERENCE TO ESSENTIAL ELEMENT.

Claim 10 of the Rodman patent, No. 1,076,453, for "the method of adapting finely divided material for dry packing for use as carbonizing material, which consists in mixing the material with a binding agent and separating the resulting mass into relatively small masses of appreciable size, which omits the element whereby the product will retain its identity under heat, found in the other claims, *Held* void, as being incomplete and vague.

APPEAL from the District Court of the United States for the District of Indiana.

Bill by the Rodman Chemical Company against the Deeds Commercial Laboratories. *From a decree dismissing the bill, complainant appeals. Reversed and remanded.*

Mr. Fred W. Winter, for the appellant.

Mr. V. H. Lockwood for the appellee.

Before BAKER, MACK, and EVANS, Circuit Judges.

MACK, *Cir. J.*:

Letters Patent No. 1,076,453, granted to appellant, as assignee of Hugh Rodman, on October 21, 1913, are entitled as for a "method

of making case-hardening material." In the specifications, the invention, it is stated—

relates to improved methods of manufacturing carbonizing material for dry packing.

The product sought to be obtained by the patented method was small masses or pebbles of carbonizing material, made out of what was theretofore largely waste dust. The advantage over other carbonizing products was its reduced cost, due to the utilization of a waste product, its greater thermal conductivity, easier handling over powdered or dusty carbonizing materials, and especially its retention of identity under heat.

While the preferred method indicated in the specifications necessitated the use of powdered coking-coal, and made the internal coking thereof a step in the method of manufacturing the product, the inventor specified also the use of powdered charcoal as a substitute, with the omission of coking as a necessary step in the method.

Claims 1, 7, 10, 17, 22, and 25 are in suit. Claim 1 reads as follows:

1. The method of adapting finely divided material for use as carbonizing material, which consists in mixing the material with a binding agent and forming small masses, which will maintain their identities when heated.

Claim 22 differs only in describing the binding agent as "tacky," and claim 25 by adding after the words "binding agent" the phrase "such as molasses."

In claim 7, the method of forming "small rounded pebbles," instead of "small masses," is stated as "tumbling to form."

In claim 10, the finely-divided material is limited by adding "for dry packing," and in lieu of the final clause in claim 1, "forming * * * heated," there is substituted "separating the resulting mass into relatively small masses of appreciable size."

Claim 17 reads:

17. The method of preparing carbonizing material which consists in fashioning finely divided material into substantially smooth-surfaced pebbles and in then applying heat thereto.

A bill to enjoin alleged infringement was dismissed for want of equity. No opinion was filed. The defenses relied upon were prior use, anticipation and invalidity for lack of invention, and non-infringement.

(1) *1. Prior use.*—While there is some evidence tending to show use and sales of this product more than two years before the application for patent was filed, not only does it fall far short of the clear proof required to sustain this defense, but we are satisfied that it is clearly and conclusively controverted. Plaintiff manufactured successively and contemporaneously several kinds of carbonizing materials; the product from the method of the patent in suit was

the final and most successful one; it differed both in substance, in form, and in quality from the others; each marked an advancing step in the manufacture of a valuable commercial product; each was produced by a definitely distinct method. The proof is clear that neither the method in suit nor the product thereof was used by plaintiff prior to 1912.

(2) *2. Infringement.*—Concededly there is infringement, except as to claim 7, if the claims are to be broadly interpreted. Defendant uses charred carbonaceous materials in powdered form and a solution of molasses and water; they are mixed in a mixing-machine; small balls or pills are thereby produced. The proper-sized ones are first air-dried, and are then dried in a revolving drum with heat applied. While the alleged purpose of the final heating is to dry out excess moisture, the effect thereof in this revolving drum is to reduce the size of the pills and to compact and harden them. Whether this be technically a “tumbling” operation or not, it is the clear equivalent thereof; the sole purpose of tumbling is to compact and harden the pill; whether this be accomplished in one operation during their formation as pills, or in two, is immaterial. As heretofore stated, plaintiff is not confined to the use of such carbonaceous material as requires coking; defendant’s use of coked or charred powder as against plaintiff’s preferential method of using coking-coal dust does not therefore avoid infringement. While some carbonaceous materials, like charred leather, require no special preparation, others, like charcoal, coke, or coal, require for commercial use at any practicable temperature the addition of a chemical, called energizer, such as lime, in order to activate the carbon. But the patent is not limited to the use of a carbonaceous material requiring the addition of an energizer; the carbonizing material in each of the claims covers as well carbonaceous materials, such as charred leather or corncobs used by defendant, having in themselves sufficient energy to activate the carbon.

(3) *3. Anticipation and want of invention.*—Case-hardening is a species of carbonizing. If it be desired to harden the metal throughout, a carbon is dissolved into the molten metal. If, however, only the surface is to be hardened, so-called case-hardening, the finished product is packed in dry carbonizing material; the box is sealed and placed in a red-hot furnace for several hours; the carbon gases produced are absorbed only by the surface of the metal. When the required depth of carbonization is secured, the article is dropped, red hot, into cold water; this makes the carbon skin or “case” perfectly hard. The interior of the article, not having been carbonized, remains soft and tough. The desirable and sought-after product for case-hardening was one that would be susceptible of repeated

use; the small pill, maintaining its identity when heated, answered this need. The uniform distribution of carbon and energizer, resulting from their use in powdered form, and the maintenance of this relation by the permanent binding together of the particles, as well as the freedom from dust, were additional advantages of this pill or pellet formation. Moreover, a waste material, the coal or coke dust, theretofore discarded, was utilized.

A new product was thus created; a product of commercial value for definite uses.

Earlier patents, Dodds, British, No. 571, Aube, British, No. 738, Demenge, No. 564,053, Logan, Germany, No. 181,531, all of which mention incidentally case-hardening and Meyer, No. 524,904, while referring to the use of carbonizing-briquets made of powdered materials or of balls of carbonizing-paste, give no hint that these products will not be completely absorbed in a single carbonizing process, or that they will maintain their identity under heat; nothing whatever is said in any of them as to the method of manufacture. In our judgment, they are different products than those made under the process of the patent in suit.

Rodman's own earlier process and product patents, Nos. 949,442 and 949,448, and others, are likewise for a different product and process.

While each step in the process of making these pellets may be old as applied to other articles, the conception of this novel product, and of the combination of acts necessary to produce it is novel.

That the possible hints given by the patents cited were never grasped, that tons of coal and coke dust were allowed to go to waste, strengthen the presumption, inherent in the grant of the patent, that the conception involved an exercise of the inventive faculties and was not an obvious deduction.

In the light of the present knowledge, it may have been a simple matter for defendant's expert, from a reading of the earlier patents, to create a product identical with that of the process in suit and by the same means; this, however, is no demonstration that the product or method would have been obvious to one skilled in the art but ignorant of the patent in suit.

Plaintiff's essential contribution to the art through the patent in suit was the step by which the identity of the small pellets was maintained, and their continued use, in actual practice for some five hundred hours, made possible. Defendant made a substantially identical product by a substantially identical method.

Of the claims in suit, all except claim 10 cover the entire process of manufacturing the product that will retain its identity under heat; in claim 17, the final application of heat is expressly specified

as a step in the process. Each of them must be held valid and infringed.

(4) Claim 10, however, omits this element; it is incomplete and vague, and must be adjudged invalid.

The decree will be reversed, and the cause remanded for further proceedings consonant with the views herein expressed.

[U. S. Circuit Court of Appeals—Ninth Circuit.]

SMITH CANNERY MACHINES CO. v. SEATTLE-ASTORIA IRON WORKS *et al.*

Decided November 30, 1919.

272 O. G., 376; 261 Fed. Rep., 85.

1. PATENTS—INFRINGEMENT—FISH-DRESSING MACHINE.

The Smith patent, No. 979,103, for a fish-dressing machine, claims 38, 39, 40, and 41 *Held* valid and infringed.

2. SAME—SAME—EQUIVALENTS—RANGE.

Protection against the use of mechanical equivalents in a combination is governed by the same rules as in case of other patents, and where a combination patent marks a distinct advance in the art the term "mechanical equivalent" should have a reasonably broad and generous interpretation.

3. SAME—SAME—MERE ADDITION OR IMPROVEMENT DOES NOT AVOID.

That an infringing machine is superior, more useful, and more acceptable to the public than that of a patent does not avoid infringement where the essential features of the patented machine are used, unless its superiority is due to a difference in function or mode of operation or some essential change in character.

4. SAME—SAME.

That a part of defendant's device performs a function additional to a corresponding part of plaintiff's device does not avoid infringement.

APPEAL from the District Court of the United States for the Northern Division of the Western District of Washington; Edward E. Cushman, judge.

Suit in equity by the Smith Cannery Machines Company against the Seattle-Astoria Iron Works, Thomas A. Heckman, and N. C. NicholSEN. *Decree for defendants and complainant appeals. Reversed.*

Messrs. Grosscup & Morrow and *Mr. Hiram E. Hadley* for the appellant.

Messrs. Farrell, Kane & Stratton for appellee Seattle-Astoria Iron Works.

Mr. C. H. Hanford for appellees Heckman and NicholSEN.

Before GILBERT, ROSS, and HUNT, Circuit Judges.

GILBERT, *Cir. J.*:

(1) The appellant brought a suit for infringement of two Letters Patent, which it owned as the assignee of the inventor, E. A. Smith.

The patents are each for fish-dressing machine, the first of which is No. 796,538, issued on August 8, 1905, and the second is No. 979,103, issued on December 20, 1910. The court below found that there was no infringement and dismissed the bill.

The machines described in the patents are complicated, and the claims are many, for the reason that they include various operations in cleaning and preparing the fish, such as removing the heads, tails, and dorsal and ventral fins, as well as opening and cleansing the fish. The controversy centers about that portion of the combination which relates to cutting open the fish. Numerous prior patents had issued for fish-dressing machines, none of which had gone into successful use, for the reason that they all were deficient in automatic means for handling and opening fish of different sizes. The appellant's patents were the first to overcome that difficulty, and the appellant's machines went into universal use in the salmon-packing industry on the Pacific coast. At the time of the trial there were in use 283 machines under the appellant's patents. Said the court below :

The devices of the patent in suit well-nigh took the entire field upon its introduction, and plaintiff is entitled to a liberal range of equivalents.

The feature that distinguished the appellant's machine from those which had preceded it is its flexibility, its capacity to receive and operate upon various sizes of fish as they come to the machine, and the essence of that portion of the combination which produces this result is that the cutting-saw which rips open the belly of the fish is protected from cutting too deeply by a device which rests upon the body of the fish, and takes advantage of resistance upon the solid back of the fish; it being at the same time essential that in the operation the solid portion of the fish back of the visceral cavity shall not be cut.

In the appellant's machine, after the preparatory service of cutting off head, fins, and tail, the fish is fastened on its back on a circular carrier and moved thereon tail end first. It approaches the splitter held by gripping devices and guides so adjusted that the fish is gradually and firmly centered, so that the splitter, which is a small circular saw, will cut along the medial line of the fish-belly, beginning at the vent. The splitter is operated in a frame at the free end of a pivoted arm which has no lateral movement, but is permitted movement to and from the carrier. Attached to the frame is a shoe consisting of two parallel plates between which the saw rotates. The plates are so formed and placed as to permit the saw to begin its splitting function, and, after the splitting has progressed a short distance, the lower edges of the plate press on the inside of the back of the fish, and so adjust the movement of the saw that it shall not mutilate the back of the fish. But, before

the plates enter the cavity of the fish, the depth of the cut is regulated by pressure on the outside of the fish, accomplished by means of flared sides on the forward extension of the plates. The rear ends of the plates are so shaped that they turn the sides of the fish over outwardly after it has been split open, throwing the belly inside out, and so holding it open for the operation of the cleaning mechanism.

The appellees' machine is covered by a patent issued on February 27, 1917, to N. C. Nichol森 and T. A. Heckman, Letters No. 1,217,809. The appellees' apparatus is mounted on a quadrilateral frame, lengthwise of which is a V-shaped trough, in the bottom of which chains are carried by sprockets. On each link of the chain is set a sharpened pin so placed as to engage the fish near the back as it comes upon the trough, and carry it the length of the trough. A spring-presser holds the fish against the chains, and aids in centering and fastening the fish back downward firmly against the chains. The fish-splitting mechanism is described as of the form of a plow of two moldboards, so formed as to turn furrows in opposite directions, the perpendicular sides of which moldboards are parallel and in close proximity, leaving between them a slot in which a circular saw is revolved. The plow, together with the saw, is attached to the free end of a shaft, the other end of which is pivotally attached to and supported on the main frame. The pivotal attachment permits the splitting device to move to and from the trough, and it has no lateral movement.

As the fish, with its head removed, approaches the saw, head end foremost, the toe of the plow enters the ventral cavity, and by gravity presses upon the back of the fish, and the saw which revolves in the same frame to which the plow is attached, automatically accommodates itself to the size of the fish, the varying depth of the fish-body moving the saw up and down, and thus regulating the depth of the cut. As the fish is ripped open, the moldboards of the plow spread it open and turn the fish inside out, during which operation the base of the plow rests upon the solid back of the fish; the periphery of the saw being slightly above the base of the plow. In the rear of the plow and above, over the trough, there are forked arms pivotally supporting two metallic rods, which are not fastened to the moldboards of the plow, but come in such proximity to it to engage the inner surface of the fish-belly as it is spread open outwardly, and then hold the fish so as to permit the action of the fish-cleansing devices. The toe of the plow is a necessary part of the automatic mechanism by which the depth of the splitting-saw is regulated, and by which the defendants' machine is susceptible of operation on fish of different sizes.

The following are the claims of the appellant's patent, No. 979,103, which are principally involved:

38. In a fish-dressing machine, a frame, a carrier supported thereon for movement, means on the carrier for holding a body, a splitter arranged in the path of said carrier, means swingingly connected with the frame for supporting said splitter, and shoes on opposite side of said splitter swingingly connected to said last means.

39. In a fish-dressing machine, a main frame, a carrier supported thereon for movement, means on the carrier for holding a body, a frame swingingly supported on said main frame, a splitter supported by said last frame, a yieldingly pressed means connected with said last frame for independent movement toward and from the carrier, and shoes on said last means disposed to engage the fish body to regulate the depth of cut of said splitter.

Claims 40 and 41 add to the elements of the foregoing claims the members whose function it is to spread the cut-open body of the fish and expose the whole cavity to the body-cleansing devices.

We think that the appellant's claims are readable upon the appellees' machine, notwithstanding the fact that in the operation of the appellant's machine the fish go tail end first, while the reverse is true of the appellees' machine. The claims of the appellant's patent contain no limitation to either mode of operation. Comparing the two machines we find that the plates between which appellant's splitting-saw revolves extend slightly below the periphery of the saw and yieldingly press upon the inside of the back of the fish after the first cutting movement. This pressure regulates the movement of the plates to and from the fish, and the flaring tops of the plates engage the fish before it is sufficiently opened to permit the bottom of the plates to perform their function. This function in the appellees' machine is performed by the bottom of the plow which constitutes the means which by pressure on the body of the fish govern the movement of the appellees' frame to and from the fish, and thus regulate the depth of the cut. The appellees have thus, we think, availed themselves of the essential features of the appellant's combination.

(2, 3) Where a combination patent marks a distinct advance in the art to which it relates, as does the appellant's invention here, the term "mechanical equivalent" should have a reasonably broad and generous interpretation, and protection against the use of mechanical equivalents in a combination patent is governed by the same rules as patents for other inventions. (*Imhaeuser v. Buerk*, C. D., 1880, 362; 17 O. G., 795; 101 U. S., 647.) The fact, if it be a fact, that the infringing machine is superior, more useful, and more acceptable to the public than that of the appellant, does not avoid infringement, so long as the essential features of the appellant's patented machine are used, unless its superiority is due to a difference in function or mode

of operation or some essential change in character. (*Morley Machine Co. v. Lancaster*, C. D., 1889, 380; 47 O. G., 267; 129 U. S., 263; 9 Sup. Ct., 299; *Hoyt v. Horne*, C. D., 1892, 435; 59 O. G., 1764; 145 U. S., 302; 12 Sup. Ct., 922; *Lourie Implement Co. v. Lenhart*, 130 Fed. Rep., 122; 64 C. C. A., 456; *Diamond Match Co. v. Ruby Match Co.*, C. C.; 127 Fed. Rep., 341; *Whitely v. Fadner*, C. C.; 73 Fed. Rep., 486.)

The trial court, referring to the "yieldingly pressed means" in appellant's claim 39 connected with the saw-frame "for independent movement toward and from the carrier," reached the conclusion that the "independent movement" of the shoe distinguishes the appellant's patents from that of the appellees', and observed that without such "independent movement" there would be nothing to distinguish the appellant's cutting device from that of the prior Haigh patent, No. 673,255. To this we are unable to agree. The words "independent movement toward and from the carrier," as shown by the plans and specifications of the appellant's patents, is not a movement independent of the cutting-frame; but the expression "independent movement" is used to indicate that the movement of the "yieldingly pressed means" is not subject to control by other means than by pressure on the fish, and not that it is independent of the movement of the saw-frame to and from the carrier. The shoe in the Haigh patent, as indicated by the drawing thereof, is a shoe which, it is true, has the same purpose as have the shoes in the patents here involved; that is, to regulate the depth of the cut of the saw. But it plainly appears from the drawing that Haigh's shoe rides on the surface of the trough in which the fish travels, and not on the body of the fish. In that distinction is found the advance which Smith made in the art, and which made his combination successful.

(4) The decision of the court below was influenced, also, by the consideration that the appellees' plow, in addition to the function of regulating the movement of the saw and spreading the side flaps of the split fish, performs the additional function of removing the viscera. But this does not avoid infringement. In *Pedersen v. Dundon* (220 Fed. Rep., 309; 136 C. C. A., 143) this court said:

Neither the joinder of two elements of a patented combination into one integral part, accomplishing the purpose of both, nor the separation of one integral part into two, which together accomplish substantially what was done by the single element, will avoid a charge of infringement—citing *Bundy Mfg. Co. v. Detroit Time Register Co.*, (94 Fed. Rep., 524; 36 C. C. A., 375;) *Standard Caster & Wheel Co. v. Socket Co.* (113 Fed. Rep., 162; 51 C. C. A., 109;) *H. F. Brammer Mfg. Co. v. Witte Hardware Co.*, (159 Fed. Rep., 726; 86 C. C. A., 202.)

It is our conclusion that the appellees have infringed claims 38, 39, 40, and 41 of the appellant's patent, No. 979,103.

The decree of the court below is reversed, and the cause is remanded, with instructions to enter a decree in accordance therewith.

[U. S. Circuit Court of Appeals—Seventh Circuit.]

WOLF, SAYER & HELLER, INC., v. UNITED STATES SLICING MACH. CO.

Decided October 7, 1919.

272 O. G., 733; 261 Fed. Rep., 195.

1. PATENTS—MEAT-SLICING MACHINES—VALID AND INFRINGED.

The Van Berkel patents, Nos. 806,603 and 895,213, for meat-slicing machines with removable meat-plates, *Held* valid and infringed as to claim 2 of the earlier patent and claims 8, 9, and 10 of the later.

2. SAME—LACHES BARRING RECOVERY FOR INFRINGEMENT.

Where the owner of patents notified one who was already infringing that suit would be brought if improvement patents controlled by the owner were infringed and no suit was brought for seven years, during which the infringers continued to make and vend the infringing machines, no recovery for that period of infringement of the original patents can be allowed, the owner being barred by laches. While such acquiescence in infringement amounted to a parole license, it was revoked by the bringing of the suit, and damages were recoverable for infringement accruing after suit was brought.

3. SAME—CORPORATIONS—RATIFICATION BY CORPORATION OF ACTS OF UNINCORPORATED PREDECESSOR.

Complainant corporation, which was the owner of patents, *Held* to have ratified the acts and statements of a representative of its unincorporated predecessor with reference to suit for infringement of improvement patents, which amounted to acquiescence in infringement of original patents.

4. SAME—KNOWLEDGE OF AND CONSENT TO INFRINGEMENT—PAROLE LICENSE—REVOCABLE.

Where a representative of the owner of a patent notified an infringer that if improvement patents were infringed suit would be brought and the infringer continued to make and vend the infringing machines for a number of years, *Held* that the statement amounted to no more than a parole license to the infringer, which was revoked when infringement suit was begun. Hence, though the owner was barred by laches from recovering damages for the past infringement, he might recover damages for infringement occurring after the suit, the conduct of the owner and statement of its representative not amounting to an estoppel.

APPEAL from the District Court of the United States for the Eastern Division of the Northern District of Illinois.

Bill by the United States Slicing Machine Company against Wolf, Sayer & Heller, Incorporated. *From a decree for complainant (249 Fed. Rep., 245) defendant appeals. Modified, and, as modified, affirmed.*

Mr. Max W. Zabel for the appellant.

Mr. Frank T. Brown for the appellee.

Before BAKER, ALSCHULER, and EVANS, Circuit Judges.

EVANS, *Cir. J.*:

(1) The decree from which this appeal is taken sustains two patents involving meat-cutting machines known as the Van Berkel

patents, Nos. 806,603 and 895,213. The opinion of the district court, appearing in 249 Fed. Rep., 245, so far as it deals with questions of validity and infringement, meets with our approval. We see no reason for any further discussion of these two questions.

(2) The decree provides for a reference and—

that the plaintiff recover from the defendant * * * the profits, gains, and advantages which said defendant has derived * * * since February 3, 1911, etc.

Appellants insist that, even though validity be found and infringement appear, appellee's rights have been lost by its laches, and further urges that this court should at least deny all relief for past infringements.

While the record does not establish the facts as conclusively as we might wish, we feel justified in concluding that appellee, the successor to an unincorporated company of the same name, has since 1909 been the United States representative of the owner of the patents in suit and possessed certain exclusive rights for this territory; that its president was associated with patentee and his exclusive licensee in Great Britain prior to taking charge of the business in the United States, and was at the time of the interview, hereinafter detailed, authorized to speak for the owner of the patent and its licensee in this country; that in April or May, 1909, the president of appellee called upon the president of the appellant company, and, to quote the former's language—

threatened him with an infringement suit * * * if he copied any of our improvement patents;

that the meaning of the expression "improvement patents" is clearly shown by a reference to a machine then in appellant's possession embodying the then latest improvements in meat-cutting machines; that the machine embodying the Van Berkel patents here involved was sold prior to this date under a license from Van Berkel to the American Slicing Machine Company; that appellant was at that time also making a meat-slicing machine which infringed the Van Berkel patents here involved, and the president of appellee in the same conversation, and by way of explanation of what was meant by "our improvement patents," said:

But if he insisted on copying our machine, as he had already copied the Van Berkel machine sold by the American Slicing Machine Company, I would certainly go to the court on the patent;

that after this conversation appellant delivered to appellee the machine which it had in its possession, and which embodied "our improvement patents" above referred to, and was paid therefor by appellee; that thereafter appellant continued to make and sell in large quantities meat-slicing machines of the style and design referred to

as the American Slicing Machine Company's machine, an infringement of the two Van Berkel patents, and was so engaged up to the commencement of this suit, July 7, 1915.

From this conversation appellant was justified in concluding that appellee acquiesced in the continued making of a machine, which merely infringed the two Van Berkel patents in suit, and which was a copy of the machine made by the American Slicing Machine Company, but that legal proceedings would follow any attempt to embody the improvement patents controlled by appellant. During all the succeeding years, from 1909 to 1915, appellee knew of appellant's making and selling the other model, and frequently replaced such machines with new ones of its own make.

We have given due consideration to the argument, most forcibly urged by appellee, that the machine made by appellant and referred to in the conversation above quoted did not in fact infringe the Van Berkel patents. But a careful examination of the record convinces us that the appellant's machine made prior to 1909, and continuously thereafter, was the same machine, so far as these patents are involved, as the one of which complaint is made in this suit.

(3) We have also given attention to the contention that the representative of the unincorporated company, known as the United States Slicing Machine Company, had no authority in 1909 to represent or to bind either Van Berkel or appellee. Such a position is exactly contrary to the one taken by appellant at the time the testimony was offered. This testimony was received on the theory that the witness came to the United States with authority from the owner of the patents to organize a company to handle the meat-slicing machine business under the Van Berkel patents. While the first United States Slicing Machine Company was unincorporated, and therefore a distinct entity from the subsequently incorporated company of the same name, yet the witness stated that it was lack of familiarity with the laws of this country that prevented an earlier incorporation, and that the subsequently incorporated company, the appellee herein, operating under the same name, acquired the rights of the predecessor company. That he was speaking in 1909 for the company in which he was largely interested can not be denied, and his subsequent conduct as the chief officer of appellee, as well as his testimony and his attitude upon the trial, indicates most clearly that these statements were duly ratified by appellee.

(4) But it does not follow that, because appellee failed to assert its rights for seven or more years, it should be denied any and all relief in this suit. (*Menendez v. Holt*, C. D., 1889, 344; 46 O. G., 971; 128 U. S., 514; 9 Sup. Ct., 143; *McLean v. Fleming*, C. D., 1878, 262; 13 O. G., 913; 96 U. S., 245.) The conversation relied upon by appellant constituted at most merely a parole license to the infringer

to construct machines, which it otherwise had no right to make, and was terminable upon notice. This termination of the parole license occurred when suit was begun.

The evidence, we think, discloses such laches as to prevent appellee from collecting damages for past infringements, but fails to establish an estoppel. We conclude, therefore, that the decree should be modified, by denying appellee's right to recover damages for infringements prior to the commencement of the suit.

The decree is modified by inserting "July 7, 1915" for the words "February 3, 1911," appearing in the fourth paragraph, and as so modified, is affirmed; appellant to recover costs on this appeal.

[U. S. Circuit Court of Appeals—Second Circuit.]

ÆOLIAN CO. v. SCHUBERT PIANO CO.

Decided June 13, 1919.

273 O. G., 186; 261 Fed. Rep., 178.

1. PATENTS—MUSIC-SHEET GUIDE—VALID AND INFRINGED.

The Thomson patent, No. 841,356, for a music-sheet-guiding device for mechanical piano and organ players, *Held* to cover a patentable improvement on prior devices and entitled to a fair construction and a reasonable range of equivalents; also *Held* infringed.

2. SAME—SUIT FOR INFRINGEMENT NOT BARRED BY LACHES.

A delay of four or five years after defendant's device was placed on the market *Held* not such laches as barred a suit for infringement.

Ward, circuit judge, dissenting.

APPEAL from the District Court of the United States for the Southern District of New York.

Suit in equity by the Æolian Company against the Schubert Piano Company. Decree for defendant, and complainant appeals. Reversed.

Mr. J. Edgar Bull and *Mr. C. A. Weed* for appellant.

Mr. Louis W. Southgate, *Mr. George D. Beattys*, and *Mr. E. W. Scherr, Jr.*, for the appellee.

Before WARD, ROGERS, and MANTON, Circuit Judges.

MANTON, *Cir. J.*:

(1) In order that there may be a clear understanding of the patent in suit and its contribution to the art, it is well to consider music-sheet-guiding devices and the musical instruments, such as the organ or piano, which play automatically and upon which it is used. An automatic piano or organ is constructed by having a series of little motors incorporated therein, each of which is connected to operate one particular action or sound-producing mechanism. One of its

features is a tracker-bar. This is a smooth piece of metal having a series of little apertures in transverse line. Each aperture is connected to control one of the motors. A perforated music-sheet is drawn longitudinally over the tracker. The music-sheet consists of a long strip of paper having a series of perforations cut therein corresponding in arrangement and spacing to the notes of the music composition which is to be rendered. Which notes are to be played is determined by the lateral positions of the perforations in the music-sheets, and the length of the various perforations determines the time the particular note shall be held. The music-sheet roll consists of a spool upon which the perforated music-sheet is wound up. These music-rolls are sold and treated as compositions, and can be played interchangeably in the instrument. The end of the perforated music-sheet is connected to a winding-roll arranged below the tracker-bar, which roll is rotated by a motor. As a perforated note-sheet is drawn longitudinally forward over the smooth face of the apertured tracker, the perforations in the music-sheet will uncover, in sequence, the corresponding apertures in the tracker; thus the notes of the instrument will be played in the order of the cutting of the perforations in the music-sheet and the musical composition will be rendered. After playing the perforated music-sheets, the sheet is drawn longitudinally backward and rewound on the spool.

The music-sheet of standard arrangement is eleven and one-fourth inches wide and is so arranged as to accommodate eighty-eight apertures in line in the tracker, and therefore eighty-eight notes of the piano may be played. The construction provides metallic bridges between the apertures in the tracker-bar of about one-fiftieth of an inch. In organs of the Æolian type, such as the inventor Thomson purchased, as hereinafter stated, a music-sheet of ten and one-eighth inches wide is employed and the tracker has 116 apertures. It would be recognized at once that, if the perforated music-sheet during its longitudinal forward travel should slip sideways or deflect longitudinally a greater distance than one of the minute bridges between two adjacent apertures in the tracker, a given perforation in the music-sheet would uncover, not only its proper aperture in the tracker, but the one adjacent thereto, and thus discord would be produced. The need, therefore, to keep the music-sheet during its longitudinal travel forward in correct lateral position on the tracker required an appliance to instantly correct any deflection, so that the continued forward longitudinal travel of the music-sheet would always be in correct lateral position on the tracker. The purpose of the appellant's invention, a music-sheet-guiding device, is to cause the perforated music-sheet to travel longitudinally forward over the apertured tracker, always in exact side-

wise register and to correct any sidewise deflection thereof before discord can be produced. The guiding device is used only when the music-sheet is moving forward, or, in other words, while the piano is playing. When the music-sheet is being rewound around the spool or moving longitudinally backward, the guiding device is thrown out of operation; the backward movement is at high speed. A device to accomplish these objects must necessarily be a very delicate and nicely-operated piece of mechanism, for it works on a moving strip of perforated paper, which it must keep in correct lateral position within the dimensions of a bridge in minute measurement.

The pioneer inventor of the music-sheet-guiding device was O'Connor. He had granted to him Patent No. 789,053, on May 2, 1905, and two reissues thereof, No. 13,283, August 15, 1911, and No. 13,398, April 2, 1912. They have been the subject of litigation and were before this court in *Autopiano Co. v. Amphion Piano Co.*, (186 Fed. Rep., 159; 108 C. C. A., 291;) *Autopiano Co. v. American Co.*, (C. D., 1915, 243; 217 O. G., 1055; 222 Fed. Rep., 276; 138 C. C. A., 38,) and *Autopiano Co. v. Claviola Co.*, (284 Fed. Rep., 314; 148 C. C. A., 216.) Instruments of this character, known in the art, work pneumatically. The pneumatic operation has taken the form of, first, the pressure system, which employs air-pressure above that of the atmosphere; and the other, a suction system, which employs air-exhaust below that of the atmosphere. These systems, known equivalents, are both used as the manufacturer desires. The suction system is employed on player-pianos, and the pressure system is commonly employed on organs. The O'Connor construction, referred to, works on the suction plan. Since O'Connor was the pioneer inventor, we will refer to his construction.

It is the claim of the appellant that the Thomson patent is an improvement on the O'Connor. O'Connor adjustably secured a block to the right-hand part of the tracker, which block had an opening called a control or guiding opening, and which block was adjusted so that the control-opening would come just under the right-hand surface of the music-sheet. This control-opening connected by a tube to control a valve arranged to connect and disconnect the suction-chest through another tube, with an actuating pneumatic arranged on the right-hand end of the tracker, and connecting to the right-hand end of the shaft of the music-sheet roll. While the music-sheet is traveling longitudinally, if it should wander to the left, this right-hand control-opening is uncovered, the valve opens the suction-chest connecting to the actuating-pneumatic, which then is deflected to pull the music-sheet roll to the right, and hence adjust the traveling music-sheet to the right, to remedy its deflection to the left. So as to pro-

vide operation in the other direction, there was adjustably mounted another block on the left-hand end of the tracker, which had a control-opening, and which block was adjusted so that the control-opening would come just under the left-hand surface of the music-sheet. This connected by tube to control another valve, which was arranged to connect and disconnect the suction-chest through another tube, with another actuating-pneumatic arranged on the left-hand end of the tracker and connected to the left-hand end of the shaft of the music-sheet roll, so that if the perforated music-sheet, during its travel, should wander to the right, the left-hand control-opening would be uncovered, the left-hand valve open the suction-chest connected to the left-hand actuating-pneumatic, which would then be deflected to pull the music-sheet to the left, and hence adjust the traveling music-sheet to the left to remedy its deflection to the right.

In this way, the surface of the sheet was employed to cover and uncover control-openings. In the construction of the O'Connor device, the mechanism is duplicated, and as one mechanism is employed for adjustment to the right and another mechanism for adjustment to the left, the sheet-music expands and contracts with changes in the temperature and humidity, requiring adjustment of the blocks, and these adjustments are difficult, as they have to be relative to each other to account for the expansion and contraction, and also have to be made relative to the apertures in the tracker to keep the music-sheets normally and in proper relation thereto. Then, too, there was some variation in the width of the music-sheet during its entire length, and there was danger that the device might not work properly, as its operation depends upon the operation of the two blocks to a given width of music-sheet. In other words, the O'Connor device provided a double-surface method of control by means of the two guiding devices, one on each side. When Thomson, the inventor of the patent in suit, at one time purchased an organ for his home, and found that the O'Connor device did not track properly the music-sheet over the tracker-bar, and did not serve the purpose of his automatic-playing organ, he set about to invent a device which would. He has succeeded, and in our opinion he has invented an improvement over O'Connor, and has contributed to the art.

The claims in suit are as follows:

1. A music sheet guiding device comprising means normally operative to move the sheet laterally in one direction (the spring) and means including a part bearing against an edge of the sheet movable laterally thereby for governing said sheet-moving means (lever valve, and actuating pneumatic.)
2. A music sheet guiding device comprising pneumatically actuated means (actuating pneumatic and spring) for moving the sheet laterally, a movable part (lever) against which the sheet bears when laterally deflected from its path, and connections between said movable part and said moving means for

controlling the latter said connections including a pneumatic valve moved by said part.

3. A music sheet guiding device comprising means normally operative to move the sheet laterally in one direction (the spring), a movable part (lever) against which the sheet bears when moved by said means from its path, and connections between said movable part and said sheet-moving means (valve and actuating pneumatic) for controlling the latter.

4. A music sheet guiding device comprising means including an actuating pneumatic and suitable connections (levers, links, etc.) for moving the sheet laterally, and means including a movable part (lever) against which the sheet bears when deflected from its path and a valve connected to said movable part, and pneumatic connections (tubes and connections) between said valve and said actuating pneumatic for governing the latter.

The inventor states:

My invention relates to music sheet guiding devices such as are used in mechanical instrument players and mechanical players for musical instruments. Such players are ordinarily controlled by a perforated music sheet moving over the tracker.

The object of the present invention is to guide the sheet laterally during its longitudinal movement, so as to insure the exact registration of the perforations in the sheet with the corresponding ducts in the tracker, or, more broadly speaking, to insure such relative movement of the sheet and the tracker transversely of the path of the sheet as will secure their proper alignment. It is of course obvious that any considerable lateral deviation of the music sheet would interfere with or destroy the proper rendition of the music.

The patent describes the working of the invention of the device on the pressure system, but also points out that the invention can be employed just as well on the suction system. It is the control of the sheet, by guiding it from one side alone, that is claimed to be the improvement. The inventor claims only that he has invented a "certain new and useful improvement in music sheet guiding devices." The first element of construction consists of a compression-spring placed in the bearing, which supports the left-hand plunger for the left-hand end of the music-roll. This spring is under compression and is normally operative to move the music-sheet in one direction. Pushing on the left-hand side of the music-sheet roll, it always tends to push the music-sheet to the right so that when there is no pneumatic pressure in the instrument, the music-sheet roll and the music-sheet are pushed to the extreme position to the right. Likewise, there is a compression-spring on the left-hand axis of the winding-roll. There is an actuating-pneumatic having connections to the shaft, which carries the right-hand end of the music-sheet roll. The left-hand wall of the actuating-pneumatic is movable, and the connections of the music-sheet roll extend from the movable wall. This actuating-pneumatic has a light pull-spring tending to deflate the same, which spring thus makes the pneumatic double-acting; that is, when pressure is admitted to the pneumatic, it expands to the

left and pulls on the spring, and when the pressure is discontinued, and the pneumatic connects to the atmosphere, the spring pulls the pneumatic to the right and deflates the same. The spring thus acts in conjunction with the compression-spring at the left of the music-sheet roll, and acts to move the music-sheet to the right.

The actuating pneumatic is made of a size so that, when it is called into operation for making an adjustment, its operative force is greater than the action of the compression-spring. There is a normally-operative force in springs to push the music-sheet roll and hence the music-sheet to the right, which normally-operative force is opposed by a superior force; that is, the inflation of the actuating-pneumatic. The music-sheet moves in space, being normally impelled to the right by the action of the spring, and being pushed to the left by the actuating-pneumatic when called into operation. The device then provides a movable member bearing against the edge of the music-sheet and carrying a pneumatic valve for governing the operation of the actuating-pneumatic. This member bearing against the edge of the music-sheet comprises a pivoted lever having a shoe, against which the left-hand edge of the music-sheet rubs. This lever carries a pneumatic valve at its inner end, and a light spring is employed to pull the pneumatic toward its seat. Pneumatic connections are arranged between the valve and the actuating-pneumatic. These parts are so combined that, when the music-sheet is too far to the right, the pneumatic valve is pulled toward its seat, and the operative pneumatic pressure is connected to the actuating-pneumatic. As a result of this combination, the actuating-pneumatic operates the music-sheet to the left until the valve is open sufficiently to stop this action of the pneumatic. This provides that the music-sheet roll is always impelled to the right by the action of the normally-operative spring, and pushed to the left against the spring by the operation of the actuating-pneumatic, and this later operation is governed by the left-hand edge of the music-sheet rubbing on the moving part and operating the pneumatic valve.

By this combination the operation is governed by one edge of the traveling music-sheet rubbing on the movable part carrying the pneumatic valve. Therefore, if the music-sheet during its longitudinal forward travel should slip to the right, the left-hand edge of the music-sheet would move away from the movable part, and the pneumatic valve would be pulled toward its seat by the light spring pulling on the valve bringing the actuating-pneumatic into operation, so that it will expand to push the music-sheet to the left to its correct position, and thus cure its deflection to the right; and, on the other hand, if the music-sheet during this longitudinal forward travel should slip to the left, the left-hand edge of the music-sheet,

pushing on the movable part, will hold the valve in a wide-open position, and will cut the actuating-pneumatic out of operation, so that the spring will push the music-sheet to the right, back to its normal position. This provides the proper guiding during its longitudinal forward travel.

By this combination and operation, an improvement over O'Connor's double-surface method of control was established. It avoids the duplication of parts, and there is no lost motion in connections as the spring or springs are pushed. Since it operates entirely from one edge of the music-sheet, it is only necessary to set one pivoted lever in proper position relatively to the tracker-bar. If the music-sheet varies in width, the operation will not be materially interfered with. It operated by contact of the traveling edge of the music-sheet with a movable part. A very small lateral movement of the music-sheet will move said part, whereas the movement of the music-sheet required in O'Connor's device must be enough to cover one of the control-openings a considerable distance.

That it has been an improvement over the O'Connor device is best exemplified by the results obtained. The witnesses say it worked successfully and satisfactorily, and there were some thirty thousand sold beginning June, 1911. It should be given a fair construction and a reasonable range of equivalents. (*Dowagiac Mfg. Co. v. Minn.-Moline Plow Co.*, C. D. 1915, 320; 212 O. G., 327; 118 Fed. Rep., 136; 55 C. C. A., 86; *Nat. Hollow Brake-Beam Co. v. Interchangeable B. Co.*, C. D., 1897, 739; 81 O. G., 1423; 106 Fed. Rep., 693; 45 C. C. A., 544.)

The appellee's guiding device, constructed under the Dickinson patent, No. 1,194,725, works on the suction system, instead of on the pressure system. Thomson, however, in his patent, says this is immaterial, and points out that one familiar with the art may readily change to the suction system. In appellee's device, the first element consists of a compression-spring placed in the bearing which supports the left-hand plunger or shaft for the left-hand end of the music-sheet roll. The spring is under compression and is normally operative to move the sheet in one direction. This compression-spring, pushing on the left-hand shaft of the music-sheet roll, always tends to push the music-sheet to the right. When there is no suction in the instrument, the sheet-roll and the music-sheet are pushed to an extreme position to the right. This is the same action as the spring in the Thomson device.

In appellee's device, the next operative element is the actuating-pneumatic having connections to the shaft which carries the right-hand end of the music-sheet roll. It has three walls, the two outer walls of which are movable, and are connected by a link to move as one part, and the connections to the music-sheet roll extend from the

right-hand wall. There are two bellows or chambers in appellee's actuating-pneumatic. The bellows which operates to adjust the music-sheet roll is the left-hand bellows. The appellee's actuating-pneumatic operating by suction, when this adjustment is made, will move to the right; hence any connection from the actuating-pneumatic to the shaft of the music-sheet; a chain-motion device, a cam, is employed. The actuating-pneumatic moving to the right by suction, and having chain-motion connections to the right-hand end of the music-sheet roll, is the same mechanically as Thomson's actuating-pneumatic expanding to the left under pressure and connected by direct connections to the right-hand end of the music-roll. It makes the pneumatic double-acting, so that, when the operating-section is disconnected from the left-hand bellows of the pneumatic, the right-hand bellows moves the parts to the left to inflate the left-hand bellows; the right-hand bellows thus acts in conjunction with the compression-spring at the left of the music-sheet roll and acts to draw the music-sheet to the right. This pneumatic is of such a size, when called into operation for making an adjustment, its operative force is greater than the action of the compression-spring to the left of the music-sheet roll. When the actuating-pneumatic thus operates to make an adjustment, it pushes the music-sheet roll and stores energy in the spring. Therefore, there is normally an operative force, the spring normally operative to push the music-sheet roll to the right, which normally-operative force is opposed by superior force, the deflection of the left-hand bellows of the actuating-pneumatic, the normally-operative force and the actuating-pneumatic force opposed to each other.

When the music-sheet floats in space, being normally impelled to the right by the action of the spring, it is pushed to the left by the actuating-pneumatic when called into operation. The appellee's device then arranges a movable part bearing against the edge of the music-sheet and carrying the pneumatic valve for governing the operation of the actuating-pneumatic. The part bearing against the edge of the music-sheet and movable laterally thereby comprises a pivoted lever having a surface against which the left-hand edge of the music-sheet rubs. This lever carries the pneumatic valve at its inner end, and the light spring is arranged to pull the pneumatic valve toward its seat. Pneumatic actions are arranged between the valve and the actuating-pneumatic. The parts are combined, so that, when the music-sheet is too far to the right, the pneumatic valve is pulled toward its seat and the operative pneumatic suction is connected to the left-hand bellows of the actuating-pneumatic; thus the same result is obtained as provided for in the Thomson patent.

In appellee's apparatus, only one relay is employed in the connection between the pneumatic and other actuating parts, while the

Thomson employs two relays in the connection between his pneumatic valve and the actuating-pneumatic. A relay is a mechanism employed when desired in pneumatic connections to amplify the action, so that a small gust of air is amplified up into a larger gust. The relays are added parts increasing the efficiency of the operation. There is a slight oscillating or wavering of the music-sheet when it is traveling in correct position on the tracker. It is about one two-hundredths of an inch, as testified to; it is variously estimated as from one two-hundred-and-twenty-fifth to one two-hundred-and-fiftieth of an inch. It is so slight as to be immaterial, because it is much less than the bridge between the apertures and the tracker, which is usually one-fiftieth of an inch. Whether or not the relays are used is merely a matter of manufacture. The appellant used the Thomson device with and without them. With the use of relays, a quicker action is obtained, and the cost of the relay is about from fifty cents to one dollar.

We do not think a proper comparison between two devices involves the degree of trembling or wavering of the music-sheet when traveling correctly in normal position. The proper comparison is between the devices when each functions to adjust the traveling music-sheet to correct a sidewise deflection. To attempt to distinguish the devices as the appellee does, by calling the operation of the appellant's device that of the law of the pendulum, and that of the appellee's the law of the bleeding-port, based upon the immaterial trembling balance in Thomson's device, we do not think sound. The test is whether the appellee's apparatus employs the combinations which Thomson has invented.

(2) We think that claims 1, 2, 3, and 4 have been infringed, and that the parts specified in these claims are identical in appellee's devices, and operate the same way to produce the same result. We are of the opinion that Thomson was the first to grasp the idea that edge control could be used for music-sheets, and that such control could be made from the one edge only. His invention is not anticipated by the O'Conner patent, but is an improvement thereon, and is entitled to take its place in the art under all rules of fair construction. We are of the opinion that the appellant is not guilty of laches, and may maintain this suit as late as May, 1916, at a period of some four or five years after the appellee placed its device complained of, on the market. There is no rule of law that requires a patentee to sue infringers upon all the patents he owns at the same time, or that deprives him of equitable relief if he delays his suit for the period specified here. (*Ide v. Trorlicht*, 115 Fed. Rep., 137; 53 C. C. A., 341; *Edison, etc., Co. v. Sawyer, etc., Co.*, 53 Fed. Rep., 592; 3 C. C. A., 605.)

Judgment reversed.

WARD, *Cir. J.*, (dissenting:)

In *Autopiano Co. v. American Player Piano Co.* (C. D., 1915, 243; 217 O. G., 1055; 222 Fed. Rep., 276; 138 C. C. A., 38) we held the O'Connor patent, second reissue, 13,398, to be entitled to a most liberal range of equivalents as a pioneer. I think edge control is therefore to be regarded as equivalent to surface control. Persons who had acquired intervening rights while the first reissue was in force, of whom the defendant is one, are entitled to immunity for this reason.

In *Autopiano Co. v. Claviola Co.* (234 Fed. Rep., 314; 148 C. C. A., 216) we held the O'Connor patent good against edge-control devices operated pneumatically by O'Connor's means.

The present suit is upon Thomson, 841,356, which is a method of edge control operated, in my opinion, by the same means as O'Connor, and therefore an infringement. But Thomson is an improvement and patentable as such, so that, if the defendant uses an equivalent device to his, it infringes.

I think the district judge was right in holding that the defendant's device is different. Thomson uses a spring to shift the music-sheet roll to the right, and pneumatic bellows to shift it to the left. There is a constant struggle between these two forces; the one alternately overcoming the other and so causing a continual oscillation of the music-sheet as it travels longitudinally. The defendant's device, on the other hand, shifts the music-sheet roll in both directions by the pneumatic bellows, and there is no oscillation of the sheet while it travels longitudinally. True, there is a spring at the left end of the music-roll, but it is not intended to function in the shifting, and if it actually does so its coöperation is negligible. Such a spring is used on all piano-players, however operated, for the mere purpose of enabling the music-sheet roll to be put in and taken out of the structure.

Therefore I think the defendant does not infringe, and the decree should be affirmed.

[U. S. Circuit Court of Appeals—Third Circuit.]

CONSOLIDATED WINDOW GLASS CO. v. WINDOW GLASS MACH. CO. *et al.*

Decided October 13, 1919.

273 O. G., 807; 261 Fed. Rep., 362.

1. PATENTS—ANTICIPATION—PRIOR UNSUCCESSFUL DEVICE NOT AN ANTICIPATION.

Patents for a machine and process for drawing glass for windows mechanically are not anticipated by patents for earlier and abortive devices and methods where the patents in suit were the first that were successful, and such patents must be given a broad and liberal construction, the inventors being pioneers in the art.

2. SAME—DRAWING WINDOW-GLASS—PATENTS VALID AND INFRINGED.

The Lubbers patent, No. 702,013, claims 1, 2, 3, 5, 8, 9, 10, 12, 13, 15, 16, 17, and 18, as well as Patent No. 702,014, claims 2, 3, 4, 5, 8, 9, 11, and 13, the first of which was for an apparatus for mechanically drawing window-glass and the latter being a method patent, *Held* valid and infringed.

3. SAME—MECHANICAL DRAWING OF GLASS—PATENT VALID AND INFRINGED.

The Lubbers divisional patent, No. 702,015, which showed the use, in connection with his shield in the forehearth, of floating rings, all of which apparatus was used for the mechanical drawing of glass, *Held* valid and infringed.

4. SAME—DRAWING GLASS—PATENT VALID AND INFRINGED.

The Lubbers patent, No. 886,618, for an air-vent hole in the apparatus for mechanically drawing glass, claims 20, 21, 23, 24, and 26 *Held* valid and infringed.

5. SAME—IMPROVEMENT OF APPARATUS FOR DRAWING GLASS—PATENT VALID AND INFRINGED.

The Lubbers patent, No. 886,618, for an air-vent hole in the apparatus for mechanically drawing glass, the application for which was filed May 21, 1908, and which was granted May 5, 1908, after the patentee, at the suggestion of the Patent Office, later made a divisional application of that patent, applying for Patent No. 1,020,920, and filing nearly three years late additional claims for his original patent, *Held* valid, it appearing that the whole art was in a state of flux and experiment and it being impossible to say with definiteness that Lubbers had satisfactorily worked out the open-vent solution more than two years in advance of his application.

6. SAME—IMPROVEMENT OF METHOD OF DRAWING GLASS—PATENT VALID AND INFRINGED.

The Chambers patent, No. 782,880, for a method for gradually increasing the speed of the drawing operation for the mechanical drawing of glass, *Held* valid and infringed.

7. SAME—REGULATING SPEED OF DRAWING GLASS—PATENT VALID AND INFRINGED.

The Lubbers patent, No. 822,678, for a method of regulating the speed for the mechanical drawing of glass, *Held* valid and infringed.

8. SAME—REGULATING DRAWING OF GLASS—PATENT VALID AND INFRINGED.

The Lubbers patent, No. 914,586, for an appliance to regulate the mechanical drawing of glass, so that the surface tension on the bath would be equalized, *Held* valid and infringed.

9. SAME—CAPPING GLASS CYLINDERS—PATENT VALID AND INFRINGED.

The Hitner patent, No. 821,361, for a device for capping off glass cylinders, *Held* valid despite the contention that it had been placed on sale more than two years before application, and also *Held* infringed.

10. SAME—HOISTING DEVICE—PATENT VALID AND INFRINGED.

The Hitner patent, No. 822,452, for a hoisting device to move large cylinders of glass mechanically drawn, *Held* valid and infringed.

11. SAME—HOLDING GLASS CYLINDERS—PATENT VALID AS TO CERTAIN CLAIMS.

The Bridge patent, No. 1,006,995, for an apparatus for holding the large mechanically-drawn glass cylinders, which was fit for use when the cylinders were divided into segments, *Held* valid as to claims 1, 2, and 4.

12. SAME—EVIDENCE OF INVENTION—SIMPLICITY OF DEVICE.

The Lubbers patent, No. 886,618, for an air-vent hole in an apparatus for mechanically drawing glass, claims 20, 21, 23, 24, and 26 *Held* to involve an invention of a high order. "The simplicity of the use of an open vent, which simplicity is cited as evidence of lack of invention, to our mind shows the high order of novelty and invention, in thus making use of a simple opening, instead of complicated mechanical appliances, in order to accomplish a really remarkable result."

13. SAME—ANTICIPATION—METHOD OF BLOWING GLASS BY MECHANICAL MEANS NOT ANTICIPATED BY HAND-BLOWING METHODS. .

Claim 5 of the Lubbers patent, No. 702,014, for a method of forming hollow glass articles, *Held* to be physically and functionally different from the hand-blowing method of the prior art, in which the hand-blower took advantage of a swinging motion imparted to the article and of gravity, while according to the method of the claim an increased air-supply was relied upon.

APPEALS and cross-appeals from the District Court of the United States for the Western District of Pennsylvania; W. H. Seward Thomson, judge.

Suits by the Window Glass Machine Company and another against the Consolidated Window Glass Company, against the Pennsylvania Window Glass Company, and against the Kane Glass Company, which were consolidated. *From a decree for complainants, but which denied some of the relief sought, the several defendants appeal, and complainants assign cross-errors. Modified and affirmed.*

Mr. Marshall A. Christy, Mr. Robert D. Totten, and Mr. Charles Neave (Mr. James I. Kay and Mr. A. W. Bright of counsel) for the appellants.

Mr. Clarence P. Byrnes and Mr. George H. Parmelee (Mr. Livingston Gifford of counsel) for the appellees.

Before BUFFINGTON, WOOLLEY, and HAIGHT, Circuit Judges.

BUFFINGTON, *Cir. J.*:

This case concerns window-glass, a product which enters into practically every home and structure in the country. It covers a great pioneer step in this universal art, when to its customary and time-used method of blowing such window-glass by human skill, "man-blown glass," there was added the mechanical exactness and increased production of "machine-drawn glass." That step gave to a machine and a mechanical process the equivalent of the fine skill of the most skillful of artisans, and of artisans who dealt with the most difficult to handle of products, viz., molten glass, which was changing its nature every second it was handled. This step freed the window-glass art and its universally-used product from the absolute domination and monopoly of a small body of skilled artisans, whose organization absolutely controlled its operation and the amount and price

of its output. This change enabled some seventy ordinary mechanical employees, with the help of machinery, to produce the product theretofore made by substantially six hundred blowers, whose exacting work was often done at the expense of their health, for the glass-blower's work, with its abnormal lung expansion, often caused physical decline. This change also brought about a decreased price of a universally-used product. The machine-drawn output is now two-thirds of the window-glass product of the United States, and this machine-drawn process and apparatus have been such that within a few years after they began in the latter country they have been adopted and used in England, France, Germany, Austria, Italy, Russia, Spain, Portugal, Japan, and also in Canada.

The width of the change from the hand-blown process of the new is best illustrated by a brief description of both. To make a square sheet, from which panes of window-glass can be cut, it is necessary to have a cylinder or roller whose sides are of uniform thickness and whose length is about four or five feet. Such a cylinder, or sectional cylinder, must be then split or parted on a straight line through its entire length, and then placed, with such split uppermost, in a heated furnace. As the glass softens, the sides of the cylinder recede from this longitudinal split, and we have the rectangular sheet of glass desired, from which, after certain flattening, annealing, and cleaning processes have been applied to it, panes of window-glass of appropriate size may be cut. The formation of such cylinders, or sectional cylinders, is the aim of both the hand-blowing and machine-drawing methods; but the blower could only make one cylinder at a time, and this of a length limited to say four or five feet, and a diameter of say ten inches, while by the machine-drawn method a cylinder of say thirty-eight feet in length and thirty-eight inches in diameter, and capable of being cut into five or nine subsections or rollers, could be produced. In doing this, the blower used a tool called a blowpipe, which consisted of a hollow stem through which he blew, and a bell-shaped enlargement at its end, on which he manipulated the molten glass. Taking this blowpipe, a workman, called a "gatherer," first inserted the bell-shaped, heated end of the blowpipe into a pot or tank of molten glass, and rotated it so as to gather a small mass of such molten glass on such end. The pipe was then taken to the cooling-tub, where the pipe shaft or stem was cooled, and the glass shaped or cooled on the surface. This operation was repeated three times, which gave to the mass successive layers of glass like the skin of an onion. The glass lump, which still remained plastic, was then shaped by turning it in a suitably-cooled wooden or metal block having a shaped cavity. The blower then took the tool with the glass mass on its end, and blew in some air by his lungs, while

still turning the mass on the blower-block. This gave it a rough pear shape. The glass was then reheated in the "blow-furnace," and the blower then swung the depending plastic mass in a trench, and while turning or twirling the pipe blew into it at intervals. By this operation, the size of the glass structure was determined by the air blown in, the glass being meanwhile elongated by gravity and the centrifugal effect of swinging, and at the same time the whole mass was kept symmetrical in form by twirling. During such manipulation the glass became too cold to work, and it was again reheated in the blow-furnace, and again elongated by the intermittent steps of swinging, twirling, and blowing, until a cylinder of equal diameter and thickness through its entire length was formed. When this was done, the end of the cylinder or "roller" thus formed was heated in the blow-furnace, and the closed end blown open. The roller was then laid horizontally on a horse or rack, and the blowpipe was broken or cracked off the one end, and the other or rounded end of the cylinder was then "capped off," or severed by wrapping around it a thread of hot glass and touching it with a cold iron; the expansion by reason of the hot thread and the contraction by reason of the cold iron, resulting in a straight cut of the cylinder on a line at right angles with the horizontal length of the cylinder itself. These rollers or small cylinders, so produced by glass-blowers, were, as we have said, from five to six feet in length, and eight or ten inches in diameter, and weighed about twenty pounds, though their weight in glass of double strength might run over fifty pounds. The rapid and skillful handling of this swiftly-changing, molten mass, the difficulties and skill of manipulation, and the requirement that the finished product should be of even thickness throughout, manifestly necessitated work of the highest skill, coupled with great strength and endurance. This skill was of such a character that three years of apprenticeship was often required to learn it, even by a man who was familiar with the work incident to such blowing, and the workmen were so restricted in numbers and of such individual skill that they formed a labor organization which absolutely dominated that industry.¹

¹ Q. What was the condition as to the labor organizations to which these blowers and gatherers belonged?

A. At that time, there were, if I recall correctly, two labor organizations, both of them trying to outdo each other in arbitrariness. They formulated rules for the operation of your factory, which you were obliged to live up to. You were restricted in the amount of glass that your men should blow in the eight-hour turn. They were required to lay off a certain portion of each eight-hour turn. The number of cylinders they were allowed to make was limited, and the number of boxes of glass for the week's work was limited, and an excess production over the limit was punished by severe penalties inflicted on the workmen. But the shortage of men made the workmen very arbitrary. They wanted their glass cut in sizes which made them the most money, irrespective of whether these sizes were the sizes which the trade required. The larger the size the glass was cut into, the

A visit, at the time of the argument of this case, of the members of this court to a glass factory near Pittsburgh, showed them the machine-drawing method of making window-glass. The extent of the operations of this factory, and the call for molten glass, were such as to necessitate the use of a tank to keep up the supply of glass required. This tank, of course, had nothing to do with the patents here involved; but, as a part of a practically continuous process from the raw material to the flattened sheets of window-glass, we note that such a vital element as the tank and the process therein employed, for keeping up the continuous supply of glass, will be found described in the case of *Siemens v. Chambers*, (C. D., 1893, 214; 62 O. G., 1351; C. C.; 51 Fed. Rep., 902,) a case decided in this circuit, and in that connection it is in evidence in this case that one of the beneficent effects of the installation and successful use of the machine-drawn process was to permit the use of the tank, and the savings and product increase due to that economical agent of efficiency and to the use of which the glass-blowers had always objected. In this tank a huge bowl at the end of a long handle, which was suspended by a chain from an overhead runway was dipped into the tank-mouth and filled with molten glass. The dipper was then swung around and the glass carried to a glass-pot, from which the molten glass was to be machine-drawn. It will here be noted that the use of this pot, situate at some distance from the tank, was the method used in this particular factory, while the alleged infringing method used, and with which we are here concerned, consisted in working the molten glass, not in a pot, but in a structure situated alongside of and drawing its glass directly from the tank.

But, to return to the factory visited, it will be noted that the machinery by which this draw is there effected was centered in a platform about forty feet above the molten glass. This platform contained the different mechanisms required, and had suspended from it the mechanical semblance of a glass-blower's tool. This tool was a hollow pipe about five or six feet in length, at the bottom of which was a circular piece of steel, the whole tool somewhat resembling a mushroom-stem, with the top or umbrella inverted. From a cage in front of the mechanism, where the single operator, who controls the

greater were the earnings of the blower and gatherer and flattener. In addition, a man could make more money, and make it easier, blowing double strength than single strength, and, while the normal requirements of the country were always considered to be about one-fourth double and three-fourths single, lots of factories, our own included, were producing between 40 and 50 per cent. double, instead of 25, because we could get double strength blowers when we couldn't get men who would blow the single. The business from a manufacturing standpoint was chaotic.

Q. 15. How difficult was it to obtain membership in these unions?

A. Both the unions enforced the rule that no one could learn the trade, could learn any of the trades, what is termed the four trades, the blowing trade, the gathering trade, the flattening trade, and the cutting trade, unless he was a father, son, or brother of a member of the union.

operation, watched and operated, the drawing-tool or bait, as it is technically termed, was caused to slowly descend. As the cage or mechanism was lowered along guideways which reached nearly to the pot, the inside of the steel bait dipped into the molten glass, which entered and filled the interior of the bait. As the bait had an interior edge or knuckle at its lower part, a circular rim of glass was at once formed by the molten glass coming in contact with the cooling steel. This solid rim thus formed was the start and support for the drawing operation which followed. As the bait slowly emerged from the pot of molten glass, a cylinder began to form, in a shape resembling a great demijohn; that is, first the neck, then the gradually-expanding shoulders, then the main or cylinder body proper, which slowly increased until a diameter of about thirty-eight inches was reached. As the "bait" continued rising, a molten-glass cylinder was slowly drawn upward from the pot, and this cylinder, now thirty-eight inches in diameter, slowly and majestically was drawn upward and upward until it reached a height of about thirty-eight feet. The slow emergence of these cylindrical walls of even thickness from a bath of molten fluid, mounting to such a height, self-supporting and changing gradually from fluid to plastic, then to solid, glass, impressed one as a real, veritable miracle, as the great cylinder stood erect, of predetermined thickness, and of clear transparency. It stopped substantially forty feet above the ground, supported by its own sides, and those sides resting on a fluid bed of molten glass at its foot. We stop at this point to place in a note in the footnote² an extract from the testimony of Dr. Bishop, pro-

² Q. When you began this investigation, what impressed you at first as the main physical factors involved, or what particularly impressed you mainly in the operation?

A. Well, the whole process, from the time they commenced to feed the glass into the enormous tank of molten glass until the time the process was complete. But to a physicist, who has been obliged to handle glass, and knows its brittle character and the strains that are produced in it, this drawing of a glass cylinder from a bath of molten glass strikes one as being really a marvelous performance. I recall very distinctly the first time I visited this plant and observed the bait lowered into the glass, and marveled at the ease with which the glass was fastened to it; and as the bait was drawn upward the tendency was to watch the bait and the attached glass cylinder and *see how soon it would fall down*. After I became accustomed to that, I then watched to see what was going on in the bath of molten glass. It naturally separated itself in this way: We have the molten liquid glass, then a zone that we might call the meniscus zone; then above this the plastic zone, where the glass is flexible and moves with the greatest ease, something like a leaf in the wind; above this plastic zone comes the setting zone; and then passes into window glass in the upper part of the cylinder. Now, I was impressed with the fact that the mechanical appliances must be quite remarkable, and there must be a very close correlation and coordination, not only between the various physical factors which enter into this, but between the eye and the hand of the operator and the machines which correlated these various factors.

Q. You have referred to the physical factors involved in this process. I will ask you to state, from your study of these methods, what you consider to be the main physical factors involved.

A. After a prolonged study of this subject, I decided that the main essential factors are: (1) The bath of molten glass. (2) Heating to maintain the glass in a liquid state at a proper drawing temperature. (3) Shielding the heat from the drawing point. (4) Chilling of the glass in the bath. (5) Surface tension. (6) Viscosity. (7) Flexibility of

fessor of physics and dean of the School of Engineering of the University of Pittsburgh, who has admirably stated, not only the outward and visible features of the drawn-glass process, but the great range of occult and invisible functional elements which tend to make or mar such a process.

What shall be done with this immense cylinder? A cold bar of steel is run around the lower end of the cylinder, and it is at once cut off from the plastic glass, which falls back into the pot. We here note that the glass which falls back into the pot, and which is called the "aftermath," does not concern us in the present case; but the character of that aftermath and the conditions necessary for its treatment were matters which had to be reckoned with in effecting the industrial and economical success of the drawing process under consideration. A large hoop, padded with asbestos, is then run around the severed end of the cylinder. To this is attached an overhead line. The lower end of the cylinder is drawn out from the pot into mid-air, and as it is drawn out the cage, with the bait, is lowered until the great cylinder reaches a horizontal position. Then the bait is detached, and, although its weight is well upon to one hundred pounds, it is held suspended by the cylinder itself. The cylinder is then dropped into a long horse or supporting-rack, which consists of upright stems having semicircular hoops at their upper end, which

the glass in the plastic zone. (8) Homogeneity of the glass; and under this two sub-heads: (a) uniform mass density; (b) uniform thermal density. (9) Symmetrical segregation of the glass at the drawing point. (10) Speed of draw, and its relation to the temperature conditions in the receptacle. (11) Relative air pressure within and without the cylinder and controlled by vent. (12) Strains: (a) produced in the glass while drawing; (b) taking down strains. (13) Cool glass remaining in the receptacle at the end of the draw; that is, the aftermath.

Q. Have you arranged any classification of these factors you have enumerated?

A. Of course, these factors entered, with perhaps one or two exceptions, simultaneously in a drawing operation. But it is possible, I think, to perhaps systematize these somewhat roughly under four heads: (a) factors affecting the glass in the receptacle; (b) factors affecting the glass during the drawing; (c) factors affecting the glass during the taking down; (d) factors preliminary to the next draw. Now, if you go back to these same 13 factors which I have enumerated, you can perhaps classify them somewhat under this arrangement: Under (a) "factors affecting the glass in the receptacle," we have: (1) the bath of liquid glass; (2) heating to maintain the glass in the bath in a liquid state; (3) shielding the heat from the drawing point; (4) chilling of the glass in the bath; (5) homogeneity of the glass in regard to its mass density and thermal density; (6) symmetrical segregation of the glass at the drawing point. The factors which have to do with the cylinder that is being drawn—that is, the ones that come under (b)—are: (5) surface tension; (6) viscosity; (7) elasticity; (10) speed of draw; (11) relative air pressure and vent control. The factors which enter during the taking down, under class (c) are: (12) strains which exist in the glass due to the method of the formation of the cylinder, and those which are introduced by the method employed to take the cylinder down and lay it in a horizontal position. Those factors which are preliminary to the next draw—that is, class (d)—are those which result from the necessity of removing the cool glass remaining in the receptacle at the end of the draw. This involves either a new factor in heating, if the aftermath is to be melted back and refined in place, or if the device which produced the symmetrical segregation of the glass at the drawing point is to be removed, and a new one put in its place. *I want to be very clear that, in attempting to classify these, that does not mean that one class occurs, and then another class occurs, and so on, but practically all of these occur all the time during the operation.*

are so spaced as to support the cylinder when lowered onto them. At this point a workman takes a capping-tool, and, beginning with the upper end of the cylinder, next the bait, caps or cuts the cylinder along the desired lines. These large cylinder-sections are then moved away to separate horses or racks, and, after being longitudinally cut are subjected to the treatment of flattening, ironing, annealing, and cleaning, which were followed in the course of the small single cylinders of the glass-blower's art. To those interested in the subject the number of the *National Geographic Magazine* of May, 1919, contains illustrations and descriptions of this process.

(1) The proofs in this case show:

First, that while the suggestion of machine-drawn glass had been made and was recognized in the literature of the art as early as the fifties, no practical method of machine-drawing window-glass had been evolved in the fifty years following, and the highest achievement of the art and the only method of making window-glass was the hand-blown process first described. Interesting, therefore, as these prior suggestions were, suggestive as they may have been, in practice they got nowhere. It therefore follows that the men who in 1894 began a systematic and costly campaign to draw glass by machinery were absolutely pioneers in that field, so far as accomplishment was concerned. It follows, also, that these prior patents, none of which solved the problem of machine-drawn window-glass, should have no effect in anticipating, qualifying, or defeating the claims for patent protection of those whose subsequent effort actually produced machine-drawn window-glass. Nor should these earlier, but certain, attempts which resulted in absolutely nothing, shield and protect from infringement and accounting those who copied not the abortive failures, but the successful steps of the originators of machine-drawn glass.

Second, while, of course, many of the general principles on which the hand glass-blower formed the cylinder, must in the nature of things be the same as those by which the machine formed the same cylinder out of the same material, yet it will be seen that the hand-blown art and the machine art are essentially different. In that respect, the trial judge below well said:

While there are certain analogies between the hand-blowing and machine operation of drawing glass cylinders, the former having taught certain principles, as the regulation of the size of the cylinder by internal air pressure, and control of the thickness of the glass by elongation, yet there are many fundamental and vital differences between the two systems.

Third, the machine-drawn window-glass is produced by one continuous, progressive operation. There is no reheating. The diameter and length of the cylinder are so different that it is evident that the

magnitude of the article handled, the continuous operation in handling, and the size of the product produced, in themselves are factors indicating that the problems involved in this continuous process, their interrelation to each other, the elements of air distention, the glass heat, and its rapid changes, unite with many other factors to make the whole process so correlated and interwoven that each element or invention which contributes to the successful end cannot be considered as an isolated inventive act, but must be viewed from the standpoint of all the parts of an interrelated, correlated, combination whole. In that respect, the trial judge well said:

It is, perhaps, true that few, if any, of the arts presented so many perplexing problems as the drawing of glass cylinders by machinery from a molten bath. These problems appeared at the very beginning of the operation, and rose up persistently all along the way. The inventor had to deal with elemental actions, forces, and properties of matter; with things in the nature of heat, cold, the properties of solids, liquids, and gases; heat applied to the glass, and cold applied to the molten liquid; the properties and physical constitution of the glass as it passed from the solid to the liquid condition, through the plastic condition up to the solid state again; the application of air under conditions of pressure, and under conditions of pressure varied by heat. He must consider the uniformity or nonuniformity of the temperature of the glass in the furnace at different places and at different times; the conditions under which the intense heat from the furnace must be guarded from the drawing point, and the systematic segregation of the glass at that point. If the draw is from a pot, the relation between the diameter of the pot and the diameter of the cylinder being drawn; the rate of cooling of the glass in the receptacle from which the draw is being made; the speed of the draw, having relation to the temperature conditions in the drawing receptacle, as well as in the cylinder being drawn; the action of the air on the cylinder, both within and without; the temperature of the air when admitted to the cylinder, and the heating effect on the air after it has been admitted; the regulation of the air pressure in the cylinder to procure uniformity of diameter and to eliminate the "breathing" of the cylinder, with the resultant corrugations in the glass; the symmetrical heating during the draw to prevent the lateral movement of the cylinder, and the melting back of the aftermath or residuum between the draws; the surface tension of the glass, and the strains produced in the cylinder while forming, and while being taken down. These problems were not only numerous and complex, but many of the difficulties were latent and were only located after repeated experiments and failures. When the difficulty had been definitely determined and located, the remedy had to be found.

The patient hearing and consideration of this case by Judge Thomson, and his able opinion in its many phases, lead us to feel that the foregoing extract from his opinion points out the proper attitude of a court toward the patents which have bridged the great chasm between the hand-blown and machine-drawn window-glass, and to this admirable statement of Judge Thomson's we add that of Judge Pollock, who had these same patents before him, where he said:

Considering then: (1) all the patents involved in this suit as unified in purpose to carry forward the process devised, or as mechanical aids essential

to the conduct of such process, therefore merely incidental thereto; (2) that by the process involved there was accomplished for the first time the new and useful result of mechanically drawing glass cylinders from a molten receptacle of glass of such size, thickness, diameter of cylinder, and degree of perfection as to successfully compete with hand-blown cylinders in trade and commerce; (3) because of the far-reaching importance of this old result accomplished in a new and hitherto unknown way, making it of the largest economic consequence, value, and importance in the trade and in labor saving—the patents covering the process must and should, I believe, be regarded of the highest importance and be accorded the largest degree of credit given by the law to patents; and (4) indulging in favor of the validity of the patents themselves these presumptions which arise in law from the admitted facts of this case, such as (a) the legal presumption as to the validity of the patents, (b) the creation of a new mechanical industry, (c) arrived at after years of ceaseless experimentation and investigation under great difficulties and at large expense, (d) in dealing with a product of nature of such delicate and fragile texture as glass, (e) wherein the operation carried through the process was the first to employ, regulate, and successfully control natural forces and devote them to a useful end, (f) at a time when such forces were little understood and progress was impeded at every step by latent difficulties, hard to discover and harder to overcome, all of which presumptions must be indulged in this case under the rules established in the adjudicated cases.

When we consider that this machine-drawn-window-glass process and apparatus were the outcome of years of courageous and original experimentation, and that in those experiments several million dollars were sunk, we can see that we are dealing not only with a great contribution to a great art, but with the creation of a new art, and that the steps involved are of a radical, basic, and pioneer character.

Turning, then, to the machine-drawn-window-glass process and the mechanism which we have described above and seeking to find the basic principles and locate the dominant factors involved therein, we may say that the general problem attempted was to mechanically and continuously draw from a body of molten glass a self-supporting cylinder of substantially uniform diameter and substantially uniform wall thickness, in size so much larger than the glass cylinder of the hand-blown art as to increase output and decrease cost. In approaching this problem of an art which existed only in contemplation, it is clear the inventors departed abruptly from the art of hand-blown window-glass by ignoring certain principles and dispensing with certain agencies there regarded as fundamental and indispensable.

In the art of hand-blown window-glass, the size and shape of the glass cylinder or "roller"—the primary structure—were attained chiefly by resort to certain laws of nature. The cylinder, on being swung in the trench, was elongated by gravity; it was distended by air-pressure from the blower; its symmetrical form was made and maintained by the centrifugal effect of turning and twirling. Rather instinctively the blower supplied the requisite quantity of air to

effect distention; thereafter his skill merely supplemented the natural operations of centrifugal force and the law of gravitation. To the control and use of these natural forces, the hand-blower applied his skill; without them, he could not exercise his skill, and he could not make glass. Gravity and centrifugal force were therefore the basic elements or agencies on which the art of hand-blown window-glass was built.

In searching first for the problems of machine-drawn window-glass, and then for the solution of those problems, the inventors in this case wholly discarded centrifugal force as a factor in maintaining symmetry in the cylinder. They obtained the requisite symmetry by mechanically causing the motions of the cylinder to be vertical and steady, instead of oscillatory and revolving. They also discarded the law of gravitation as a means for lengthening the cylinder. They not only discarded this natural law, but they proceeded in direct opposition to it by employing means to cause the cylinder, in its elongation, to arise from a molten-glass base, instead of to descend from such a base. In a word, they substituted mechanical means for natural forces; and for the human element, by which air in varying volume was—instinctively, intuitively, or intelligently—supplied to the growing cylinder, the inventors also substituted mechanism. In thus dispensing with human intelligence or intuitions, and in proceeding, not only without the aid of natural forces previously relied on, but actually in opposition to them, the conceptions of the inventors were more than novel; they were audacious, and, being practical, they involve invention of the highest order.

In working out the conception of drawing window-glass mechanically, without the aid of elements of the old art, the inventors found that the controlling agencies were: (1) temperature of glass and air; (2) distending air; (3) speed of draw. Considering, therefore, these three basic factors and their subdivisions, let us turn to an examination of the inventive steps of those who contributed to final success—for manifestly, such a result could only be born of investigation—and see, first, whether such inventive efforts are embodied in the patents here in issue; second, what protection has been given that invention in the way of claims; third, are the features thus invented, and protected by claims, found in defendants' process and mechanism.

The real pioneers in this great advance were Lubbers, who was a glass-flattener and inventor, and James A. Chambers, who was an experienced glass-man and whose means were placed at Lubbers's disposal. Lubbers began his experimental work in 1894 or 1895, and interested Chambers therein. The hidden difficulties of the problem which confronted these daring men are well illustrated by

the fact that Lubbers believed at that time he could put machine-drawn window-glass on the market in three months, and Chambers was willing to invest large sums of money on the faith of that belief. Indeed, the difficulties that were from time to time encountered by these two men were almost superhuman, and it was not until 1901, and after a million dollars had been sunk in experimenting, that they were able to draw cylinders eight or ten inches in diameter and only five or six feet in length; in other words, to do just what the glass-blower could do. And while the results were such as to encourage them to go farther, the stupendous difficulties confronting them are apparent, when it is considered that, with all this outlay of effort, inventive skill, and money, they were not able even then to produce machine-drawn window-glass on a successful commercial scale. Addressing our attention to that period of development, let us consider in serial order the inventions made and the patents granted during that time in the three basic fields above stated, viz: (a) temperature of glass and air; (b) distending air; and (c) speed of draw.

Turning first to the basic question of temperatures, Lubbers was confronted with radically new conditions and problems bearing on heat, both of the molten glass in the pot before it was drawn and in the cylinder as it was being drawn. We say "radically different" because, while the hand-blower had to meet varying heat conditions when he took his molten glass from the tank or the pot, the problem of the glass remaining in the tank or the pot no longer concerned him, and while, of course, he had to meet changing heat conditions of the mass he was handling as he progressively developed his cylinder, yet it will be observed the blower was able to apply heat anew three different times to the glass mass he was working, as the process advanced. In the case of machine-drawn glass, on the contrary, the maintenance and control of the necessary heat conditions was an absolute essential, not only in the glass being drawn, but in the pot, also, because the process was a continuous one, and the pot was continuously being drawn from. Hence the maintenance and control of heat in the pot was vitally essential to the success of a continuous process. In the same way, the maintenance and control of heat essential to drawing a cylinder were equally essential and became more difficult because the glass in the cylinder could not be subjected to reheating as the process went on. Lubbers, therefore, began with the tank, which was the necessary base of a continuous process, and devised something that was wholly new in the tank art, namely, a forehearth or sidewise extension, whereby the glass was withdrawn from the main body of the tank and segregated in a place where it could be conveniently handled in a continuous process. But, while the forehearth afforded a convenient means of reaching the glass, Lubbers found that the glass being removed from the intense regen-

erative gas heat of the tank became colder at the outside wall of the forehearth and hottest in the part near the tank itself. To meet such objectionable heat variations, three different agencies or processes were at various times devised, to wit, a turntable pot, a pot-and-kiln method, and the forehearth method already referred to; but, as the question of infringement here involved concerns the latter, the forehearth method alone, we restrict ourselves to showing Lubbers's contribution to that problem.

(2) In taking up this heat problem, as well as the other problems concerned in the case, it is to be noted that the inventions made involve, as stated by Judge Thomson in the extract quoted above, the unusual feature of first locating or discovering the difficulty to be overcome and its relation to the whole problem, before any inventive steps were taken to solve it. In other words, these patents involve, so to speak, two series of inventions: first, discovering the difficulty; and, second, discovering means to overcome that difficulty, for the proofs show that, while the mischief or difficulty was time and again seen in the broken or imperfect cylinders made, the completion of the process, the many factors affecting it, and the difficulties incident to studying molten glass, all united to so obscure and confuse that it was impossible to locate the real cause of an objectionable result. To this temperature problem Lubbers's Patent No. 702,013, for an apparatus for drawing glass, applied for September 28, 1900, granted June 10, 1902, was addressed. Without entering into a detailed discussion of it and its companion method patent, No. 702,014, we may say that Lubbers therein disclosed drawing the glass from the forehearth of a tank-furnace, and that the use of the forehearth necessarily required that some provision for the regulation of tank heat be made. To that end, Lubbers provided a heat-shield and a water-cooled ring, for the purpose of securing symmetrical heating, symmetrical cooling, and symmetrical proper temperature generally, at the point where the cylinder was being drawn. The process and apparatus were wholly novel in use in the problem of machine-drawing window-glass. The judge below found the claims here involved, to wit, claims 1, 2, 3, 6, 8, 9, 10, 12, 13, 15, 16, 17, and 18, valid. This apparatus patent was a companion to method Patent No. 702,014. The judge below found claims 2, 3, 4, 8, 9, 11, and 13 valid, a conclusion in which we concur. He found claim 5, which is for—

the method of forming hollow glass articles, consisting in drawing a hollow article from a bath of molten glass, supplying air to the interior of the article, and increasing the rate of air supply as the article increases in length, substantially as described—

invalid, in that regard saying:

It is undoubtedly true that the elongating cylinder gradually cools, causing shrinkage in volume of the compressed air, and that there is a gradual decrease

in the amount of heat imparted to the air as the cylinder lengthens, thereby lessening the expansion. It is also true that to meet these conditions there must be an increase in the air supply as the cylinder lengthens. Plaintiffs claim that this conception, covered by claim 5 of this method patent, is new in the art. I cannot concur in this view, even if this broad claim is read independently of the specifications defining the invention, wherein the inventor declared that to keep the cylinder of substantially uniform size it was necessary to automatically control the air supply, so as to regulate it according to the length of the cylinder being drawn, and that the supply of air should be slowly and gradually increased during the drawing operation. That the diameter of the forming glass cylinder must be maintained by air pressure is an old and well recognized basic proposition in the art of glass making. The glass-blower by hand was perfectly familiar with the principle. He knew that to enlarge the cylinder the air pressure must be increased, and to lessen it the pressure must be diminished. But he also knew, and put into constant practice, the principle that to maintain the cylinder of uniform diameter the air pressure must increase as the cylinder lengthens. Had he not known and practised this principle constantly, the fine art of hand-blowing window glass cylinders could not have developed. Without such knowledge no merchantable cylinder could have been blown at all. It was basic and fundamental in the art. That the hand blower might not have been able to assign the scientific reasons therefor is not important. He knew the principle and applied it. Those who attempted to do by machinery what the hand blower had done successfully for generations presumptively knew the fundamental principles upon which that art had been built.

In this conclusion we feel the court below was mistaken. The claim is limited to the process of drawing from a bath of molten glass, and the method claimed was in substance for supplying air to the interior of a machine-drawn cylinder and increasing the air-supply as such drawn cylinder increased in length. The judge below found that the same thing was done in the manual drawing of the glass-blowing art. Possibly this is true. The blower may have instinctively supplied air as he found the need of air, but the proofs do not show that the blower so increased the air with the increase in the length of the cylinder. But in the hand-blowing of cylinders there was the additional potent factor of a swing, as well as the blowing, to maintain the diameter of the cylinder as it increased in length. No such swing, and therefore no such means, of cylinder-lengthening by gravity exists in the machine-drawn process. It is evident, therefore, that Lubbers's method of meeting the difficulty was physically and functionally different from the hand-blower's method. It therefore seems to us that claim 5 should be held valid.

(3) In connection with the process patent, No. 702,014, Lubbers was granted a divisional patent, No. 702,015, which showed the use, in connection with his shield in the forehearth, of floating rings; the ring and shield having a sealing-joint whereby the surface of the glass within the ring is practically shut off or segregated from

the surrounding heat. This apparatus was protected by six claims, all of which were found novel and inventive in character by the judge below, a conclusion in which we concur. We are not unmindful that the use of floating rings in tank-furnaces was old, but in the tank-furnace they floated generally over the whole glass-surface, and their principal function was not to segregate or protect from heat, but to keep the glass within them free from objectionable substances. But Lubbers used them in a different way, in that they were necessarily confined to one place, and that place was in the forehearth, and they were used in connection with shields which he also devised, and their use was here for the purpose of heat control alone.

(4) Turning next to the problems relating to the regulation of air and the solution thereof, we note that claim 5 of Patent No. 702,014 was an air problem, and under the order of discussion pointed out earlier in this opinion, would regularly be discussed under this present head. Regarding that claim, therefore, as a part of this present subject, and as here discussed by reference, we next turn to Lubbers's Patent No. 886,618 for an air-vent hole. The difficulty to which this patent was addressed was a fundamental one, and one which threatened to defeat the practical commercial success of the machine-drawing of window-glass. The difficulty that arose from air-pressure was that exceedingly slight variations led to the enlargement and corrugation of the cylinder, which of course made it practically unusable. Efforts had been made to overcome this difficulty by means of mechanical valves, of which Lubbers's apparatus and method patents, No. 702,016 and No. 702,017, in which Lubbers essayed to meet the difficulty, are examples; but the air-pressure was so light, and the necessity of adjustment so exact, that such mechanical valves had proved failures.

In this dilemma Lubbers made the simple and novel discovery that nature itself could solve the difficulty if an open vent was provided, and that such vent would automatically take care of air-pressure, and would prevent corrugations and bumps, or breathing, as it was termed. In other words, that where an overpressure of air was passing down the bait-stem such overpressure would find a safety-valve in a continuously-open vent located in the path of supply. It was a novel, daring, and original suggestion, and in our judgment went to the very heart of the success of machine-drawing. Indeed, the simplicity of the use of an open vent, which simplicity is cited as evidence of lack of invention, to our mind shows the high order of novelty and invention, in thus making use of a simple opening, instead of complicated mechanical appliances, in order to accomplish a really remarkable result. Substantially there is nothing to the patent except the vent, used in the connection it is; but that

very simplicity, originality, and effectiveness of the use evidence a high order of invention in employing such a simple appliance to accomplish such a vital result. As to the invention, the patentee states:

The invention also relates to the exhaust or relief of a small portion of the air supplied to the interior of the article during drawing, through a small hole which is opened by the operator after the forming of the cap, so that a constant opening is provided through which the excess air is passed out as it becomes heated within the article. This has been found desirable, especially in connection with the graduating valve by which the supply of air is controlled, since the small outlet prevents enlarging of the article during drawing which is otherwise liable to occur on account of variations of pressure in the cylinder.

The broad character of the invention was recognized by the Patent Office in awarding a generic claim such as No. 20:

In glass-drawing apparatus, an air supply pipe having an open outlet for air, arranged to equalize pressure in the article being drawn, substantially as described.

This claim, and Nos. 21, 23, 24, and 26, were all found valid by the court below, a conclusion in which we concur.

(5) We have not overlooked the able argument of counsel that Lubbers was not entitled to this claim, by reason of certain proceedings in the Patent Office. The history of the proceeding was that Lubbers applied on May 21, 1903, for Patent No. 886,618, granted May 5, 1908. At the suggestion of the Office, he later, and on a divisional application of that patent, applied for Patent No. 1,020,920, and the claims noted above were filed on April 25, 1906, which, it will be noticed, is almost three years after the original application was filed. We have carefully considered the subject, and see no reason to feel that this second application of Lubbers was not properly made, in connection with his original application. It was germane to it. The whole art was in a state of flux and experiment. New difficulties were being discovered, and it took time to locate what was the cause of these difficulties, as well as to devise means for meeting them. Certainly this whole matter of venting was an open, unsolved subject during this experimental season, and we find no time we can place our hands on with definiteness when Lubbers had satisfactorily worked out this open-vent solution, which time is more than two years in advance of his application.

(6) Turning next to the speed of draw, which we have found one of the basic elements of success in the process, we note the Patent No. 762,880, granted to James A. Chambers June 21, 1904, for a method of drawing glass articles. The claims involved are:

First:

The method of shaping glass articles, consisting in drawing them from a glass bath and gradually increasing the speed of drawing through the drawing operation, substantially as described.

Second:

The method of shaping glass articles, consisting in drawing them upwardly from a bath of molten glass and gradually and automatically increasing the speed of the drawing operation, substantially as described.

The court below found the two claims invalid. Our study of this art brings us to a different conclusion. It is, of course, clear that it is a self-evident fact that the faster a draw of molten glass is made the thinner the resultant article, and, of course, the slower the draw the thicker the glass. But from the time these experiments were begun by Lubbers no one seems to have thought of applying that general principle in a practical way to the new art of drawing that was being experimentally developed, until Chambers, who was a practical, experienced, and pioneer operator in glass, suggested his solution. Chambers's account of the art that Lubbers had up to that time developed in blown articles, and his remedy, are set forth in his application. He says:

My invention relates to the drawing of glass articles from a molten bath, and is designed to increase the output of drawing machines and to make the thickness of the glass more uniform throughout the cylinder or article being drawn. Heretofore in the drawing of cylinders and similar articles from receptacles containing a molten glass bath, the bait has been drawn upwardly at substantially the same speed throughout the drawing of the article. In such cases, especially where a cylinder is drawn two or three times the length of a roller, the glass of the lower portion of the cylinder is thicker than that in the upper portion. I have found that this difference in thickness is due to the gradual chilling of the glass in the bath, the glass gradually growing stiffer through the time occupied in the drawing operation, and that by gradually increasing the speed of the bait during the drawing operation I can reduce the time occupied in drawing and produce the article having a more uniform thickness of glass throughout its length.

Chambers disclosed a practical method of employing his principle by the use of a conically-shaped drum, rotated at uniform speed. The drawing began when the line was around the small end of the conical drum, and as it proceeded the successively-larger portions of the drum over which the drawing-line passed automatically increased the speed at which the bait was drawn upwardly. Chambers's method solved a real difficulty, and his principle of difference-in-speed drawing made it possible, even with the molten glass growing stiffer, to make the entire length of these great cylinders more uniform in thickness. It will, of course, be seen that the application of this speed principle to the mechanical process of drawing from a molten bath was novel, for, while the abstract principle of difference in speed as affecting thickness was known, an experienced man like Lubbers, confronted by failure of his valuable principles and patents by reason of the non-uniformity of his cylinder-walls, had not thought of any practical application of that principle to keep his

cylinder-walls from thickening as they were drawn. His cylinders were becoming longer, but with the longer cylinder came the thickening of the glass. It was then that Chambers stepped in and applied the old, but unthought-of, principle to this new process, which was a drawing and not a blowing operation. Lubbers had formed the cylinder initially by blowing. He was getting a longer cylinder, but the increase in length was accompanied by an increase in thickness, and it was at this point that Chambers, by speeding up the drawing, helped to save the process from failure. The claims involved the limitation of drawing from a glass-bath. It was to the drawing art that Chambers applied in a novel way the principle, and contributed his important part in making the entire drawing system a success.

Conceding that the blower had a conception that the longer his article was made the thicker it became, we find no reason therefrom to minimize what Chambers did. The blower was dealing with a fixed quantity of glass, and he had a fixed thickness to get from that limited quantity of glass. He had the benefit of a swing to thin his glass as he operated it, and it was his practice to subject it to heat three different times during the blowing process. In the machine-drawing method, the problem was essentially different. There was no fixed quantity of glass to be operated on, but a pot filled with a molten mass which was liable to be drawn in thinner or thicker form, according to its heat. There was no method of recharging or reapplying the heat. The factors, therefore, which confronted Chambers in the drawing art, were altogether different from those of the blower, and Chambers met the problem by drawing small quantities of molten glass into the cylinder-zone during the earlier stages of the operation when the glass was at a higher heat, and compensated for the loss of heat, and the consequent larger thickness of glass drawn, by a more rapid drawing, which became rapid automatically, during the latter stages of the operation. It was a simple, novel, and effective means of meeting the difficulty. It was one of the links that made a chain of success possible. We are of opinion Chambers's patent was valid.

(7) The orderly consideration of the speed of drawing next brings us to consider the patent to Lubbers, No. 822,678. Chambers, as we have seen, in his patent just considered, had shown how the body of a long cylinder, which was to be cut into rollers, could be kept of uniform thickness, while the draw was going on by gradually and automatically speeding up the draw of the cylinder-walls themselves. But, in addition to the necessity of regulating the draw of the main body of the cylinder, difficulties developed themselves in the cap at the top of the cylinder, and also in the lower part of the cylinder, just over the molten mass. These difficulties arose as an attempt was made to draw cylinders of longer length, for when such longer

cylinders were attempted to be drawn it was found that the cap which had to support the whole weight of the cylinder gave way under the strain. Lubbers's solution of that problem was to use three speeds in the operation.

First, a low speed in drawing the cap. Regarding this feature, Lubbers says in his specification :

I have also discovered that by using the lower speed in starting the drawing of the cylinder I can draw cylinders of a length equal to at least two or three of the cylinder rollers which had previously been blown by hand. I can thus draw a cylinder of several times the length of an ordinary roller, and then sever the cylinder at an intermediate point, or points, to give rollers of a length desirable for flattening and working up.

It will thus be seen that the strengthening of the cap by slow drawing was an important factor in the development of the new art of drawing very long cylinders. Of the drawing of the main cylinder-body, Lubbers says :

In drawing cylinders with this form of apparatus, the blowpipe is lowered into the bath and causes the glass to adhere thereto, and the pipe is then drawn up with a small amount of air admitted to form a neck portion 7. More air is then admitted to swell out the glass being drawn to the size of the cylinder desired, thus forming what is called the "cap." During the forming of the neck and the cap, and during the first part of the drawing of the cylinder proper, the drawing frame is lifted at slow speed by suitably controlling the fluid passed to the motor or in any other desirable manner.

Second, in drawing the main body of the cylinder, Lubbers speeded up the draw, preferably gradually, all of which were, of course, features also shown by Chambers. He says :

After the cylinder proper is started, the speed of the drawing frame is increased, preferably gradually, until it reaches the full normal drawing speed, which may then be continued until the complete cylinder is drawn of the desired length.

When the end of the cylinder proper was reached, and it was desired to form the cylinder end which dipped into the molten glass, and which was to be "capped off" eventually from the main cylinder-body, Lubbers suggested that this cap or end should be drawn thin, so that it might be easily sheared or cut off and dropped back into the molten mass. To do this he changed to a third and still higher speed, saying in his specification of that operation :

The speed is then increased to a considerable extent, such as to draw a thin portion of glass at the lower end, which may be easily severed from the glass in the tank by shearing, cutting off with the flame, or otherwise.

Referring to these three relative speeds, Lubbers points out his method of use as follows :

The relative speeds which I prefer to employ are about as follows: If the motor gives about 100 revolutions per minute in drawing the first portion, I preferably increase this to about 600 revolutions in drawing the major portion

of the cylinder length. The speed at the end to thin the glass is preferably much higher, preferably about 2,400 revolutions per minute. The speed which I have employed during the main drawing operation is about 30 inches per minute, with 600 revolutions. After cutting off, the drawing frame is lowered and the glass removed in the ordinary manner. By this method the cylinder is made stronger and thicker in the upper part, so as to support a long cylinder without breaking, and the change from the slow speed to faster speed is preferably gradual, so as to prevent excessive jerks which would injure the cylinder. I am thus enabled to draw a cylinder of at least two or three times the length of an ordinary hand-blown roller, which cylinder I then crack off at an intermediate point or points and cap off at its ends, thus forming several glass rollers or cylinders, which are cracked longitudinally and flattened in the ordinary manner. By thus drawing a cylinder of more than ordinary length, I am enabled to increase the output and cheapen the product.

It will be observed that the gradual increase of speed during the second, or cylinder proper, process, was not original with Lubbers, but was disclosed by Chambers. But Lubbers proposed to use in combination with this second or main-cylinder-body drawing, and to use in one continuous operation, a lower speed in making his upper cap and a higher speed in making his lower cap, with the practical and commercial result of making the long cylinders, without which the process would have been a commercial failure.

The claims here involved do not cover the second or Chambers method, standing alone, but only in combination with the lower speed in forming the upper cap, which elements are embodied in claims 1, 2, 3, and 6, or in combination with the forming of the upper cap at lower speed and the lower cap at higher speed, which elements in combination are embodied in claims 5, 7, and 8. In connection with both the slower speed in the upper cap and the higher speed in the lower cap, this particular Lubbers patent showed new combinations which the lower court found were valid, a conclusion with which we concur.

(8) We have already seen that the problem of obtaining cylinders of substantially uniform thickness was effected by positive controlling agencies which involved (a) temperature, (b) the distending air, and (c) speed, and the patents on these separate elements have already been discussed. But in addition to these positive controlling agencies, which had to be devised, the development of this art disclosed serious and obscure other difficulties of apparently an inexplicable nature, which had to be eliminated, overcome, or neutralized. For example, the natural thing, of course, was to let the bait drop into the center of the pot and draw the glass from that point, but for some inexplicable reason it was found in practice that the cylinder as it was drawn began to shift from this central position in an unaccountable way, with the result of producing glass of uneven thickness on opposite sides of the cylinder. This difficulty was finally located, its cause explained, and the trouble caused thereby

overcome by Lubbers in his Patent No. 914,588. Briefly stated, Lubbers found that the cooler portion of the molten glass has what is called a surface tension, or draw, of greater power than the hotter portion, and the tendency of this cooler and stronger portion was to shift the location of the bait from the center of the pot toward such cooler surface. Referring to this difficulty, in his patent Lubbers says:

In such drawing operations it has been found difficult to make the glass of the same thickness in the different portions of the circumference of the hollow article. * * * The glass thus drawn is often of the "thick and thin" variety. This forming of thick and thin portions during the drawing operation is not only objectionable on account of the variations in thickness, but it causes a large amount of breakage, both during the drawing and the subsequent treatment. It also injures the quality of the glass, by making it very difficult to flatten properly, where cylinders are formed producing waste in cutting, and sometimes prevents cutting the glass in the desired way.

The cause of this shifting Lubbers explains in his patent as follows:

I have found that where the glass is fed into a receptacle, for example, a refractory pot, the glass may be of a different temperature and stiffness in one portion of the pot from that in another portion, and the heat of the pot may vary in different parts thereof. There may also be variations in the character of the pot material in different portions of its walls, and other causes also lead to a difference in the surface tension in different parts of the article being drawn. I have found that, by adjusting the pot and drawing mechanism relatively to each other, I can reduce and avoid these difficulties to a large extent. With proper care in the adjusting, I can practically eliminate thick and thin glass and its consequent difficulties and objections. The importance of this will be understood when it is considered that in changing shifts of men all of the conditions surrounding the feeding of glass into the pot and the drawing operations are changed. These operations still depend to a considerable extent on the skill and familiarity of the workmen. For example, if the glass is ladled from the tank into the drawing pots, one operator may become accustomed to ladling the glass from a portion of the bath which is at a certain distance from the wall of the tank. His successor on the next shift may be accustomed to ladling from a different point in a different manner and under other conditions. For these reasons, it has been found that, where the drawing was proceeding in the proper manner with one ladler, it might draw in an entirely different manner with the next ladler. For some time it was not understood what caused this difference, which led to such important variations in the drawing of the glass. I have found that, by adjusting the pot and drawing tool or bait relatively to each other in a lateral direction, I can to a large degree compensate for these differences, owing to individual peculiarities in the workmen, and with proper care can practically eliminate thick and thin glass. Similarly, I can overcome the troubles arising from variations in the heat conditions and material of the pot.

To overcome these difficulties, Lubbers devised a simple drawing apparatus, by which the bait was made adjustable in lateral directions. When it was found that the bait and the cylinder were being drawn to one side by surface tension, he started the next draw a cor-

responding distance away from the center, so that the effect of the surface tension was to center the draw in the center of the pot and thus make a cylinder of uniform thickness. Speaking of his apparatus and of its method of use, Lubbers says:

I thus obtain two horizontal adjustments at right angles to each other, by which I can bring the blowpipe or bait to any desired position relative to the walls of the pot. If, on starting a shift, it is found that the glass is drawing thick and thin upon a pot, I loosen the adjustable screws for the blowpipe support of this pot, and shift the position of the blowpipe to compensate for the differing conditions of tension at the different parts of the surface of the bath. For example, if the glass is of a lower temperature at one side of the bath than at the opposite side, the blowpipe will be moved toward the hotter side. The cooler and stiffer portion of the glass will have a greater surface tension than the hotter portion, and consequently by moving the blowpipe toward the hotter portion I can compensate for this difference in the condition. Similarly, if the cavity or wall of the pot is hotter on one side than the other, thus giving more heat to the glass, I move the bait correspondingly. It is found in practice that, by adjusting the position of the bait or blowpipe relative to the walls of the pot, the difficulties in drawing thick and thin glass are practically overcome. In practice this adjustment may be needed when a shift is changed, or it may be needed even while the same workmen are operating the apparatus. The occasion which calls for adjustment is easily recognized, and with a little practice the mode of adjusting is easily understood.

This surface-tension patent, three claims of which, claims 5, 6, and 7, are involved, the court below found valid, a conclusion that commends itself to us, for we feel that the location and discovery of this obscure phenomenon was a matter of great originality and value, and its solution, by the simple compensating, self-adjusting mechanism which Lubbers devised and covered by the claims in question, was a very material element in the success of the whole art of the successful machine-drawing of window-glass.

(9) In addition to the difficulties that arose and which had to be overcome in the drawing of the cylinder from the pot-center, all of which elements have been considered in the foregoing patents, difficulties were also encountered and had to be overcome in the treatment of the cylinder after it was drawn, namely, in getting it into a position where it could be handled and cut into rollers, and also in the apparatus for properly cutting it into rollers. The cutting of the upper cap off the cylinder, and the cutting of the cylinder-body itself into rollers of proper length, was accomplished by the device of Hitner for capping off glass cylinders, disclosed in his Patent No. 821,361, which was applied for March 6, 1905. It is, of course, true that previous to Hitner's device cylinders had been capped off by means of an electrically-heated wire. This wire was held in stationary position and the glass was moved toward it. This resulted in considerable waste, and the moving of a large cylinder in this way was obviously objectionable. Hitner devised a tool made up of a

small heated wire of metal, of high electrical resistance, and of sufficient length to encircle the glass cylinder to be capped off. The leading-in wires were made flexible, so as to allow free movement of the device with relation to the stationary cylinder, and one of them was provided with a switch on the handle, by which an electric circuit could be made or broken, as desired by the operator. By the use of this device, the operator could loop the wire around the glass cylinder, and its free end passed around a roller held by the finger or thumb of the operator. When the switch was turned on, the current rapidly heated the encircling wire, which heat was communicated to the cylinder and caused the narrow zone of glass near it to expand. When this heated ring of glass was tapped by a cold steel tool, the glass parted on the line spanned by the wire. The court below, however, found the patent was invalid, because it had been placed on sale more than two years before the application.

A study of the case has brought us to a different conclusion. As the application was filed on March 6, 1905, such sale and public use must have been prior to March 6, 1903. This would be during the period when the work of devising a window-glass-drawing-machine process and apparatus as a successful whole was in an experimental state, both at Alexandria and at Gas City. Now, while the capping-machine of Hitner was in substantial form the same from the start, and while it operated in the same way then as now, nevertheless we are convinced that at the time these machines were devised and made by the Doubleday-Hill Electric Company for the American Window Glass Company, and were paid for, that under the peculiar circumstances of this case said machine was still in an experimental stage, and such sale and use was not a public one in the sense of the statute. In the first place, the operations at both places were of a most secret nature. The machine was not made by the Doubleday-Hill Electric Company and sold to the American Window Glass Company in the ordinary commercial sense, but the American Window Glass Company, in order to have some electrical work, which it was not able to do itself, done by competent people, arranged with Doubleday-Hill Electric Company to furnish them with the services of Hitner, one of their employees. During the course of this employment, Hitner devised the capping-machine, and it was constructed by Doubleday-Hill & Company, his employer, under the orders and at the request of the American Window Glass Company. In substance, we regard the making of the machine as having been made really by the American Window Glass Company. But not only was this the case, but its use was not a public one. The plants were closed and the operations carried on in the most carefully-guarded way. Moreover, while this device was used, its use was wholly experimental, for success had not been reached in the manufacture of long cylinders,

and the breakage and failure of the experiments up to that time were charged, *inter alia*, to this very Hitner capping device. It had not then justified itself, and its success and its freedom from blame for the troubles that undoubtedly then existed in the successful manufacture of long cylinders were not such as to warrant an application for it as a device which had passed the experimental stage. We are therefore unable to agree with the conclusions of the court below that Hitner's patent was invalid. On the contrary, we find that it was inventive in character and applied for in due time.

(10, 11) What we have said in a general way as to this patent of Hitner applies to his Patent No. 822,452 for a hoist. As stated earlier in this opinion, after the cylinder was drawn and swung out to a horizontal position in mid-air, it was lowered and cushioned on a long horse or stand that stood on the floor. The proofs in this case show that as the development went on several devices were tried for supporting such drawn cylinder, but none were satisfactory. Lubbers sought to form such a rest, but his took too much time and it was abandoned. Thornburg, also an experienced man, sought to solve the difficulty, but without success, and it remained for Bridge to develop an apparatus which had proved entirely satisfactory and for which Patent No. 1,006,995 was granted him. Without entering into minor details, we may say that his device consisted of a series of upright standards provided with semicircular arms, which were made resilient by the use of springs supported on arms which extended from the standard to the crosspiece which supported the semicircular hoops on which the cylinder rested. The arrangement of parts was such that, not only was the entire cylinder safely rested upon all the semicircular arms of the device when the cylinder was lowered, but as each roller was capped off and parted from the remainder of the cylinder, not only was the capped-off roller properly supported by the semicircular arms on which it rested, but the remainder of the cylinder remained safely nested on the remaining semicircular arms of the device. This device was only perfected after much experimenting. We are of opinion, with the court below, that the device involved invention, was novel and useful, and the patent was applied for within two years of its being perfected. We therefore agree with the court below that the claims in controversy, claims, 1, 2, and 4, are valid.

Turning to the question of infringement, we note the fact that prior to the patents in suit there were no apparatus or methods in existence for machine-drawing window-glass. It is therefore self-evident that the defendants' apparatus and method of machine-drawing window-glass, which is a commercial success, was not drawn from the prior art. There is no evidence that it was originated by them-

selves. There is evidence that some of those who helped install their plants had formerly been in the employ of the plaintiff company, and knew of its methods. It is therefore quite reasonable to infer that the successful devices of the complainant must have had a material influence in formulating the methods and apparatus which the defendants followed and used. In view of this situation, we are not surprised to find that, taken as a whole, the defendants copied and infringed the plaintiffs' process and apparatus, and this copying is in the main so apparent, if the plaintiffs' patents are held valid, that the conclusions reached by the court below are self-vindicating. We therefore refrain from a minute discussion of the question of infringement, with the exception of referring to the principal and basic element of whether the defendants used a forehearth from which they drew their glass. In that connection, we may say that the defendants' furnace and its mode of operation are aptly described in the opinion of the court below, from which we quote as follows:

The defendants' tank furnace at Hazelhurst, previously used for hand blowers, was rebuilt and changed in 1908 from the hand-blowing tank to the machine tank. As reconstructed, the working end was considerably widened, thus giving extensions of the main tank. The construction of the Kane tank is the same. These extensions were partially separated from the tank proper, by a series of piers, drawing places being provided in the side extensions by lowering the roof over the drawing positions of the bath, and providing covers near to the glass level in the extensions. The heat currents in the main bath were vertically cut off from those shielded covers by "vertical shades" or clay plates resting on the piers which extended down near to the glass level. As thus constructed, the depth of the glass in these side extensions was less than that of the glass in the main tank; the floor being elevated or built up. Being partially separated from the furnace proper by the piers, the heat currents in the main bath to some extent cut off by the vertical shades, the depth of the glass being less than that in the main tank, bounded on one side by an outer side wall and on the other joined to the hot glass in the main tank, from which the glass on the same level flowed to the drawing station, these extensions present all the characteristics of the forehearth. I have here attached transverse and longitudinal sections of the working end of defendants' furnace, showing the side extensions and drawing stations, being copies of plaintiffs' Exhibit 68. Defendants' furnace structure is shown in a plaster model (defendants' Exhibit 30), the correctness of which seems to be conceded, except as to the stepping down of the pedestals in the drawing holes, which is correctly shown in the drawings attached. Similar extensions were also built at the end of the drawing portion of the tank. Four gas burners for each drawing station, were extended through holes in the side walls; the two outer burners being at right angles with the wall, and the intermediate ones being pointed in a converging angle toward the draw. These burners perform the same function as the burners in the Lubbers forehearth. The heat above the glass at the drawing stations coming from these burners and that entering from the main furnace was shielded from the drawing point, first by a vertically movable clay cylinder lowered through the top stone, and later by this cylinder coacting with a floating clay ring. One floating ring was first used, then two, and finally three, for each drawing place. Before the draw began, a ring was pulled into place by the operator, and the

cylindrical clay shield was then lowered to make a joint with the floating ring, which largely cut off the surrounding heat and also centered and held the ring in position concentrically under the drawing hole. The draw then began and proceeded slowly, no water-cooled chilling ring being then employed; the glass being chilled solely by exposure to the atmosphere. Later a water-cooled chilling ring was added inside of the clay ring to increase the chilling effect, thus greatly increasing the speed of draw and the amount of production. Later, by proportioning the width and depth of the water chilling ring so that it extended from the top stone down substantially to the floating ring, it was found that the clay cylinder or anchor ring could be done away with. Since then the drawing has proceeded within the floating ring and up through the water-cooled shielding and chilling ring, which was not protected by a surrounding cylinder. Except in unimportant details, the operations of the Consolidated, the Pennsylvania, and the Kane Glass Companies were the same. In some cases the water ring was tilted according to the judgment of the operator. Sometimes the water ring had small centering lugs, which held the rings a fraction of an inch apart, and sometimes these were cut off, in which case the rings set close together.

From a study of the proofs, of the drawings and models, we conclude that the defendants, who had been previously drawing their glass from a tank and the body of the tank, saw fit to change both the construction and the mode of operation of their tank. Their change in construction consisted in adding to the side of the tank, at its working end, side chambers, into which the glass flowed from the main body of the tank, so that in this way they received a continuous and full supply of molten glass. The roof of this side structure was lower than the tank-roof. It was also shielded both from the direct effect of the burning of the generative gas in the tank proper and was measurably protected from the radiation of that heat, not only by its retired position and by its roof, but by the shields and heating-reducing devices employed in and about such side chamber. We are quite clear that this side structure of the defendants, from which they drew their glass, was the functional equivalent of Lubbers's forehearth. It had all the functional features which Lubbers first pointed out to the art in his forehearth. It was automatically fed from the main body of the tank. Its heat was less than the main body of the tank. It used shields and cooling-rings. It afforded a workable basis for drawing window-glass cylinders, and its structure was such as to allow the control and modification of heat, which were essential to the success of a machine-drawing system. Its location and relation to the tank were such that, while this side structure got the benefit of the whole maximum heat of the tank and of the whole molten product of the tank, those operating it were enabled to use only such ranges of the maximum heat as they needed to maintain proper glass-molten conditions, and yet were enabled to shield or shut off such portions of the tank as were harmful. In no sense of the word did the defendants in their reconstructed tank follow, either in function or physical effect, the

old system of working from the tank proper; but they availed themselves in function and practice of Lubbers's forehearth in a modified form, which one of the plaintiffs' witnesses has happily called a "sheltered cove." We are quite clear that the judge committed no error in holding that defendants' side-tank practice was an infringement of Lubbers's patents.

As to those features of infringement which the court below did not pass upon, we deem it sufficient to say that, in view of what we have already said on the general subject of infringement, we feel that, in addition to what the court below found infringed, we are justified in also finding that claim 5 of Patent No. 702,014 to Lubbers, which we have before indicated was valid, was also infringed. We further find that claims 1 and 2 of patent to Chambers, No. 762,880, which we have before found valid, were also infringed. We also find that claims of the patent to Hitner, No. 821,361, for capping off glass cylinders, which we have heretofore found valid, were infringed. We also find the claims of Patent No. 822,452 to Hitner, for a hoist, which we have heretofore found valid, were also infringed. We also find that claims 20, 21, 23, 24, and 26 of the patent to Lubbers, No. 886,618, for a hole-vent, which we have found valid, were infringed.

With these additions and modifications, the decree of the court below will be affirmed.

In thus concurring in the conclusion reached by that court we place of record the fact that the work of the individual members of this court in understanding the complicated and difficult questions involved, in digesting the proofs, and in formulating their views have been greatly aided by the industry, patience, and research expended by Judge Thomson in the preparation of his able and exhaustive opinion.

[U. S. Circuit Court of Appeals—Second Circuit.]

HERCULES POWDER COMPANY v. NEWTON, COMMISSIONER OF PATENTS.

Decided April 14, 1920.

274 O. G., 204; 266 Fed. Rep., 169.

1. TRADE-MARKS—SUIT UNDER SECTION 4915, REVISED STATUTES—JURISDICTION.

In a suit brought under section 4915, Revised Statutes, against the Commissioner of Patents to obtain registration of a trade-mark, where there is diversity of citizenship of the parties, although neither is a resident of the district where suit is brought, jurisdiction exists where defendant consents to the suit.

2. SAME—REGISTRATION—RIGHT TO REGISTRATION GOVERNED ALONE BY STATUTORY PROVISIONS.

Upon application to register a trade-mark where the question presented is whether the mark is descriptive, and hence not registrable under the

statutes, the value of the mark or the fact that dealers and buyers of the goods to which it has been applied do not associate it with the goods except as indicative of origin is immaterial and tends only to prove rights which should be protected from unfair competition.

3. SAME—SAME—DESCRIPTIVENESS OF MARK QUESTION OF LAW.

Upon application to register a trade-mark the question whether it is descriptive is a legal one where there are no contradictions of fact or contradictory inferences of fact. (*Gold v. Newton*, C. D., 1918, 310; 256 O. G., 649; 254 Fed. Rep., 824; distinguished.)

4. SAME—WHAT IS A REGISTRABLE MARK NOT DEFINED BY STATUTE.

The trade-mark statute, (act of 1905, 33 Stat., 724,) as amended, does not describe or define what constitutes either a good trade-mark or a registrable trade-mark. It assumes that the word has a meaning sufficiently well known to dispense with statutory definition. It does, however, lay down some rules for the guidance of the Commissioner, among which is the provision that "no mark which consists * * * merely in words * * * which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered."

5. SAME—RIGHTS ACQUIRED BY TEN YEARS' EXCLUSIVE USE.

The Trade-Mark Act of 1905 (33 Stat., 724) in the so-called "ten-year clause" recognized, if it did not create, a property right previously doubtful, if not wholly non-existent; but it does not give similar rights to one who has exclusively used a merely descriptive or geographical mark for ten years expiring after the passage of the act.

6. SAME.

"No sign or form of words can be appropriated as a valid trade-mark which from the nature of the fact conveyed by its primary meaning others may employ with equal truth, and with equal right, for the same purpose." (*Standard Paint Co. v. Trinidad Asphalt Co.*, C. D., 1911, 530; 165 O. G., 971; 220 U. S., 446.)

7. SAME—DESCRIPTIVE MARKS—"MERELY" DESCRIPTIVE.

"'Merely descriptive' (Trade-Mark Act of 1905, section 5 (b)) means *only* descriptive, or nothing more than descriptive. It may be that the force of the adverb is satisfied by the addition to the descriptive word of a picture or device, or by qualifying the description through the addition of another word. * * * But if the proposed trade-mark consists of a single word, then that word standing alone is merely descriptive, or it is not descriptive at all."

8. SAME—"INFALLIBLE," FOR SMOKELESS POWDER, MERELY DESCRIPTIVE.

The word "Infallible," as applied to smokeless powder, *Held* merely descriptive. Perhaps, when accurately used, it refers always to mental processes, but in common acceptance it means "exempt from uncertainty" or "absolutely trustworthy."

9. SAME—SUGGESTIVENESS AND DESCRIPTIVENESS DISTINGUISHED.

"The difference between suggestion and description is often hard to perceive. An explosive powder marked as 'Hercules' would be suggestive, and no person other than its maker could with equal right and equal truth call his powder by that name or any derivation therefrom; but 'Infallible' is merely descriptive because it has no association with the Hercules Company other than that acquired by a long course of business nomenclature."

APPEAL from decree entered in the District Court for the Southern District of New York, dismissing bill in equity.

STATEMENT OF THE CASE.

The bill is brought under section 4915. Revised Statutes, and section 9 of the Trade-Mark Act of 1905 (33 Stat., 727) to procure a declaration that plaintiff is entitled to have defendant register under the act its trade-mark of "Infallible" for smokeless sporting-powder.

Diversity of citizenship exists between the parties; therefore, although neither is resident within the Southern District of New York, jurisdiction exists based solely on the consent of defendant. (*Barrett Co. v. Ewing*, C. D., 1917, 353; 243 O. G., 1065; 242 Fed. Rep., 506.)

In 1914 plaintiff applied for registration showing a use of the word "Infallible" as applied to smokeless sporting-powder for several years. On appeal from the Examiner defendant said that "under the circumstances" shown, he held the word "descriptive" with "great reluctance."

He pointed out that plaintiff's use of the word as a mark could be protected on the principles of unfair competition, but since the Patent Office had theretofore denied registration to "Infallible" as applied to flour, the same reasons impelled to deny as to smokeless powder; for plaintiff claimed by advertisement that its powder was "uniform in velocity and pattern," not "affected by climatic changes," and "always reliable." Of such a substance he thought "Infallible," not "exhaustively" descriptive, but still it described the qualities such powder should possess and it therefore should not be registered.

From this decision an appeal was taken to the Court of Appeals of the District of Columbia, which affirmed. (*In re Hercules Powder Co.*, C. D., 1917, 176; 241 O. G., 1157; 46 App. D. C., 52.) This suit was then brought, and the bill dismissed; this appeal followed.

(Decree—C. D., 1918, 114; 257 O. G., 1081; 254 Fed. Rep., 906—affirmed. For decision of the Court of Appeals of the District of Columbia see C. D., 1917, 176; 241 O. G., 1157; 46 App. D. C., 52.)

Mr. Edwin J. Prindle and Mr. Warren H. Small for the plaintiff-appellant.

Mr. Robert F. Whitehead and Mr. Lineas D. Underwood for the appellee.

Before WARD, HOUGH, and MANTON, Circuit Judges.

HOUGH, *Cir. J.*:

The issue tendered by the pleadings herein is shown by an extract from the answer, viz:

Defendant denies that the word "Infallible" is registrable as a trademark for smokeless powder under the act * * * and avers that it is * * * precluded from registration by said act.

Thus the point is not that registration ought not to be granted because of some proven fact, but that it cannot lawfully be conferred because the statute forbids.

Plaintiff has, we think, sought to complicate the issue by pressing upon us as a fact proven beyond doubt, that dealers and buyers of powder do not associate "Infallible" with that explosive except as indicative of its origin—"Infallible" means made by Hercules Co.

If this be true, it doubtless strengthens plaintiff's rights against infringers or trespassers; it shows the existence of a business to which the mark is appurtenant, and tends to prove rights which should be protected from unfair, *i. e.* deceptive competition.

But the only question we have, or can have presently before us, is the right to register; not the value or worthlessness of what is registered.

The desirability of registration under the act of 1905, to and among those in extensive and especially foreign trade is very great, and need not be dwelt upon; yet it is too well settled to need citation, that a trade-mark is not the creature of registration, but the appanage or growth of a business. The Commissioner cannot base approval or denial of application on an inquiry into the nature of petitioner's business, or a finding as to how the public regards the product thereof; he can but examine the article and the mark, and declare whether the statute prohibits their registered union.

Therefore the evidence offered by plaintiff is immaterial and we regard the case as presenting nothing but an inquiry as to the meaning of a statute.

The absence of contradictions of fact, or of contradictory inferences of fact from admitted phenomena, differentiates this case from *Gold v. Newton*, (C. D., 1918, 310; 256 O. G., 649; 254 Fed. Rep., 824,) and we proceed to consider the legal question above stated.

Our present trade-mark statute, (act of 1905, 33 Stat., 724,) as amended, does not describe or define what constitutes either a good trade-mark or a registrable trade-mark. It assumes that the word has a meaning sufficiently well known to dispense with statutory definition.

It does, however, lay down some rules for the guidance of the Commissioner, and this case revolves around the construction of one of those rules, viz., (act, sec. 5; Comp. Stat., sec. 9490:)

No mark which consists * * * merely in words * * * which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered.

It has been said of these words that they only declare "the accepted law of trade-marks," and we agree with this ruling. (*Re National Phonograph Co.*, C. D., 1907, 550; 128 O. G., 1295; 29 App. D. C., 142.)

On one point only did the present statute in effect certainly recognize, if not create, a property right previously doubtful if not wholly non-existent. We refer to the so-called "ten-year clause," also found in section 5 of the act, which as construed in *Davids Co. v. Davis* (C. D., 1914, 367; 202 O. G., 952; 233 U. S., 461) and *Nashville, etc., Co. v. Coca Co.* (215 Fed. Rep., 527) secured if it did not give to those who had exclusively used a doubtful mark for ten years before the passage of the trade-mark statute, rights now undoubted.

But nothing can be found in the act which gives to one who has succeeded in exclusively using a merely descriptive or geographical or proper name for ten years expiring after the passage of the act, rights identical with or similar to those validated by the ten-year clause.

It seems to us the clear intent of the legislature to compel those who wish registration for their marks and who could not claim under the ten-year proviso, to suggest to the Commissioner for registration only those marks recognized by the "accepted law," *i. e.* in the absence of further legislation by the rule announced in authoritative judicial decisions.

It is not without interest to note that contemporaneously with the passage of our present statute, Great Britain revised its law by passing the Trade-Mark Act of 1905. (For text see Sebastian, Trade-marks, 5th ed., p. 368.)

That act provides (sec. 9, subsec. 4) that a mark may be registered which is—

a word or words having no direct reference to the character or quality of the goods—

to be distinguished.

Under this section of the act has grown up the English rule that words which are merely "laudatory epithets" are not registrable as trade-marks. (*Re Crosfield*, L. R., 1919, 1 ch., 130, disallowing the word "Perfection" as applied to soap; and *in re Sharpe, etc.*, 84 L. J., ch. 290, rejecting the word "Classic" as applied to stationery.)

Though often difficult in application, the accepted legal rule for trade-marks suspected of being descriptive or geographic is not difficult to state; and it may be noted that both in the statute and in decisions the faults arising from geographic and descriptive names are treated alike—they are nearly akin.

For us the authoritative rule was restated in *Standard, etc., Co. v. Trinidad, etc., Co.* (C. D. 1911, 530; 165 O. G., 971; 220 U. S., at 453) thus:

It (the trademark) may consist in any symbol or in any form of words, but as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trademark which *from the nature of the fact conveyed by its primary meaning others may employ with equal truth, and with equal right, for the same purpose.*

The latest ruling (*Hamilton, etc., Co. v. Wolf*, C. D., 1916, 281; 225 O. G., 1441; 240 U. S., at 256) relies upon the same decisions and applies the same rule to a close case; and in holding "American Girl" as not descriptive of shoes, points out that "American Shoes" would come within the prohibition.¹

It seems clear, therefore, that the Commissioner will properly act under this section of the statute if he inquires whether under ruling case law the proposed trade-mark is descriptive—unless it can be held that the statute has modified or changed the result of judicial decision by inserting the word "merely."

"Merely descriptive" means *only* descriptive, or nothing more than descriptive. It may be that the force of the adverb is satisfied by the addition to the descriptive word of a picture or device, or by qualifying the description through the addition of another word. Thus in *Re Crosfield, supra* (p. 143) it was suggested that while appellant could not use the word "Perfection" as a trade-mark for soap, if he used "Crosfield's Perfection" different considerations might arise.

But if the proposed trade-mark consists of a single word, then that word standing alone is merely descriptive, or it is not descriptive at all.

It does not conflict with this ruling that, as suggested in *Williams v. Mitchell*, (C. D., 1901, 445; 96 O. G., 2411; 106 Fed. Rep., at 170,) a word may be in its nature descriptive, and yet in its application not descriptive.²

As most English speech is to be understood only from its context, so a word often takes its hue and meaning from its environment. It is to this truth that we owe such decisions as that in *Waterman v. Shipman*, (130 N. Y., at 310,) holding that the word "Ideal" as applied to—

fountain pens (is) non-descriptive, arbitrary and fanciful and has no natural nor necessary application to a pen.

And this court made the same ruling in respect of the same word as applied to brushes, in *Hughes v. Smith*, (209 Fed. Rep., at 39,) although the remark was not necessary to decision, inasmuch as the "ten-year clause" protected that particular trade-mark.

¹ *Dennison, etc., Co. v. Thomas, etc., Co.* (94 Fed. Rep., 651) and *Kellogg, etc., Co. v. Quaker Oats Co.* (235 Fed. Rep. 657) contain citations of practically all the best considered cases on this subject.

² This ruling was disapproved (as it seems to us improperly) in *re American Circular Loom Co.* (C. D., 1907, 452; 126 O. G., 2181; 28 App. D. C., 446.)

But after making these allowances it remains true that the fundamental inquiry is this: Does the suggested trade-mark word or device with the environment proposed for it, convey by its primary meaning something which others may employ with equal truth and equal right for the same purpose?

Putting that inquiry in this case, it seems to us that the word "Infallible" as applied to explosive powder, is merely descriptive. The word by derivation, and perhaps when accurately used, refers always to mental processes; but it has long come to mean in common acceptation "exempt from uncertainty," or "absolutely trustworthy." When applied to an explosive it is plainly descriptive of what the powder will do, and is distinctly the "laudatory epithet" of the English cases.

Comparing it with the American formulation of the rule, it is obvious that any other manufacturer of equally good powder may, with equal right and equal truth call his explosive "Infallible."

Decisions on such a point as this are illustrations rather than ruling precedents, for the environment or application of the word may so easily modify its signification.

Yet since the word is a common one, ruling upon a word similarly suggestive of excellence and similarly common are illuminative. The word "Standard" as applied to phonographs has been rejected, (*Re National Phonograph Co.*, C. D., 1907, 550; 128 O. G., 1295; 29 App. D. C., 142), and has been found equally open to objection in respect of scales, (*Computing Scale Co. v. Standard, etc., Co.*, 118 Fed. Rep., 935,) while as applied to bathtubs and similar articles it has been rejected (*Standard Ideal Co. v. Standard Sanitary Co.*, L. R., 1911, App. Cas., 78) under the Canadian Trade-Mark Act, which requires refusal of registration—

if the so-called trademark does not contain the essentials necessary to constitute a trademark properly speaking.

Under this language it seemed to the Privy Council—

perfectly clear that a common English word having reference to the character and quality of the goods in connection with which it is used, and having no reference to anything else, cannot be an apt or appropriate instrument for distinguishing the goods of one trader from those of another.

The decisions of this court have adhered to this rule consistently, from *Bennett v. McKinley* (65 Fed. Rep., 505, instantaneous-tapioca case) to *Thermogene Co. v. Thermozine Co.*, (234 Fed. Rep., 69, the thermos-bottle case.) The litigation over "Holeproof" hosiery (*Holeproof Co. v. Wallach*, 172 Fed. Rep., 859, modifying 167 Fed. Rep., 373) was decided wholly on grounds of unfair competition; as also were *Siegert v. Gandolfi*, (147 Fed. Rep., 100, the Angostura Bitters case;) *Florence, etc. Co. v. Dowd*, (178 Fed. Rep., 73, the

Keep Clean toothbrush case,) and *Wrigley, etc., Co. v. Grove Co.*, (183 Fed. Rep., 99, the spearmint-gum case.)

It is true that in some of the decisions hereinabove cited, and many others, the distinction between rights inhering in a valid and registrable trade-mark and those arising from a defendant's unfair competition have not been plainly delimited. Yet the distinction is not shadowy; and in the closely-akin matter of geographical names as trade-marks we have recently treated it at length in *Scandinavia Co. v. Asbestos, etc., Works*, (257 Fed. Rep., pp. 951 and 960.)

We there held that geographical names do not constitute valid trade-marks unless selected, issued and appropriated under such special circumstances as to point distinctively to origin or ownership. Of this the Chartreuse litigation is the best instance. (*Baglin v. Cusenier Co.*, C. D., 1911, 552; 169 O. G., 580; 221 U. S., 592.) Transferring that remark to the present case of a descriptive word as a trade-mark we think that such word must be rejected unless it is so modified by other words, phrases or designs as to render it not "merely" descriptive, or unless common knowledge or evidence demonstrates that the descriptive word is used in a plainly non-descriptive manner.

Of this last the Sterling Ale case (*Worcester, etc., Co. v. Rueter*, 157 Fed. Rep., 217) and *Ludington, etc., Co. v. Leonard* (127 Fed. Rep., 155) are examples. In this last case the word "Carroms" was upheld as a trade-mark for a game because a carom was no part of the game.

The similarity of trade-mark and unfair competition law is obvious; the latter largely grew out of the former and is its natural evolution. The differences between them are perhaps as well marked by extreme cases under both doctrines as in any other way. The rigid yet far-reaching nature of a trade-mark is well illustrated by *Aunt Jemima, etc., Co. v. Rigney*, (247 Fed. Rep., 407,) while the possibilities of relief against unfair competition find an extreme example in *Shredded Wheat Co. v. Humphrey Cornell Co.*, (250 Fed. Rep., 960.) The litigation in this circuit over this trade-mark has we think grown out of the very rigid language employed by the Court of Appeals of the District of Columbia in cases of this kind. The decision on the appeal of the present plaintiff is based upon adherence to the court's previous decision in *Re Central Consumers' League*, (C. D., 1909, 329; 140 O. G., 1211; 32 App. D. C., 523,) where the court held that it was the object of Congress—

to prohibit anyone from acquiring a property right * * * in a name possessing any inherent signification that would of itself enhance the use or value of the article or articles to which it may be applied. * * * It was intended to limit the selection to mere arbitrary words.

In adhering to its previous ruling the court further said of trade-mark words in general:

If descriptive at all, the act forbids the registration.

As above indicated, we think that is going too far. The suggested word must be "merely" descriptive and must be so descriptive with reference to the particular thing to be described.

The difference between suggestion and description is often hard to perceive. Complete definition seems to us impossible, but apt illustration is furnished by the present cause. An explosive powder marked as "Hercules" would be suggestive, and no person other than its maker could with equal right and equal truth call his powder by that name or any derivative therefrom; but "Infallible" is merely descriptive because it has no association with the Hercules Company other than that acquired by a long course of business nomenclature.

Another reason for this present action is the long line of trade-marks allowed by the Patent Office and thought by the plaintiff to be open to the same objection successfully urged against his word "Infallible." It seems to us that the registration of such words as "Perfection" and "Marvellous" for cold-cream (not to speak of others) is open to criticism, but errors in the Office cannot affect authoritative judicial decisions. It is also reasonably inferable from this record that plaintiff feels unjustly treated by refusal to register a word which it has exclusively and successfully used as a trade-mark for more than ten years, but not for that decade which alone secures protection under the ten-year clause of the present statute. We appreciate the hardship and are quite aware of the international trade-mark difficulties which beset the path of the American trader in foreign parts who has not secured registration in his own country. But the remedy is with the Congress, and neither the Commissioner of Patents nor any court can change the accepted law on which the Trade-Mark Act of 1905 was built.

It is not possible under the present act for a citizen to choose as his trade-mark something invalid by general law, use it without opposition long enough to make a showing of trade repute and commercial success, derive from that success "secondary meaning" for his mark, and then apply for registration.

There is much to be said in favor of a registration law which would give legal and governmental sanction to any mark which it could be shown the public has accepted. Such a system would enable this plaintiff to prevail; but Congress must first create it.

Decree affirmed.

[U. S. Circuit Court of Appeals—Third Circuit.]

ROHM *et al.* v. MARTIN DENNIS CO.*Decided January 12, 1920.*

275 O. G., 201; 263 Fed. Rep., 388.

1. PATENTS—FOR HIDE PREPARATION INVALID FOR FAILURE TO DISCLOSE INVENTION.

Rohm patent, No. 886,411, for a process for bating hides, *Held* invalid, because of the application's failure to fully and clearly disclose the invention, as required by Revised Statutes, section 4888. (Comp. St. sec. 9432.)

2. SAME—NECESSITY OF CLEARLY DISCLOSING INVENTION.

Revised Statutes, section 4888 (Comp. St. sec. 9432) and the purpose of the patent laws require a full disclosure of the invention before the patent is granted, in order that the public may, at the expiration of the patent, have full use of the invention.

APPEAL from the District Court of the United States for the District of New Jersey; J. Warren Davis, judge.

Patent infringement suit by Otto Rohm and the Rohm & Haas Company against the Martin Dennis Company. *From a decree dismissing the bill* (263 Fed. Rep., 106), *plaintiffs appeal. Affirmed.*

Mr. Charles Neave and *Mr. Merrell E. Clark* for the appellants.

Messrs. McCarter & English and *Mr. Arthur L. Fullman* (*Mr. Park Benjamin* of counsel) for the appellee.

Before BUFFINGTON and WOOLLEY, Circuit Judges, and MORRIS, District Judge.

BUFFINGTON, *Cir. J.*:

The bill filed in the court below by Otto Rohm and others, owners of Patent No. 886,411, issued to him May 5, 1908, for a preparation of hides for the manufacture of leather, charged the Martin Dennis Company with infringement of said patent. On final hearing, that court entered a decree dismissing the bill. Thereupon Rohm and his associates took this appeal.

1. After full argument before this court and due consideration, we are of opinion the court below committed no error in dismissing the bill, and we rest our conclusion on the ground that the patent is invalid by reason of the fact that the patentee did not, in his application, give the public that full and clear disclosure of his invention Revised Statutes, section 4888 (Comp. St. sec. 9432) requires.

The patent covers a process for bating hides which is so fully described in the opinion below that we save needless restatement by referring to the report thereof at 263 Fed. Rep., 106. Briefly stated, the alleged invention of Rohm was the substitution by him of the

pancreas of animals for the dog-manure used in the well-known process of bating hides. The old process and Rohm's improvement by substituting animal pancreas for dog-manure are thus stated in his specification:

For bating hides, that is to say, for removing the lime and fatty matter from the hides after the liming process, dog manure has been used for a long time.

The present invention has for its object to provide a simpler and more reliable method of removing the lime, together with the fatty matter and the remnant of the hairs. For this purpose I treat the hides with an aqueous extract from the pancreas of animals. The principal constituent of the said pancreatic extract is trypsin, the effect of which is materially assisted by the other enzym of the pancreas, viz., steapsin, which has the property of splitting up fat and completing the saponification of the fat contained in the hides.

Rohm's disclosure as to use of his process is as follows:

The details of procedure will appear from the following example: A pancreas weighing about 250 grams is extracted with 1 liter of water, and 10 cubic centimeters of this extract are added to 990 cubic centimeters of a 0.1 per cent. aqueous solution of ammonium chlorid. The solution thus obtained is an excellent bate.

Is this, in connection with the other parts of the specification, a compliance with Revised Statutes, section 4888, which required that—

Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall * * * file in the Patent Office a written description * * * of the manner and process of making * * * and using it, in such full, clear, * * * and exact terms as to enable any person skilled in the art * * * to which it appertains, * * * to make * * * and use the same.

Has this basic statutory condition precedent to the grant of a patent been complied with by the present applicant? The evidence satisfies us it has not. On that point we refer to the testimony of Otto Haas, one of the plaintiffs, and who has overseen the manufacture and sale, under the patent, of the extract of pancreas disclosed by the patent, which was commercially styled "Oropon." It was sold to some one hundred and thirty customers, among whom was the witness Beadenkopf, in connection with whose use of "Oropon" experiments by Haas and him were carried on,

to find out with what quantities of "Oropon," in lime, and at what temperatures, we could obtain the best possible results.

It further appeared that it was the plaintiffs' custom to send their chemist to all of their customers so desiring, in order to give them like instructions. When the witness was asked whether the instructions so given involved any departure from those of the paragraph of the patent above specified, which stated, "The solution thus obtained is an excellent bate," he refused to answer. He

was then asked whether the "Oropon" they sold was prepared by that formula; but this he refused to say, as also whether it contained any different ingredients from those disclosed in the patent.

2. Manifestly there was no reason, if the patent disclosed the entire invention and full workable directions for using it, why these questions should not have been answered; but if the specification did not sufficiently disclose the invention, and full and clear instructions for its use, it was clearly of interest to the plaintiffs to withhold such information. For if this withholding of information could be thus successfully carried out for the next six years, as it has been during the eleven years since the patent issued, the patentee would then for seventeen years have had a monopoly of his undisclosed invention, and at the end of the seventeen years he and his customers would have a like monopoly of the undisclosed invention for all time, unless they then chose to take the public into their confidence. But such is not the spirit of the patent law. Its purpose is that such full disclosure shall be made before the patent is granted that the public may, at the expiration of the patent, have a full and workable use of the invention. Indeed, this initial "full, clear, concise, and exact" disclosure is the real consideration moving from the patentee for the grant of patent monopoly by Government; and so necessary is a disclosure of this kind that the authorities have gone to the extent of holding (see opinion of Chief Justice Taney in *Wood v. Underhill*, 5 How., 1; 12 L. Ed., 23, cited by the Supreme Court in *The Incandescent Lamp Patent*, C. D., 1895, 675; 75 O. G., 1289; 159 U. S., 474; 16 Sup. Ct., 75) that—

If, from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent.

Satisfied, as we are, that the specification did not make the required statutory disclosure, we hold the patent invalid.

The decree below is therefore affirmed.

[U. S. Circuit Court of Appeals—Second Circuit.]

G. REIS & BRO., INC., v. REFORM INITIAL COMPANY, INC., AND GOTTSCHALK AND BRASCH.

Decided May 12, 1920.

275 O. G., 422; 266 Fed. Rep., 219.

1. PATENTS — INVENTION — CHANGE OF MATERIAL — RESULT NOT MATERIALLY CHANGED.

"A filler form comprising a body of felt compressed * * * and saturated by a water soluble stiffening agent (starch) maintaining it in compressed condition," designed to be used as a filling beneath embroidery-threads, *Held* devoid of invention, it appearing that starched felt was old

and that it was old to use other filling material beneath embroidery-threads and the evidence showing that the capacity claimed for the felt in this situation—namely, its expansibility after being freed of starch during washing and so maintaining the “plumpness” of the embroidery—did not exist in any useful degree.

2. SAME—SAME—CHANGE OF MATERIAL—UTILIZING KNOWN CAPACITY OF SUBSTITUTED MATERIAL.

The use of starched compressed felt, which was old, for a filler-form to be placed beneath embroidery-threads, claimed by the patentee to have the capacity of expanding after being freed of the starch during washing, *Held* devoid of invention as involving only a substitution of an old material for material formerly used for the same purpose, the capacity of the material to so expand being only trifling and having been long known.

Before ROGERS, HOUGH, and MANTON, Circuit Judges.

STATEMENT OF THE CASE.

Appeal from decree of District Court for the Southern District of New York dismissing bill in equity for infringement of all the claims of Patent No. 1,294,560, issued February 18, 1919, for a “filler-form for embroidery.”

Claim 6 is typical, and is as follows:

A filler form comprising a body of felt compressed beyond its normal density and saturated by a water soluble stiffening agent maintaining it in compressed condition, whereby said body is adapted to expand to its normal dimensions when said stiffening agent is washed out.

Mr. S. Mortimer Ward for plaintiff-appellant.

Mr. Thomas Ewing for defendants-appellees.

HOUGH, *Cir. J.*:

To the end that embroidery may stand out from the embroidered fabric more prominently than it will or can through or by the thickness of the thread or filament applied, it has long been customary to “fill” the embroidery, *i. e.* to stuff out the figure which is the ornamentation by covering the stuffing with the silk, cotton or other threads used by the embroiderer.

It is easier to do this if the stuffing or filling is preconstructed in the shape or outline of the intended ornament of embroidery; and this construction was generically old.

The patentee’s desired result, as specified, was to produce a—
filler-form * * * which will * * * give to the finished embroidery the desirable well rounded contour (and) * * * will expand * * * so as to take up any looseness in the embroidery stitches, and permit of the finished embroidery being washed an indefinite number of times without injury.

The quoted claim, even without evidence as found in the record, sufficiently shows that the patentee’s means consist in cutting figures (usually letters of the alphabet) out of starched felt.

Considering the admitted antiquity of filled embroidery and of felt stiffened in many ways including starch, the field left for invention was indeed narrow; and plaintiffs can and do contend only that their use of felt solubly stiffened is so remotely analogous to any former use thereof—that (being productive of a new result), it sufficiently evidences exercise of inventive faculty, within *Potts v. Creager* (C. D., 1895, 143; 70 O. G., 494; 155 U. S., at 608.)

But the field of invention was further and especially narrowed by a prior patent (No. 1,063,734) for a filler-form—

comprising united one or more layers of textile fabric, and one or more layers of material (giving) shape retaining qualities or firmness, * * * for example * * * *unwoven fibrous material*, digested wood pulp, or other forms of cellulose, compressed.

That this included compressed felt is undeniable.

Consequently the patent stands or falls on the expansible or “plumping” capacity of felt when freed of starch. On this point we hold on the evidence, and as matter of fact, that no such capacity is shown to exist in any useful degree. We are further of opinion that such trifling expansibility being a long-known function of felt, its use for embroidery filling amounts (at the most) to no more than a change of material for attempting the more perfect accomplishment of the same work—which is not patentable. (*Potts v. Creager, supra.*)

While as above intimated, we are not persuaded that there is by plaintiff's means any “more perfect accomplishment,” this case is entirely within the principle of our decisions in *Ambursen, &c., Co. v. Hydraulic, & Co.*, (211 Fed. Rep., 982,) and *New York, &c., Co. v. Sierer*, (158 Fed. Rep., 819;) while *Marconi, &c., Co. v. De Forest, &c., Co.*, (243 Fed. Rep., at 564,) illustrates a case where there was a new use or application and a wholly new result.

Decree affirmed with costs.

[U. S. Circuit Court of Appeals—Third Circuit.]

VANDENBURGH V. ELECTRIC WELDING CO.

Decided February 19, 1920. Rehearing denied March 29, 1920.

275 O. G., 423; 236 Fed. Rep., 95.

1. PATENTS—PATENT FOR REINFORCING-BAR HELD LIMITED AND NOT INFRINGED.

The Vandenburg patent, No. 841,741, for a reinforcing-bar for use in concrete work, *Held* limited by the prior art to a bar with kerfs or cuts in which the attached coil is placed and a tongue or spur overlapping the kerf and holding the coil in place, and, as so limited, not infringed.

2. SAME—REISSUE PATENT FOR REINFORCING-BAR HELD INVALID AS NOT WARRANTED BY ORIGINAL PATENT.

Claims 1 and 2 of the Vandenburg reissue patent, No. 14,182, for reinforcing-bars for use in concrete work, *Held* invalid, as not warranted by the original patent.

APPEAL from the District Court of the United States for the Western District of Pennsylvania; Charles P. Orr, judge.

Suit by George E. Vandenburg against the Electric Welding Company. *From a decree dismissing the bill, plaintiff appeals. Affirmed.*

Mr. Carlos P. Griffin for the appellant.

Mr. Frederick W. Winter for appellee.

Before BUFFINGTON and WOOLEY, Circuit Judges, and MORRIS, District Judge.

BUFFINGTON, *Cir. J.*:

On January 22, 1907, there was issued to George E. Vandenburg, Patent No. 841,741, for a reinforcing-bar. On August 15, 1916, a reissue of said patent was granted, No. 14,182. This reissue made no change from the original, either in the specification, in the figures, or in claim 3, here in issue; but claims 1 and 2, here in issue, are new. Vandenburg having charged the Electric Welding Company with infringing said three claims of the reissue, and the court below having, on final hearing, held the claims invalid and dismissed the bill, Vandenburg took this appeal.

1. After argument and due consideration, we are of opinion the court below made no error in dismissing the bill. The grounds of our conclusion we now record:

The combination device, which Vandenburg disclosed in his specification, was a particular type of attachment of coils and reinforcing-bars in concrete work. Both coils of wire and reinforcing-bars to which such coils were attached were prior devices in use in that art. Taking these two familiar devices of coil and bar, Vandenburg disclosed a new way of attaching the coil and bar for use in the concrete-reinforcing art, to wit, by the use of kerf or cut in the side of the bar in which the coil was placed, and a tongue or spur overlapping the kerf, which spur, when bent down, served to hold the coil in place. This seating of the bar in the kerf cut and keeping it in place by the overlapping spur or tongue, Vandenburg set forth in his specification as follows:

As a preferred means of securing the coils to the bar I have shown a series of kerfs 8 in *one face of the bar* inclined away from the center of the bar toward the opposite ends thereof, and the coils are seated within these kerfs and *held therein* by means of the integral spurs 9, *which are forced downward upon the coils when inserted and permanently retain them in position—*

and embodied in his third claim as follows:

A reinforcing bar provided upon *one end* with a series of kerfs, each having an integral overlapping spur, and a coil disposed in said kerfs; each convolution thereof being retained beneath one of said spurs.

Now, while a kerf or cut in the edge of a bar was a common mechanical expedient, no one had used it in concrete reinforcement until Vandenburg disclosed his device. But, other than a combination using a kerf, Vandenburg disclosed nothing new in his specification. Finding his kerfed combination novel, regarding it as useful, and assuming for present purposes, as we will, that it embodied invention, there is no reason for regarding it as other than a narrow contribution to the art of a specific type of coil and bar attachment. In the nine years between its grant and the filing of this bill, Vandenburg's patent made no impress in the art, and we give the patentee the full measure of his disclosure and the protection of his claim by limiting his field of monopoly to a reinforcing-bar with a kerf and an integral overlapping spur, as embodied in his third claim.

Thus limited, such claim is not infringed by the defendant's structure. It has coils, which, as we have seen, are old; it has a reinforcing-bar, which is also old; and the two are attached, but the crux is: How are they attached? Are they attached by a kerf cut? Mere attachment of bar and coil were old, and Vandenburg's advance consisted, not in bar and coil attachment generally, but in the kerf and spur attachment. This form of attachment being the gist of Vandenburg's patent, it must be the test of defendant's infringement, or, in other words, does the defendant use the kerf and spur attachment of Vandenburg's claim? In our judgment, it does not. The kerf of the claim is upon one end, which can only mean one edge of the reinforcing-bar, which end or edge cut is the only form of bar and kerf cut disclosed by Vandenburg, and his bar is a flat bar, and the kerfs are cut diagonally into the edge of such flat bar. On the other hand, the bar of the defendant's device consists of a channel-bar and there is no cut of any kind in the end or edge of either of the channel sides. On the contrary, attachment in defendant's bar is made by using the back body of the central bar of the channel and stamping a tongue out of said solid central back portion, and then winding such tongue over the coil, which does not rest in the body of the bar but outside of it.

It will thus be seen the defendant's coil is not restrained by the body of the bar, or by the sides of any cut in the body of the bar, but is restrained wholly by the tongue, which surrounds and holds the coil. In Vandenburg's structure, the tongue or spur simply holds the coil in the kerf recess, and it is the cut sides of the kerf which hold the coil in place. If Vandenburg's spur or tongue broke,

the kerf sides would still have a coil-restraining function. But in defendant's device the sides of the cut in the body structure do not restrain or hold the coil; that is the function of the stamped cut, coil-encircling tongue. If defendant's tongue broke, there would be absolutely no coil and bar attachment or restraint, for the cut in the bar has no functional purpose whatever, save to create a tongue, and the attaching, functional agency of defendant's tongue would be the same if no cut in the reinforcing bar were made but the tongue was made by riveting it on the reinforcing-bar. For these reasons we are clear defendant's structure does not infringe the third claim.

2. Seeing, then, that the kerf and overlapping spur in combination constituted the real invention of Vandemburgh, and that he disclosed no other form of attachment, it is quite evident he was not entitled to broad claims of the generic type, which he secured on the reissue in claims 1 and 2. Kerf and overlapping spurs are not embodied in these claims, and it is manifest that these claims, unrestricted by the limitation of kerf and spur, were only added nine years after his patent was granted, to make infringers of those who used other forms of attachment than the kerf and overlapping spur, which alone Vandemburgh disclosed, and which were the sole warrant for the grant of his patent.

Such being the case, it is clear the court below was not in error in dismissing the bill.

[U. S. Circuit Court of Appeals—Second Circuit.]

BELLOWS AND SLACK v. THE NEW YORK CENTRAL RAILROAD COMPANY.

Decided May 13, 1920.

275 O. G., 827; 286 Fed. Rep., 530.

1. PATENTS—PATENTABILITY—SUBSTITUTION OF STEEL FOR WOODEN CAR-SILL NOT INVENTION.

"The idea of making a car sill of rolled steel straight channel bars which could be purchased in the open market was not the subject of patentable invention."

2. SAME—SAME—REINFORCING METAL CAR-SILLS—WOODEN SILLS.

Where it was old to reinforce wooden car-sills by the employment of a reinforcing member extending along the sill between bolsters and to reinforce metal car-sills of the fish-belly type and also to reinforce straight metal channel-bars in other arts, it involved no invention to substitute a straight rolled-steel channel-bar for the wooden sill and reinforce it in an analogous way.

3. SAME—SAME—PATENTS INVALID FOR LACK OF INVENTION.

The Bellows Patent No. 762,790, claims 1, 7, and 10 to 17, and the Bellows Patent No. 762,858, claims 1 to 9, for metal car-sills, *Held* invalid, being devoid of invention in view of the prior art.

APPEAL from the District Court for the Southern District of New York. Actions by Arthur B. Bellows and Louis M. Slack and the Cambria Steel Company, plaintiffs, against The New York Central Railroad Company, defendant, for infringement of Letters Patent Nos. 762,858 and 762,796. *Decrees for defendant. Plaintiffs, Arthur B. Bellows and Louis M. Slack, appeal.*

Mr. George H. Parmelee and Mr. Clarence P. Byrnes for the appellants.

Mr. Robert J. Fisher for the appellee.

Before WARD, ROGERS, and MANTON, Circuit Judges.

MANTON, *Cir. J.*:

The patents were issued on June 14, 1904, to the appellant Bellows, for car-sills. Thereafter, the Cambria Steel Company became the exclusive licensee under this patent. A provision of this license agreement provided that it was the understanding of the parties that if the patents were declared invalid or found to infringe patents to others, the Cambria Steel Company would have the right to surrender the agreement and would not thereafter be obligated to pay royalties under it. After the decision of the district court, the Cambria Steel Company refused to further be bound and discontinued payment of royalties pursuant to the terms of this agreement. There has been a severance of parties granted and this appeal is prosecuted without the Cambria Steel Company or its aid. The patents relate to railroad freight-cars and particularly freight-cars having flat bottoms, such as flat-cars and gondola cars as distinguished from hopper-cars, where there is no flat floor. The patent relates to the sills supporting underframes of the cars on which the body is mounted. They are the supporting longitudinal sills, and especially the center sill which forms the backbone of the car running lengthwise of the car-frame from end to end. These are connected with the center and side sills by body-bolsters. The claims involved in Patent No. 762,796 are 1, 7, 10, 11, 12, 13, 14, 15, 16 and 17; and claims 1 to 9 inclusive of Patent No. 762,858. The suggestion of counsel is that the following language covers each:

A car sill consisting of a channel reinforced by an angle bar or other flanged shape secured to it at any point below its top and between the body bolsters, and in some instances extending below the bottom of the channel.

A car sill composed of one or more channel girders each of which has a reinforcing angle bar secured to it at a point between the bolsters and not projecting either above or below the flanges of the channels making up the sills.

The need for steel sills came at a period of the transition from wood to steel cars. The problem, if there was one involved, was to avoid the fish-belly-shaped sills and arrange for a proper distribu-

tion of the strains and stresses. It involved having due regard for the buffing-strains and the economical manufacture of the sills. The inventor in his specifications states that—

heretofore in order to obtain the necessary strength at the central portion of car-sills the webs of these sills have been commonly-formed of gradually-increasing depth from the ends toward the center. The making of these sills, whether formed of pressed steel shapes or of a sheet with angles riveted along its edges, has been an expensive operation and necessitated the use of special and expensive machinery. My invention obviates this difficulty; and it consists in securing along the central part of the sill a separate longitudinal strengthening member, this member adding the necessary strength at the desired point.

The transition period between the wooden and steel cars and the making of necessary repairs in used cars brought out many types of sills and reinforced channels used as sills. This record is top-heavy with instances of the inventor's idea of reinforcing structural steel beams used as supporting-sills for freight-cars and other load-carrying appliances. Indeed, it has been the subject of grant of several patents which have been offered as part of the prior art. The reinforcing angle and other bars have long been secured along the lower edge of roll channel-beams in various structures, including cars and their parts as well as the framework of buildings and bridges. Straight channel-sills of pressed steel were rolled, as were straight sills of channel form built up from plates and angle-bars. Steel fish-belly sills of channel form, each of which was provided with a reinforcing-angle secured along its lower edge, were used in 1900 and 1901 on railroads and manufactured by the Pressed Steel Car Company. In some instances, this angle was flush with the bottom of the sill and in others extended beyond the bottom of the sill. This prior use illustrates the reinforcing of sills. To be sure, they were of the fish-belly shape as distinguished from the Bellows straight sill or roll shape reinforced, but drop-bottom gondola cars were built for the Louisville & Nashville Railroad and used by it as early as 1895. In its cars, there was bolted to the sills of the cars, which were of wooden timbers along its lower inner edge, a smaller reinforcing-timber which was flush with the bottom of the sill and extended from bolster to bolster, the ends of the reinforce-beams being notched or gained so as to rest upon the upper surface of the bolster. But straight steel beams used for carrying loads and for meeting stresses and strains of heavy loads were old in the arts. In the ship-building art, as appears in the British patent to Withy and Siveright, No. 14,885, granted in 1886, and to Stuart, granted June 3, 1890, girders in the form of channels were both built up and integral, which were provided with angle reinforcements at the point of stress.

In the building art, straight channels were reinforced at the point of stress by reinforcing-plates.

We think that it did not constitute invention to make and reinforce straight channels and use them as sills. It was an obvious expedient to take care of stresses and strains. The idea of making a car-sill from rolled material which was for years made and could be purchased in the open market, was not the subject of patentable invention. The reinforcing of the car-sill was long before anticipated. The publication which was offered in evidence, of the Master Car-Builders' Association, antedated the time of conception of this invention. What the inventor did was to apply to the steel sill a reinforcement analogous to that which had been applied to wooden cars. We think that the claim of advantages of greater strength in appellants' construction over that of the fish-belly-shaped sills, was fully met by the proof that fish-belly sills have not been supplanted by straight sills and are in very extensive use and, even in this day, may be found as a prevailing type. What advance was made by the appellant Bellows was simply an outgrowth of mechanical construction required for the transition period from wooden to pressed-steel cars in the matter of rearrangement and readjustment of the many parts necessary for the building of the car. We find nothing of an inventive character in what he accomplished. It was never the object of the patent laws to grant a monopoly upon an idea which would naturally occur to a mechanic in the ordinary progress of manufacture. (*Atlantic Works v. Brady*, C. D., 1883, 214; 23 O. G., 1330; 107 U. S., 192.) It was held not patentable to place a strip of steel upon a horizontal leather part of a shank-strip for the purpose of stiffening it. (*Crouch v. Roemer*, C. D., 1881, 202; 19 O. G., 1067; 103 U. S., 797.) And it was no invention to place a stiffening-rib upon the under surface of a grate-bar. (*Parsons Mfg. Co. v. Coe*, 185 Fed. Rep., 522.) Nor was it patentable to reinforce a plowshare by a patch of soft metal welded into the inner face. (*Moline Plow Co. v. Omaha Co.*, 235 Fed. Rep., 519.)

Invention in reinforcement is to be found only in discovering a new principle or employing new means for embodying the old principle. (*Turner v. Lauter Piano Co.*, 248 Fed. Rep., 930.)

We agree with the district judge that any reinforcing of the steel sills would occur to the lay mind, not to speak of the skilled mechanic. *In view of the prior art and publications as disclosed by this record, we are satisfied that no invention is disclosed in appellants' idea of metal sills.*

The decrees are affirmed.

[U. S. Circuit Court of Appeals—Seventh Circuit.]

MINNEAPOLIS KNITTING WORKS *v.* MARSHALL FIELD & Co.*Decided January 6, 1920.*

276 O. G., 598; 263 Fed. Rep., 987.

PATENTS—INVENTION—ADAPTATION OF IMPROVEMENT IN CHILD'S WAIST TO INFANT'S BAND.

The adaptation of the inelastic reinforcing-tape with tabs of a child's knitted waist, to which buttons are sewed for the purpose of supporting lower garments, to an infant's band designed to support the napkin, the lower garment appropriate to the infant. *Held* devoid of invention. The Owenshire patent, No. 800,237, *Held* void.

APPEAL from the District Court of the United States for the Eastern Division of the Northern District of Illinois.

Suit in equity by the Minneapolis Knitting Works against Marshall Field & Co. *Decree for defendant, and complainant appeals. Affirmed.*

Mr. Frank Parker Davis for the appellant.

Mr. George L. Wilkinson for the appellee.

Before BAKER, MACK, and PAGE, Circuit Judges.

MACK, *Cir. J.*:

This appeal is from a decree dismissing for want of equity, the bill to enjoin infringement of claim 2 of Letters Patent No. 800,237 for improvement in infants' bands or shirts. The decree finds the claim valid, but not infringed.

The claim reads as follows:

A band or shirt comprising a tubular body of elastic knitted fabric provided with shoulder pieces or straps 3 and inelastic strips or tapes 4 extending over said shoulder pieces and diagonally downward over the front and rear of the body to central points near the bottom thereof, and suitable tabs secured at the lower ends of said tapes.

The Letters Patent were issued September 26, 1905, on application filed January 23, 1905. Contemporaneously there were issued Letters Patent No. 800,618 applied for by the same inventor on April 24, 1905. Claim 1 of the patent in suit was introduced into the application therefor by amendment, after its rejection as a claim in the other application, and after the allowance of claim 2 now in suit. They differ only in one respect: that the band or shirt in claim 1 is not limited to a tubular body. In the course of the second application, the claims of which had originally been rejected as not being patentable over the other allowed application, counsel for the applicant stated that—

the novelty of the claims in both cases is not included in the description of the opening in the front of the garment or its omission. The inelastic strips or

tapes and the tabs secured to the lower ends of the tapes constitute the novel features of the claim.

The object of the invention in suit, as specified, is to provide an elastic tubular band or garment having means for securing a napkin (diaper) thereto; the inventor, however, expressly states that while he has—

described the invention as applied to an infant's band or shirt, it may, of course, be applied to a shirt designed for use of adults.

The specifications describe the invention consisting of—

generally in a band or shirt having a tubular body of elastic knitted fabric with inelastic tapes or strips extending over the shoulder pieces thereof and extending diagonally downward on the front and back to central points near the bottom of the garment and with inelastic tabs secured to the lower ends of said tapes.

While defendant was notified in 1911 of a claim of infringement of both patents, suit was not commenced until 1917. Though plaintiff may not thereby be chargeable with laches, testimony of defendants' disinterested witnesses, based on memory, should not be deemed untrustworthy, when, in the interim, their old corporate books of account were destroyed as no longer of any perceptible value. Despite some discrepancies in the testimony, we are satisfied that the Fogarty waist was made and sold publicly more than two years prior to the application for the patent in suit, and that, except for the fact that it was a shirt, and not an infant's band, it completely anticipates the alleged invention.

In our judgment there is no invention whatsoever in the adaptation of the inelastic reinforcing-tape with tabs of a knitted child's waist, to which buttons are sewed for the purpose of supporting lower garments, whether that waist be open front or back, or tubular, to the infant's band designed to support the napkin, the lower garment appropriate to the infant. If this were otherwise not clear, it would be apparent from the specifications of the patent in suit, according to which the invention is "of course" applicable to a shirt designed for the use of adults, and therefore necessarily designed for supporting the usual undergarments worn by adults.

While it becomes unnecessary to consider the question of infringement, we do not intend, by affirming the decree dismissing the bill for want of equity, to assent to the finding that defendant could escape the charge of infringement merely by the substitution of an elastic tape so attached as to be decidedly less elastic than the knitted body, or by forming the tab out of a continuation of the tape, instead of by attaching a separate piece of tape.

Decree affirmed.

[U. S. Circuit Court of Appeals—Second Circuit.]

**BELLOWS AND SLACK v. NEW YORK CENTRAL RAILROAD COMPANY.
SAME v. PRESSED STEEL CAR COMPANY.***Decided May 13, 1920.*

277 O. G., 585; 266 Fed. Rep., 532.

**1. PATENTS—APPEAL—RIGHT OF HOLDER OF LEGAL TITLE TO PROSECUTE APPEAL
INDEPENDENT OF EXCLUSIVE LICENSEE.**

Where suit was brought by the legal owner of a patent, joined with an exclusive licensee holding a license containing a provision that if the patent should be held invalid or should be held to infringe other patents the licensee should have the right to surrender the agreement and should not thereafter be obliged to pay royalties, and the district court held the patent invalid, upon refusal of the licensee to appeal the legal owners have sufficient interest in maintaining the validity of the patents to entitle them to prosecute an appeal, although the patent had expired and no injunction could be granted.

**2. SAME—PATENTABILITY—USE IN NEW DEVICE OF CONSTRUCTION PREVIOUSLY
USED IN REPAIR JOBS.**

Where in the use of steel cars having longitudinal sills it was found that the sill was often broken between the end of the car and the body-bolster by reason of collision or buffing and it was the practice to repair such breaks by removing the end of the sill beyond the break and splicing an end section to the main body of the sill, claims of the Bellows patent, No. 693,218, covering a car provided with a sill with a sectional end spliced to the body at a point between the body-bolster and the end, *Held* invalid because devoid of invention, as it involves only the idea of using for new cars a construction theretofore used in repair jobs. (*National Harrow Co. v. Quick*, C. D., 1896, 501; 76 O. G., 1574; 74 Fed. Rep., 236.)

3. SAME—NOVELTY—STEEL CAR.

The Bellows patent, No. 693,218, for a steel car, claims 2 and 3 *Held* void in view of prior uses.

APPEAL from the District Court for the Southern District of New York. Action by Arthur B. Bellows and Louis M. Slack and the Cambria Steel Company, plaintiffs, against the New York Central Railroad Company, defendant, and the same plaintiffs against the Pressed Steel Car Company, defendant, for infringement of Letters Patent No. 693,218.

Decrees for defendants. Plaintiffs, Arthur B. Bellows and Louis M. Slack, appeal.

Mr. George H. Parmelee and Mr. Clarence P. Byrnes for the appellants.

Mr. Alfred W. Kiddle and Mr. Wylie C. Margeson for the appellees.

Before WARD, ROGERS, and MANTON, Circuit Judges.

MANTON, *Cir J.*:

These actions were heard as one and will be treated in one opinion.

When the actions were tried in the district court, the Cambria Steel Company, an exclusive licensee of the appellants, joined in the action. The claims were held invalid in the district court and the Cambria Steel Company refused to prosecute an appeal. Its license agreement, dated February 21, 1900, contained the following clause:

This agreement is based upon the understanding that the patents of the parties of the first part are valid, and if any of them shall be invalid or shall infringe patents to others, the party of the second part shall have the right to surrender this agreement and shall not thereafter be obliged to pay royalties under it.

Prior to making this agreement, the Cambria Steel Company was not engaged in the business of making structural-steel cars but became engaged in such manufacture thereafter. Under the license agreement, they agreed to pay the appellants five dollars per car and did so up to the date of the decree below. Many cars were built and a considerable sum was paid as royalties. When the Cambria Steel Company refused to further pay royalties or to prosecute this appeal, a motion for a severance of parties was granted and thereafter the individual plaintiffs prosecuted the appeal. A motion was thereafter made to dismiss this appeal. It was denied. At the time of such denial, it was determined to hear the merits of the appeal when we might reconsider the motion to dismiss. The license to the Cambria Steel Company appears to be a right to make and sell the cars, using the construction which, the appellants contend, is covered by their patent. It was not an assignment. (*Waterman v. Mackenzie*, 138 U. S., 252.) The Cambria Steel Company could not sue in its own name alone, and Bellows and Slack were made parties. We are satisfied that the appellants have an interest in maintaining the validity of the patents. The patent has expired and no injunction can be granted. The infringement alleged at bar is in reference to the car made by the manufacturer and used by the railroad company in 1910. Notice of infringement was not given until 1915. However, we shall pass upon the merits of the case rather than dismissing the appeal, as urged by the appellee.

The patent in suit relates to a sill which has been referred to as a "spliced sill" used in the manufacture of the underframe which supports the car-body of freight-cars. Frames of this and like character were made of wooden beams and planking prior to 1898. Then the steel car made its appearance. Steel plates and sheets were pressed by highly-draulic presses into different shapes and replaced wooden parts in the wooden cars. Among the parts wherein steel replaced wood were the lateral sills which not only supported the load, but were obliged to meet the buffing-blows and collisions which are of every day occurrence in the life of a freight-car.

On the 11th of February, 1902, the patent here considered was granted to Bellows. Later, the appellant Slack obtained an interest in the patent by assignment. Claims 2 and 3 of the thirteen claims of the patent are in suit and are as follows:

2. A car having a longitudinal sill with a sectional end spliced to the body of the sill at a point between the body-bolster and its end; substantially as described.

3. A car having at the side a plate-girder with an end portion detachably fixed to the body of the plate-girder at a point between the body-bolster and the end; substantially as described.

In his specifications, the inventor says:

The center sill and plate-girders are preferably made sectional—that is to say, divided at each end at a point between the body-bolster and the end of the car—and spliced, as at B, the splicing, which is sufficiently illustrated in Fig. 3 being effected by suitable flanged sections and rivets. The object is that in case the car should be injured at the end by collision the damaged end sections of the sill and plate girders may be detached and replaced with relatively small cost as compared with cutting out and replacing the entire sill, as in prior car constructions, or replacing the entire plate-girders. Within the scope of my broader claims I may, however, make the sill or the plate-girders, or both, continuous throughout their length. For economy of construction I preferably form plate-girders of less depth from the body-bolster outwardly than between the body-bolster, as shown at 12 in Fig. 1.

The act of infringement relied upon by the appellants was the sale of a car on July 26, 1910, by the Pressed Steel Car Company and the use of said car by the New York Central Railroad Company. Reading the patent, taken in conjunction with the testimony of the inventor, it is clear to us that the invention relates to making longitudinal sills of cars in sections and splicing end portions or sectional ends of the central portion of the sills at a point between the body-bolster and the end of the car, the object or purpose being to easily repair the end sections of the sill if damage should occur by reason of collision or buffing, the thought being that the repair would be less costly and, instead of the entire sill crumbling or bending, which might result in the loss of the entire structure, the greater part of the car could be spared damage by the injury being confined to the sectional end, due to the splicing of the sills at a point between the body-bolster and the end of the car. The splicing of the sills referred to at a point between the body-bolster and the end does not confine the construction to original construction, but may involve the repair of a section of the car which may have been damaged by collision. The longitudinal sill referred to in claim 2 is not limited to any particular character of sill. It may be composed of metal beams and of suitable section as the specification reads. It comprehends any kind of a sill, whether it be wood or metal or a composite of wood and metal. The plate-girder referred to in claim 3 (which is

referred to in the specifications as metal in the side sills) is used in the side sills, as it is referred to in the specifications as—

metal plates having one or more flanged metal pieces at the top and bottom edge.

Thus, the inventor utilized web-plates with a reinforcing-angle on the top to form the top chord and a reinforcing-angle on the bottom forming the bottom chord. We are satisfied that these plate-girder sides, when used in gondola or flat cars, are cargo-carrying members intended to carry part of the load and in turn, to transmit the same to the body-bolster. The plate-girder extending between the body-bolster and into the space between the body-bolster and the end of the car, is the body or web of the plate-girder and it is to this that the end portion or sectional end is to be spliced by flanged sections and rivets. The manner of uniting the central and end portions is by a butt-splice. The webs of the central and end portions abut each other and are spliced together by means of splice-plates. In the construction of these cars by the Cambria Steel Company, using this sectional sill, the lower angle or chord is continuous from end to end of the car. It is by thus splicing that the inventor is able to—

remove and replace without necessarily removing the car from the track or even unloading the car.

Whether this is done, as claimed by the inventor, must necessarily depend upon the force of the collisions and damage done. It is contended by the appellant that it requires the features of the two claims to make up the total of Bellows's invention of the detachable underframe end, but we fail to find any combination of the features of the two claims together referred to in the patent. It is not referred to as a "detachable underframe end" nor does the patent require the splice to be adjacent to the body-bolster. This is not found in the claims in suit. We agree with the district court that the claims refer to details of construction.

On examining the prior art and prior uses in this structural-sill art, we are not convinced that the appellant Bellows was the first to make a successful structural-sill car. Hardie and Reese built a car with structural-steel shapes long prior to Bellows's period. The Lehigh Valley tender-underframe, which has been offered in evidence, shows the method of splicing these underframes by the splicing of center sills. The proofs establish that for many years prior to the inventor's date of conception, the Lehigh Valley Railroad Company had followed the practice of splicing center sills of damaged locomotive-tender underframes. Center sills and side sills were of rolled channels, the lightest of them being about six inches in depth and some were twelve inches in height. Any experience which this railroad company had and in which the injury was sus-

tained by collision, it was found that it resulted principally in bending or breaking the center sills between the body-bolster and the end sills and its spliced center sills, comprised of rolled channel, and extended through the bolster at each end of the car and had sectional ends spliced thereto at a point between the bolster and the end sills. The drawings which were offered in evidence clearly show the cars having true body-bolsters. Nor can it be said that this is not an apt case of inception, because the construction as used by the Lehigh Valley Railroad Company was in connection with a tender. It is true that the inventor here entitles his patent a steel car, but when examined as to claims and specifications, it is found that the invention has to do with the sills used in car construction. The appellants are, therefore, confronted with the rule so long established and time-honored: That which infringes, if later, would anticipate if earlier. (*Peters v. Active Mfg. Co.*, 129 U. S., 530; *Knapp v. Morse*, C. D., 1893, 651; 65 O. G., 1593; 150 U. S., 221.) Applying an old contrivance in a new way, if such it be, to this analogous subject of constructing the underframe of a car without any novelty in the mode of applying the old construction to the new purpose, is not a valid subject-matter of patentable invention. The idea that using the construction theretofore used in repair jobs for new cars is not invention. (*National Harrow Co., v. Quick*, C. D., 1896, 501; 76 O. G., 1574; 74 Fed. Rep., 236.)

It also appears from the testimony that there were 2,000 Baltimore & Ohio cars made embodying center sills having sectional ends spliced thereto at a point between the body-bolster and the end of the cars—precisely the construction contended for in claim 2 of the patent in suit, and part of which were delivered on December 20, 1899. Some of these cars went into service before the date of this application. We think the construction of these cars anticipates appellants' invention. An examination of the drawings of the so-called Erie cars, contract for which construction was made August 2, 1899, and, as appears from a tracing dated December 11, 1899, shows the central or longitudinal sill with a sectional end spliced to the body of the sill at a point between the bolster and its end. The first car was delivered February 25, 1900, and the last car shipped May 19, 1900. In view of this construction, we can not escape the conclusion that the idea of splicing was originated by Mr. Hanson. He supervised the construction at the Pressed Steel Car Company's plant. In the latter part of 1896 and the early part of 1897, one Hardie of Pittsburgh designed a steel hopper-car for the Pittsburgh & Lake Erie Railroad. The drawings, which were completed January 22, 1897, and under which a large number of cars were built by the Schoen Pressed Steel Company, provided for a plate-girder

side with an end portion detachably fixed to the body of the plate-girder by spliced plates running forward and back of the bolster. It is immaterial that the lower angle of this car is continuous from end to end for the reason that in the appellants' structure, as indicated in the patent in suit, the lower chord or angle 9 of the plate-girder side, projects beyond the bolster for the purpose of being utilized as one of the splicing members. This is what was done in the Hardie car. The sectional end of the Hardie car is just as detachably fixed to the plate-girder side as a sectional end or end portion of the appellants' car. The Hardie car discloses the use of the plate-girder side as a load-carrying member with a sectional end spliced thereto, and this construction will permit the sectional end or end portion of the plate-girder side to be replaced in a damaged car just as readily as in appellants' car by removing the rivets at the head of the bolster, uniting the section end with the gusset-plate and either straightening or cutting off the lower angle. This sectional end may be repaired. We think that construing claim 3, either broadly or reading it literally and limiting it to a construction in which the web of the plate-girder side extends beyond the bolster into the space between the bolster and the end of the car to which extended web a sectional end is spliced, or the splicing of the sectional end in front of or at or back of the bolster, the result is the same—the Hardie car is a complete anticipation. In addition thereto, it is clear that the Reese car, the drawings of which were made in the spring of 1897, which was placed in service on June 28, 1897, with the Pittsburgh & Lake Erie Railroad and which has been constantly in use since, anticipates the patent in suit. In these cars, the load was carried by the plate-girder side, the center sills being utilized for the attachment of draft-rigging and for the transmission of pulling and buffing strains. The sectional end of the plate-girder side in this car can be replaced just as readily as in appellants' car. It would only be necessary to remove the rivets passing through the upper angle, the web, and the lower angle of the sectional end. The fact that this freight-car has been in constant use since that date is sufficient answer to the claim of commercial failure. Indeed, the subject of splicing ends of the car was considered in the proceedings of the Master Car-Builders' Association in 1897. This method of construction of underframe was advocated by Mr. Barr and, we think, he clearly sets forth the extension of the longitudinal sills into the space between the bolster and the end sill, and that to these extending ends of the lateral sills there could be secured section ends to bridge the space between the lateral sills and the end sills so that in ordinary cases of damage, repairs could be made without disturbing the general frame. It may be

that Bellows has improved on Barr's idea, but the mere fact that the new method of construction is a better one than the old, requiring perhaps less repair and having greater strength than the old one, does not alter the rule that it is not invention to produce a mere change in an instrument or machine of one material into another. (*Hicks v. Kelsey*, 5 O. G., 94; 18 Wall., 670.)

We conclude that the splicing of the sills between the bolster and the end of the car was not new and that the appellants' patent has been anticipated by uses in the prior art.

The decrees are affirmed.

[U. S. Circuit Court of Appeals—Second Circuit.]

IMPERIAL MACHINE & FOUNDRY CORPORATION v. G. S. BLAKESLEE & Co.

Decided December 10, 1919.

277 O. G., 979; 262 Fed. Rep., 419.

1. PATENTS—INFRINGEMENT—EQUIVALENTS.

Claims of the Robinson patent, No. 809,582, for a vegetable-peeling machine, including a rotary disk having a horizontal striated portion, *Held* infringed by a peeling-machine having an abrading-disk of concrete or cement, the latter being considered as having striations set irregularly.

2. SAME—SAME—PRELIMINARY INJUNCTION.

While an application for preliminary injunction in a suit for infringement is addressed to the discretion of the court, where the validity of the patent has been sustained by many prior adjudications and infringement is clear its refusal would be error.

APPEAL from the District Court of the United States for the Southern District of New York.

Suit by the Imperial Machine & Foundry Corporation against G. S. Blakeslee & Co. *From an order granting a preliminary injunction, defendant appeals. Affirmed.*

Mr. A. H. Adams, Mr. J. L. Jackson, and Mr. J. J. Kennedy for the appellant.

Mr. A. Alexander Thomas for the appellee.

Before ROGERS, HOUGH, and MANTON, Circuit Judges.

MANTON, *Cir. J.*:

The appellee sued for an infringement of claims 1, 2, 3, and 4 of the Robinson patent, No. 809,582, for improvements on machines for peeling vegetables. A preliminary injunction was granted and the appellant appeals.

The patent has been held valid and infringed in previous litigations. (*Imperial Machine Co. v. Jacobus*, D. C., 212 Fed. Rep., 958,

Judge Lacombe granted a preliminary injunction; *Imperial Machine Co. v. Streeter & Co.*, D. C., 214 Fed. Rep., 985, Judge Hazel; *Imperial Machine Co. v. Smith & McNell*, 262 Fed. Rep., 419, Judge Hough, filed February, 1914; *Imperial Machine Co. v. Reinhold Mfg. Co.*, 262 Fed. Rep., 419, Judge Tuthill, filed July, 1919; *Imperial Machine Co. v. American Fruit Machinery Co.*, D. C., 212 Fed. Rep., 959, note, Judge McPherson; *Imperial Machine Co. v. Whyte*, 262 Fed. Rep., 419, Judge Learned Hand, filed December, 1918; *Imperial Machine Co. v. Rees et al.*, D. C., 261 Fed. Rep., 612, Judge Mayer, filed November, 1919.)

(1) However, since the validity of this patent is presented to this court for the first time, we have examined the patent and are of the opinion that it is valid. It discloses a practical machine for peeling vegetables in a deep mass. Indeed, we think it is a pioneer patent. The claims in suit are as follows:

1. In a device of the class described, an impelling and abrading member comprising a rotary disk composed of a horizontal flat striated portion and a raised portion extending from near the circumference inward and having two sides sloping down to the flat striated portion of said disk, substantially as described.

2. In a device of the class described, an impelling and abrading member comprising a rotary disk composed of a number of horizontal flat striated portions separated by raised portions at intervals extending from near the circumference inward, substantially as described.

3. In a device of the class described, an impelling and abrading member comprising a rotary disk composed of a horizontal flat striated portion and a rounded raised portion rising gradually from near the center toward the circumference, substantially as described.

4. In a device of the class described, an impelling and abrading member comprising a rotary disk composed of a horizontal flat striated portion, and a rounded raised portion bounded by two approximately radial edges extending from near the circumference inward and having a striated surface, substantially as described.

The machine of this patent consists of a cylinder, at the bottom of which is mounted a rotary disk having an abrading-surface providing for one or more rounded humps or raised portions which slope down from the circumference of the disk toward the main portion thereof. The function or purpose of the mounted or sloping humps is to produce agitation or circulation of the mass of vegetables whereby all of the vegetables are brought into contact with the abrading-disk. If it were not for the sloping humps or raised portions, the vegetables in contact with the disk would be ground away and would not have any means of agitation and circulation of the mass. The specifications point this out. They point out that, where the flat disk is used alone, there is a tendency to set up a rotary motion of the mass, wherein each individual soon settles

down to a substantially fixed position in the moving mass. This would result in a wear on certain parts of each vegetable and retard the sufficient action on other parts. This hump-shaped portion, with its abrading-surface, forces the mass forward; and this, together with the movement of the disk, faster than the mass is treated, make the raised parts act to turn over the vegetables next to the bottom, so as to bring different portions of each separate individual of the mass into contact with the different abrading-surfaces. It is in this it may be said to be a pioneer invention.

The inventor, in an affidavit, points this out and deposes that for more than thirteen years the Robinson construction has been successful, and that until this construction there was no successful vegetable-peeling machine on the market; and he declares that no machine is successful without an abrading-disk having raised portions. The appellant so constructs its machine as to have a disk with humps or raised portions with an abrading-surface.

A controversy is presented as to what is meant by a striated disk within the meaning of the claims. The appellee's disk has a carborundum surface, and the appellant's disk an abrading-surface of cement or concrete. This is said to be such a difference in construction as to negative the claim that the appellant infringes. The specification of the patent states that the abrading-surface may be made of a variety of material such as cast-iron, glass, earthenware, and the inventor says that he—

is not limited to any specific arrangement of the striations, and that a variety of methods of striation will be within the spirit of this invention.

In order to obtain efficient rubbing points or ridges, there is no need for any geometrical or symmetrical arrangement, nor is it needed to successfully do the work of peeling. It is plain that exactly the same purpose is accomplished in precisely the same way, if the points or ridges be set irregularly. This is true in the disk of both the appellee and appellant. A surface of carborundum or concrete is a striated surface.

Funk & Wagnall's *New Standard Dictionary* defines the noun "stria"—curved, crooked, and intermittent gouges, of irregular depth and width and rough definition, of a certain rock-surface, sometimes due to abrasions by icebergs. It would therefore seem that the appellant's abrading-surface comes within the appellee's claims. The appellant's disk, with its abrading-surface, has a pair of rounded humps or raised portions so arranged as to be diametrically opposite and sloping downward from the circumference of the disk to the flat abrading-surface.

We are of the opinion that the appellant's rotary disk has an impelling and abrading member in a vegetable-peeling machine,

which member is composed of a flat horizontal raised portion, and a raised portion extending from near the circumference inward and having two sides sloping down to the flat striated portion of the disk, thus coming within the reading of claim 1.

The appellant's disk is composed of a number of horizontally-flat striated portions, separated by raised portions at intervals extending from the circumference inward. The appellant's disk, as thus striated, comes within the phrase of claim 2. The appellant's has an impelling and abrading disk composed of the horizontally-flat striated or abrading portion, and has a rounded raised portion rising gradually from near the center toward the circumference, and is the kind of construction referred to in claim 3. Appellant's disk has a rounded raised portion, bounded by two approximately radial edges extending from near the circumference inward and having a striated surface, thus coming within the description of claim 4.

The defense that "striated" does not mean a concrete abrading-surface is not well founded. This disk, as constructed, has an abrading, impelling, and turning function. It permits of dealing successfully with a deep mass of vegetables. In other machines, but shallow layers could be dealt with. The result obtained here does not grind or bruise the vegetables, but confines its action to removing the thin outer layer of skin, and leaves the surface of the vegetable comparatively smooth, instead of pitted or hacked. Such advantages have not before been found in machines of this type, and this invention marks an advance in the art. In other words, the feature of the invention here is in the abrading-surface having rounded humps or raised portions to produce the necessary agitation and circulation of the vegetables, without which a machine of this character has been found not practical.

Such a result having been obtained, we are of the opinion that the inventor is entitled to a reasonable range of equivalents, and it would be well within such range to coat the disk with carborundum. When such a coating is accomplished, striations are formed, although the lines are broken and irregular. The variety of methods and striations would permit of such construction. (*National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, C. D., 1897, 739; 81 O. G., 1423; 106 Fed. Rep., 693; 45 C. C. A., 544; *Cimioti Unhairing Co. v. American Unhairing Co.*, 115 Fed. Rep., 498; 53 C. C. A., 230; *Hinman v. Visible Milker Co.*, 239 Fed. Rep., 896; 153 C. C. A., 24.)

Nor do we find in the prior art any patent which anticipates the patent in suit.

In the Buist and Schmidt patent, No. 551,526, the patentees depend upon upright wings or partitions for agitation of the mass; but it is not the same kind of agitation produced by the bumps of the patent in suit. The corrugations and abutting wings, and the

other hard points in the inside of the machine, are intended to scrape the skin off the vegetables. There is no kind of agitation which causes the vegetables to circulate to change position, and thus afford different sides to the paring or abrasive surface.

In the Jaeger patent, No. 524,420, the inventor depends upon spring-rasps fastened to radial boards and arranged in concentric circles. It may be that the inventor's disk of rasps would impart a rolling or turning movement to the vegetables; but there is nothing to cause the necessary circulation of the mass. The rolling or turning of the vegetables is not enough; there must be circulation of the vegetables, and this, so that, as each layer is peeled, the next layer is brought against the disk and the performance continued, until finally the entire mass has circulated from top to bottom. The construction of the patent in suit accomplishes this, but the Jaeger patent does not do so.

For the same reason the French patent to Harff, No. 234,435, cannot be said to anticipate the patent in suit.

In the patent to Kiepenheuer, No. 74,399, there is disclosed no abrading-disk but a contrivance of knives. A knife arrangement of this kind is expressly disclaimed in the patent in suit. It may be that it would simply cut and hack the vegetables to pieces, as claimed by the appellee. It has never been in successful operation.

We think, further, that this German patent to Kiepenheuer was intended to peel but a single layer of vegetables, as distinguished from the deep mass of vegetables. The knife-blades shown in Figure 12 in the patent are arranged and shaped differently from the sloping humps of both the appellee's and appellant's structure. The blocks extend in a circumferential direction along the edge of the disk, and slope downwardly toward and along the periphery of the disk, forming a circumferential pocket between the central and highest point of the blocks and the stationary wall. The humps of the disk of the appellee and appellant extend radially in with, and slope from, the circumference toward the center; the two sides also sloping toward the main portion of the disk. We do not think that this patent anticipated the patent in suit.

It is very significant that the appellant has copied the appellee's disk, rather than make use of the patents referred to, and which are said to constitute the art prior to the date of the patent in suit. If the appellant thinks that any of the devices or improvements or combinations are protected by any of these patents of the prior art, they may still use them, notwithstanding this patent, so that the enforcement and restraint of the injunction granted herein cannot injure them. On the other hand, the failure to enforce the injunction would deprive appellee of the benefits secured to it by this patent

(*Minn Ry. Co. v. Barnett & Record Co.*, C. D., 1919, 329; 286 O. G., 283; 257 Fed. Rep., 302; 168 C. C. A., 386.)

(2) Since the validity of the patent was sustained by many prior adjudications, it was proper for the district judge to grant the preliminary injunction. (*Edison Electric Light Co. v. Beacon Vacuum, etc., Co.*, C. C.; 54 Fed. Rep., 678.) And while it is true that the application for a preliminary injunction was addressed to the discretion of the court, still the patent was frequently sustained, and there was undoubted authority, since the infringement appeared clear. To refuse to exercise that discretion to the detriment of the patentee would have been error. (*Searchlight Horn Co. v. Sherman Clay & Co.*, 214 Fed. Rep., 99; 130 C. C. A., 575; *Weber Electric Co. v. Cutler-Hammer Mfg. Co.*, 256 Fed. Rep., 31; 167 C. C. A., 303.)

We think the order below was properly granted, and it will be affirmed.

[U. S. Circuit Court of Appeals—Second Circuit.]

H. D. SMITH & Co., v. PECK, STOW & WILCOX Co.

Decided December 10, 1919.

277 O. G., 981; 262 Fed. Rep., 415.

1. PATENTS—ANTICIPATION—ANALOGOUS ART.

The Ward patent, No. 737,179, for a screw-driver, is not anticipated by a horseshoer's hoof-parer, by a carriage-trimmer's tool, by an ice-pick and meat-maul, or by a wrench, as none of them suggest the idea in their construction of being at all adapted to a tool utility by turning on its longitudinal axis. To adapt the old devices to the new function requires modification or changes.

2. SAME—INVENTION—TEST OF INVENTION.

Whether a patented structure involves invention is a question of fact, and the determining factor is not whether the achievement was difficult or easy, but whether it has in point of fact given the world something of value that it did not have.

3. SAME—EVIDENCE OF INVENTION.

The willingness of the public to pay more for a patented device than for other articles of that class is a demonstration of its substantial value, and the fact that defendant copied the structure and shape of the article shows that it, too, appreciated the value of the advance made.

4. SAME—DESIGN FOR SCREW-DRIVER NOT ORNAMENTAL.

The Ward design patent, No. 37,213, for a design for a screw-driver, *Held invalid*, as it does not impart such a pleasing effect to the eye as to create beauty or attractiveness or to make it ornamental.

APPEAL from the District Court of the United States for the District of Connecticut.

Suit in equity by H. D. Smith & Co. against the Peck, Stow & Wilcox Company. *Decree for complainant, and defendant appeals. Modified and affirmed.*

For opinion below, see 258 Fed., 40.

Mr. H. E. Hart for the appellant.

Mr. Archibald Cox and *Mr. Henry E. Rockwell* for the appellee.

Before WARD, ROGERS, and MANTON, Circuit Judges.

MANTON, *Cir. J.*:

The appellee now owns, by assignment, Letters Patent No. 737,179, granted August 25, 1903, for a screw-driver, and Design Letters Patent No. 37,214, of November 8, 1904, for a design for the screw-driver. Both were issued to William S. Ward. The mechanical patent was considered by this court in an action wherein the present appellee was plaintiff and the Southington Manufacturing Company was defendant. (247 Fed., 342; 159 C. C. A., 436.) In that case, however, the plaintiff agreed, by stipulation, that the patent was valid, and therefore did not contest its validity for want of invention. The defenses offered in that litigation were non-infringement and invalidity because of anticipation. It was held there that there was nothing in the prior art like the combination of this article, to wit, the screw-driver, and the defendant failed on both of its defenses, to wit, the non-infringement and anticipation because of the prior art.

(1) In this case, the appellant is not bound by such an admission, and therefore the question of whether or not the patent discloses invention is open to it. It has also offered in evidence patents which were not in the case of *Smith v. Southington Mfg. Co.*, and which it contends establishes anticipation because of prior date. Likewise the defense is interposed that evidence of prior use establishes anticipation. There is a denial of infringement of the patent by use of the structure which the appellee says infringes its patent.

The district judge held that, in view of the result in this court in the case of *Smith v. Southington Mfg. Co.*, *supra*, it was not incumbent upon him to do more than examine such patents offered in the prior art as were not considered by this court, and such new evidence as amplified or added to the claim of anticipation due to prior use. In this we think the learned district judge was correct. The mechanical patent provides for a new make of screw-driver. Screw-drivers have existed for a long time, but in this invention we believe that the inventor gave to the world a new and better screw-driver than it has had, and thus has moved the art forward. It consists of a combination of a particular structure and a particular shape. It consists of integral solid drop-forging beginning at the

top of an oval, but having a flat hammer-face, and continuing into a flat handle-web, into which scales of an elliptical shape gradually decreasing in width are riveted, continuing into a conical tapering bolster, continuing into a round shaft, ending up in a flat blade; the handle portion being elliptical in the cross-section for the most part, but gradually merging with the conical bolster by a gentle taper into a circular tool-shank, thus providing a firm grasp, while facilitating a nice control by pressure of the finger and thumb upon the shank of the tool. There has been created for it a very substantial and large demand. It commands a high price for such a tool in the market. Its shape and handles provide for turning the tool on its elliptical axis.

Two important characteristics stand out as necessary for successful use by operators: (1) It should be of such a character that the blade may be inserted in the kerf of the screw as easily and certainly as possible; and (2) provide for the application of as much power as possible to turn it. Hand-power is applied, and the hand-grip must be attained by the shape upon which the hand rests and obtains control of the tool, and is brought to bear in the turning operation. The combination must have such structural strength as to meet increased strains occasioned by the increased control and turning power. The structure provided by this integral solid drop-forging provides for wooden hand-scales so shaped as to provide the foregoing characteristic. The shape can be seen plainly by the eye and felt by the hand. In the lower part of the handle, the elliptical cross-section merges with an abrupt break into a circular cross-section, and the two then decrease in diameter until there is a comparatively small circular cross-section and then continuing down becomes still smaller and then flattens out as a blade.

(2) Whether the structure involves invention is a question of fact, and the determining factor is not whether the achievement is difficult or easy, but whether it has, in point of fact, given the world something of real value, that it did not have—a benefit conferred upon mankind. (*O'Rourke Engineering Const. Co. v. McMullen et al.*, 160 Fed. Rep., 933; 88 C. C. A., 115.)

This court, upon the appeal in the other litigation, considered it very useful, and pointed out that a considerable demand had arisen for it. The record here shows that 4,700,000 of these screw-drivers have been sold at a price of at least ten per cent. higher than the next-highest-priced screw-driver. This willingness of the purchasing public to pay is a practical demonstration of its substantial value. The appellant's conduct in copying the structure and shape of the appellee's structure is a strong indication that it, too, appreciates the value of this advance in the art. We conclude that the combination constitutes invention, and that the patent is valid.

We shall consider the various patents in this record which were not considered in the case of *Smith & Co. v. Southington Mfg. Co.*, (247 Fed. Rep., 342; 159 C. C. A., 436.) In that case, the defendant introduced the same three table-knife patents, No. 78,328, issued May 26, 1868, to Moses Rubel, No. 86,252, issued January 26, 1869, to Moses Rubel, and No. 172,874, issued February 1, 1876, to James D. Frary; the screw-driver patent, No. 267,709, issued November 21, 1892, to Philip Nadig; three wrench patents, No. 553,059, issued January 14, 1896, to Robert C. Ellrich, No. 666,029, issued January 15, 1901, to Amos Sheppard, and Design No. 34,136, issued February 26, 1901, to William S. Ward; and all were held not to anticipate the patent in suit. We adhere to the conclusion there announced. In addition to the foregoing patents, this appellant has offered and introduced three other patents, one to Franz Lehman, No. 96,928, issued November 16, 1869, for a horseshoer's hoof-parer, one to Munson, No. 104,056, issued June 7, 1870, relating to rubber-coated carriage-trimmings, and one to Conklin, No. 128,020, issued June 18, 1872, for an ice-pick and meat-maul. The ice-pick is made of a single piece of cast metal, with handle-scales attached. The carriage-trimmings tool consists of a piece of metal covered with rubber, and the hoof-parer of a curved piece of metal with a curved knife fastened to one end, and two pieces of horn riveted to either side. They have neither the structure nor the shape of the patent in suit. It is plain that none of these prior patents could provide for the patented screw-driver without modification of the things shown in the patent.

(3) It is not sufficient to constitute anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question. It must be designed by the maker and adapted for the performance of such function. (*Topliff v. Topliff & Co.*, C. D., 1892, 402; 50 O. G., 1257; 145 U. S., 156; 12 Sup. Ct., 825.) The prior wrench patents to Ellrich (No. 553,059) and Sheppard (No. 666,029) do not show or suggest any part of the shape of the patented screw-driver, except only at one end of the six mentioned parts. They do not disclose or suggest either the butt at one end or any of the shape below the handle portion, where the elliptical cross-section gradually merges into a round cross-section, nor the continued contracted diameter through the conical bolster into the circular tool-shank. They lack half the combination of the article, because, if a blade is formed on the end of one of these wrenches, the device still lacks the shape, and they cannot be declared an anticipation. We shall consider the design patent to Ward better.

The tools made pursuant to the prior patents were not screw-drivers, and do not suggest the idea in their construction of being

at all adapted to a tool utility by turning on its longitudinal axis. To adapt these old devices to this new function would require modification or changes, and therefore they do not anticipate. (*Hobbs v. Beach*, C. D., 1901, 311; 94 O. G., 2357; 180 U. S., 383; 21 Sup. Ct., 409; *Barry v. Harpoon Castor Mfg. Co.*, 209 Fed. Rep., 207; 126 C. C. A., 301.)

The improvised tools used by employees of both in their factory and at their homes were simply wrench-bars and were not anticipations. They had not become established facts, accessible to the public, in contributing definitely to the advance of the art. They had not taken their place as part of the known established art, to which the public may at any time resort. (*Ajax Metal Co. v. Brady Brass Co.*, C. C.; 155 Fed. Rep., 409.) These tools do not suggest or show the merging of the elliptical cross-section into the circular cross-section, or the portion of the tool below that. To prove anticipation by an unpatented device, if attempted by oral testimony, the existence and use must be proven by clear, satisfactory proof and beyond a reasonable doubt. (*The Barbed Wire Patents*, C. D., 1892, 299; 56 O. G., 1555; 143 U. S., 275; 12 Sup. Ct., 443.) We find nothing in the prior use of the various tools, which have been offered in evidence and been considered, which warrants our concluding, beyond a reasonable doubt, that the appellee's patented structure has been anticipated by such use.

The proof of infringement is ample. The appellant's screw-driver is so near in structure and shape to the appellee's screw-driver that we are convinced of its infringement.

(4) The appellee has sued upon both patents in this action. This it may properly do. (*Eclipse Mach. Co. v. Harley-Davidson Motor Co.*, D. C., 244 Fed. Rep., 463.) To successfully establish the validity of the design patent, and to entitle the inventor to protection, he must establish a result obtained, which indicates, not only that the design is new, but that it is beautiful and attractive. It must involve something more than mere mechanical skill. There must be invention of design. The district judge concluded that the screw-driver is beautiful and attractive, and he says, even ornamental. We cannot, however, agree that the appellee's structure, made pursuant to this patent, has such a pleasing effect imparted to the eye as to create beauty or attractiveness, or to make it ornamental. It provides for a new utility. Design patents refer to appearance. Their object is to encourage works of art and decorations which appeal to the esthetic emotions—to the beautiful. We do not think that the device constructed by the appellee has a subject-matter for such beauty and attractiveness as is contemplated by the statutes,

which permit the Patent Office to grant design patents, and conclude that the learned district judge erroneously sustained this patent.

We therefore modify the decree by affirming the result reached by the district judge as to the Letters Patent No. 737,179, granted August 25, 1903, and reverse the decree as to Design Letters Patent No. 37,214.

The decree below is thus modified and affirmed.

[U. S. Circuit Court of Appeals—Sixth Circuit.]

CONCRETE APPLIANCES CO. *et al.* v. MEINKEN *et al.*

Decided January 6, 1920; on petition for rehearing March 2, 1920.

278 O. G., 163; 262 Fed. Rep., 958.

1. PATENTS—VALIDITY AFFECTED BY PRIOR APPLICATION FOR ANOTHER PATENT.

A patent applied for after filing of application for but before issue of another patent in the same art should, as to anticipation and the presence of invention, be judged upon the basis of which the earlier application is a part, though it was not a part of the prior art in the sense in which that phrase is used with reference only to publication.

2. SAME—PATENT FOR DISTRIBUTING WET CONCRETE INVALID FOR WANT OF INVENTION.

The Smith patent, No. 948,746, for an apparatus for distributing wet concrete, as limited by the prior Callahan patent, No. 948,719, *Held* not to show invention.

3. SAME—COMBINATION DEVICE FOR DISTRIBUTING WET CONCRETE VALID AND NOT ANTICIPATED.

The Callahan patent, No. 948,719, for an apparatus for distributing wet concrete, consisting of an elevating-tower and devices for spreading same over structure, though a combination, *Held* to show invention and not to have been anticipated.

4. SAME—ANALOGOUS USE.

Apparatus for elevating and distributing wet concrete *Held* not a mere double use of earlier apparatus for loading coal.

5. SAME—NEW RESULT.

The elevation and gravity distribution of wet concrete to and around the successive floors of a building being constructed and all in a semi-automatic way is a new result in a patentable sense.

6. SAME—PATENTABILITY—TEST OF INVENTION—"NEW RESULT."

"The test of the presence of invention in a new assembly of old elements is sometimes said to be whether a new result is accomplished. This is often not a helpful rule, because its application involves definition of the phrase 'new result,' and this opens the original difficulty. Within a narrow definition, every new combination of old elements gets a new result; but this is not the sense in which the phrase is rightly used as indicative of invention."

7. SAME—APPARATUS FOR DOING A UNITARY WORK INVOLVING SUCCESSIVE STEPS UNDER MANUAL CONTROL.

Apparatus for elevating and distributing wet concrete to the floors of buildings under construction, which is in a fair sense a unitary work, does not become an aggregation merely because it involves successive steps under manual control.

On petition for rehearing.

8. SAME—CONSTRUCTION—"ADJUSTABLE"—REMOVAL OF BOLTS AND FASTENING IN NEW POSITION.

The Callahan patent, No. 948,719, for an apparatus for elevating and distributing wet concrete to the floors of buildings under construction, claim 5, the phrase "said boom being adjustably connected with the tower and adapted to be arranged at various points in the height thereof" construed in accordance with the apparent intention of the draftsmen to refer to the vertical change of the boom on the tower, which was effected by taking out bolts and bolting it again to a new position, although such is not adjustability in the most precise definition.

APPEAL from the District Court of the United States for the Western Division of the Southern District of Ohio; Howard C. Hollister, judge.

Suit by the Concrete Appliances Company and another against Dietrich Meinken and others. *From a decree for defendants, plaintiffs appeal. Reversed and remanded, with directions.*

STATEMENT OF THE CASE.

Suit upon patents numbered 948,719, issued July 8, 1910, to L. Callahan, and 948,746, issued February 8, 1910, to A. L. Smith. This case involves the tower apparatus now in common use for elevating and distributing wet ("mush") concrete upon the successive floors of high buildings, constructed in whole or in part from that material. The apparatus, as now used, involves two steps: first, elevating the material to a reservoir or hopper-bin temporarily fixed at the desired elevation in the tower; and, second, distributing it from that elevation, by gravity, through a conduit revolving at the point of connection with the hopper-bin and having at least one swiveled elbow-joint, whereby any desired point upon the selected horizontal plane can be reached for the gravity discharge of the material.

Callahan and Smith each showed, in his drawing, the complete apparatus; but Callahan made no claim to the feature of the double-swiveled discharge-pipe. Callahan's application was filed January 21, 1909; Smith's on February 23d of the same year. The Patent Office notified Callahan that his application seemed to conflict with another, and suggested to him some of the claims which Smith had made. Callahan adopted these claims, whereby an interference was declared. The substance of the issue is shown by count 1, which is

given in the footnote.¹ Upon this issue, Callahan conceded priority; judgment was rendered upon the concession; Callahan canceled these additional claims; and both patents issued. Both patents, by assignments, licenses, etc., became the property of the Concrete Appliances Company and Insley, and this suit was brought by them in the court below based upon alleged infringement of both patents. The above-quoted count 1 of the interference became claim 1 of the Smith patent, and is typical of those sued upon.

Claim 5 of the Callahan patent is here quoted² and may be accepted as a statement of his invention said to be infringed. Claims 1, 2, and 13 are also declared upon.

Mr. Arthur M. Hood for the appellants.

Mr. F. E. Dennett for the appellees.

Before WARRINGTON, KNAPPEN, and DENISON, Circuit Judges.

DENISON, *Cir. J.*, (after stating the facts as above:)

(1, 2) It goes without saying that the Smith patent can get no advantage merely because it has been owned and commercially exploited along with the Callahan patent. Upon this record, Smith can not claim to be the inventor of anything shown by Callahan's application, except as the latter is modified by the later concession of priority. The Callahan patent is not a part of the prior art, in the sense in which that phrase is used with reference only to publications, but the Smith patent, both as to anticipation and as to the presence of invention, must be judged upon the basis of which the earlier Callahan application is a part. (*Lemley v. Dobson-Evans Co.*, C. D., 1918, 223; 246 O. G., 1203; 243 Fed. Rep., 391; 156 C. C. A., 171.) It must therefore be assumed, as against Smith, that the advance of his claim 1 consisted merely in taking the concrete elevating and distributing apparatus of Callahan and substituting for Callahan's simple discharging-conduit, revolving only at the point of attachment to the receiving-hopper, the compound discharging-conduit consisting of two or more sections revolubly connected with each other.³ We are not convinced that this advance involved any

¹ In a device for distributing concrete, means for elevating the concrete to a point above the work to be performed; a hopper adapted to receive the concrete so elevated; a primary distributing pipe revolubly mounted beneath the hopper; and a secondary distributing pipe revolubly mounted beneath the mouth of the first named pipe, substantially as described.

² Claim 5. An apparatus for the purpose described, comprising a tower, a conduit extending laterally therefrom, a suitably supported horizontally movable boom carrying the conduit, said boom being adjustably connected with the tower and adapted to be arranged at various points in the height thereof, means for raising plastic material to the point desired in the height of the conduit [tower], and means for receiving plastic material from the raising means and conducting the same to the conduit; the said receiving and conducting means being adjustable in the direction of the height of the tower.

³ We speak thus of Callahan's form, because of the necessary effect of the filing dates, the concession, and the form of the issued claims.

invention. Such a double-swiveled conduit was a well-known expedient for the gravity conveying of any material which it was desired to discharge at selected points in a lower horizontal plane. It is obvious—at least when it is pointed out to us—that, with an inclined conduit revolving at its upper end, the lower end could be made to reach any desired point on the lower plane, either by changing the angle of inclination and modifying the length of the conduit, as by telescoping a section, or by adding a supplementary conduit revolubly connected with the lower end of the primary one. Neither form had been in use for concrete (before Callahan), but both forms were old for other purposes. The double-swiveled form had been most highly developed in grain-elevators, for distributing the grain from the elevated receiving-bin to the several openings on the floor below, which indicated spouts leading to still lower storage-bins.

If the matter were to be considered in the broadest sense, there might be such distinctions between elevating and distributing grain and elevating and distributing concrete that transferring a device from one art to the other and making the necessary adaptation would involve invention. That need not be decided; but here Smith begins at the point where the elevation of the concrete is finished. He has then merely the question of gravity distribution. He finds that concrete has been distributed and grain has been distributed by a single unitary chute, swinging and turning at its upper end, and that grain has also been distributed by the double-swiveled chute, thereby increasing the ability to select exactly the desired point for discharge. In the words which were used in *Crown Co. v. Sterling Co.*, (C. D., 1915, 271; 218 O. G. 875; 217 Fed Rep., 381; 133 C. C. A., 297,) Callahan had already “bridged over whatever gap there was” between the art of concrete-building and the art of gravity distribution, and the “door of opportunity was open” to all who wished to use in the former art an expedient well known in the latter. It seems to us quite clear that there is no invention in adding to the device of Callahan the well-known additional swiveled joint in the discharge-conduit. It follows that those claims of the Smith patent sued upon are invalid, and the decree of the court below, which dismissed the bill as to this patent, must so far be affirmed.

(3) At the time these patentees appeared on the field concrete had already come into extensive use as a building material in connection with metallic reinforcements, and it had been found that it was suitable for buildings of all shapes and of many stories in height. When mixed of the proper consistency, it was called “mush” concrete, and to handle this material and deliver it efficiently at the place of use in a large building operation was a

considerable problem. Various methods had been employed, but the one most approved consisted in raising it by elevator to the floor or level where it was to be used and there dumping it into wheelbarrows, by which it was conveyed to the various desired points of use upon that level. It occurred to Callahan that he could construct a tower, or skeleton elevator-shaft, which should originally extend, or which, by successive additions, should be made to extend, well above the highest story of the proposed building; that he could attach to this tower, and make vertically adjustable thereon, a receiving bin or hopper carrying a downwardly-inclined and revolvably-connected discharge-chute, which could be swung about to reach various points on the next lower level to that where the receiving-bin was fixed; that this receiving-bin and its discharging apparatus could be temporarily fixed, as the building advanced, at positions on the tower suitably elevated above each successive story; that the mush concrete could be elevated inside the tower to these various fixed positions and there dumped into the receiving-bin; and that, in this way the mush concrete could be delivered in an approximately automatic way throughout the successive floors or levels of a building, no matter how high. Upon this record, this general thought was wholly novel. It has proved to be of great commercial value. It is common knowledge that, mostly within the period since the patent issued, reinforced concrete has largely superseded all other materials in the erection of large structures, and the record shows that eighty or ninety per cent. of all the important construction work of this class in the country employs this Callahan method, and that all of the larger manufacturers of machinery and apparatus for this general purpose have taken licenses under the patent. It is not too much to say that the invention has played a large part in revolutionizing the building industry, and that it is not common for a patent in litigation to find itself supported by such a large measure of commercial merit and public acquiescence.

It is not contended that the patent is anticipated, in the strict sense of that term, but the defendant's position, approved by the court below, is that Callahan only put together old and familiar elements, and that his advance did not involve invention over what had gone before. To determine this question, we must know, first, the character of the relations between what was old and this new arrangement, and, second, whether his claims are properly characterized by reference to his real advance. To elevate material to a fixed and invariable height, and to distribute it therefrom by gravity, through a swinging, revolving chute, to different discharge-spots upon a lower level, was common. As we have said, in consid-

ering the Smith patent, this was familiar in the class of grain-elevators. The typical so-called grain-elevator, or storage-house, was a permanent structure, and grain was carried by various types of elevating apparatus to the permanent top floor or level. From the bottom of the bin there situated depended a swinging chute, which could be moved about so as to discharge, upon the floor below, into any storage-bin opening from that level. These grain-elevators, like others of similar type shown by the record, entirely lack the only substantial novelty claimed for Callahan. They did not have a temporary receiving bin or hopper with a connected discharge-chute vertically adjustable in an elevator-tower, adapted to distribute the material upon successive levels. If invention lies in this thought and its practical application, the grain-elevators are not important.

Next we are cited to several examples of unloading apparatus for vessels, of which the English patent to Baillie, No. 10,380 of 1888, is as relevant as any. In this device, which was for transferring coal from a barge to the ship alongside, there was a receiving bin or hopper located in an elevated framework or staging on the barge, and from which a depending chute carried the material away by gravity to the proper bunker in the ship. The coal contents of the barge were raised to this point by an endless chain of buckets over an inclined mast or support pivoted to the vertical frame at its upper end. Evidently, as the contents of the hold of the vessel became lowered, this mast must be extended farther down, or farther to one side, and this could be done either by an extension of the lower end or by lowering the upper pivoted point. The patent shows both methods of adjustment. The bin and pivot could be lowered upon this supporting-stage a short distance—not more than the height of the bin. The point of final delivery was not changed. Such vertical adjustability as there was in the bin was incidental to raising and lowering the whole "tower" to accommodate it to the point where elevation began. We do not find here any substantial disclosure of the real novelty of Callahan's invention, as above stated.

This leaves for consideration only the patent to Theiss *et al.*, No. 866,166, of September 17, 1907. It is not to be doubted that this is suggestive of the idea and the apparatus of Callahan; whether it is more than a mere suggestion is the question. Theiss's apparatus, like Baillie's, was intended for unloading coal from a barge and loading it into the hold of a ship. It consisted essentially of a tower-shaped structure permanently erected upon the deck of a barge or scow. It was intended to reach a distance substantially higher than the coal-receiving hatchways of the particular ship which might be selected to be served; there was never occasion to make it any higher. This tower carried an elevator car or skip which was loaded with

coal when it was at the bottom of the tower, and then was elevated as far as necessary to be dumped into a receiving-bin, which bin was capable of vertical adjustment on the tower. This receiving-bin in turn dumped into a chute, which, at its lower end, discharged through the hatchway of the vessel to be loaded. This chute was not revolvably connected with the bin or tower. It could not be moved laterally. It was carried, by the tower, in ways or guides which gave the chute its inclination and permitted it to slide therein longitudinally. There was a permitted adjustment of the guide by which the angle of inclination could be changed, but this was done by releasing and readjusting and refastening the guideways, and could not be done as a part of the operation of the device while in use.

The adjustment and fixing of the chute, in order to discharge into a desired hatchway, was a complicated matter. First, the carrying scow must be so positioned and fastened with reference to the ship that the tower was exactly opposite the hatchway. Second, the receiving-bin and the chute must be adjusted vertically in the tower at such a position that the chute, in its carrying-guides, would be pointed at the hatchway. Third, the chute must be slid downward and outward, in the direction at which it was pointed, until its lower end entered the hatchway. If, then, it was next desired to reach another hatchway on the same transverse line, the vertical adjustment of the bin and the chute-carrier, and the aiming of the chute at the new hatchway and its longitudinal extension into contact therewith, must be repeated. If it were desired to reach hatchways farther forward or aft, the scow and its entire apparatus must be released and floated alongside the ship to its new position. In the broadest sense, this patent shows a plan of elevating material to an adjustable vertical height, and from there distributing it by gravity to selected positions upon a lower level; but it shows this idea in a very rudimentary form. It would be practically useless, for the purposes now involved.

In details of construction and of claim reading, there is ample differentiation. Claim 5 of Callahan, above quoted, will not read on Theiss. A comparison of the Theiss apparatus with this claim shows (a) that the Theiss apparatus is not "for the purpose described," in any restricted sense of that phrase; (b) that Theiss has a relatively short supporting-framework, rather than a relatively high and distinctive tower; (c) that, while Theiss has "a conduit," it does not "extend laterally therefrom," excepting in the most general sense; (d) that Theiss has no "suitably supported horizontally movable boom carrying the conduit," nor anything which approximates such a boom; (e) that, since he has no boom at all, of course he has no boom "adjustably connected with the tower and adapted to be ar-

ranged at the various points of the height thereof;" but it must be said that Theiss's conduit itself has this vertically-adjustable connection with the tower. (f) The remaining elements of the claim are literally met well enough by Theiss, save for the distinction as to their use with plastic material.

(4) The question presented by Theiss seems not to be one merely of double use, because the structural differences are too great; but, if the physical resemblance were much closer, the defense of double use would be far from satisfactory. (See *Ansonia Co. v. Electrical Co.*, C. D., 1892, 313; 58 O. G., 1692; 144 U. S., 11; 12 Sup. Ct., 601; *Potts v. Creager*, C. D., 1895, 143; 70 O. G., 494; 155 U. S., 597; 15 Sup. Ct., 194; *Hobbs v. Beach*, C. D., 1901, 311; 94 O. G., 2357; 180 U. S., 383; 21 Sup. Ct., 409; *Gold v. Newton*, C. D., 1918, 310; 256 O. G., 649; C. C. A., 2; 254 Fed. Rep., 824; 166 C. C. A., 270.) Certainly, the art of loading coal into a ship for fuel is not the same art at that of distributing wet concrete to a building structure; nor is the analogy very close. It is not at all certain, even if probable, that an experienced building engineer, considering methods of handling wet concrete for a skyscraper, would call to mind a coal-handling apparatus on a harbor-scow. On the other hand, it impresses us as a bold and original thought that this material could be handled in this way. Distributing mush concrete through gravity-chutes by one apparatus throughout the whole course of building obviously involved difficulties; it had never been handled by gravity-chutes at all, excepting under simple conditions where these difficulties did not exist, and then, perhaps, had been done only on paper. On one side was the danger that it would adhere to the chutes and set and choke up the pipes, at least at the valves and gates; on the other side, the risk that the elements would disintegrate, and the water and the cement and the broken stone fall in separate strata.

Callahan's conception, that this material could be thus treated so as to deliver it from the ground all about the successive several floors of a high building and with practically no manual labor, except that involved in the story by story adjustment of the apparatus, involved, we think, inventive thought of a high order, when accompanied as it was by the devising of suitable apparatus to carry out the thought, which apparatus substantially differed from anything which had ever been constructed for any purpose, although every element was old. It is true, in a sense, that the Callahan device is produced upon the basis of Theiss's structure by substituting for the longitudinally sliding and extensible delivery-chute of Theiss, the revolubly-mounted chute of the grain-elevators; but this is not the whole truth. Callahan built up his tower to a height never thought of by Theiss, and which Theiss could not have accom-

plished without capsizing his barge; and Callahan supplied a chute-supporting boom attached to the receiving-hopper and vertically adjustable with it, a feature which the grain-elevators did not have and could not have used. He thereby laid the basis for adapting the structure to use fairly distinct from that of either a coal-elevator or a grain elevator.

As upon every such question, there is no authoritative decision which compels one or the other conclusion. The doubtful inference is rather one of fact; but we select and refer to a few instances where invention has been found—by the Supreme Court or by this court—and the facts of which may well be thought to present no stronger inferences in its favor than do those of the instant case: *Webster Loom Co. v. Higgins*, C. D., 1882, 285; 21 O. G., 2031; 105 U. S., 581; *Hobbs v. Beach*, C. D., 1901, 311; 94 O. G., 2357; 180 U. S., 383; 21 Sup. Ct., 409; *Expanded Metal Co. v. Bradford*, C. D., 1909, 521; 143 O. G., 863; 214 U. S., 366; 29 Sup. Ct., 652; *National Co. v. Aiken*, 163 Fed. Rep., 254; 91 C. C. A., 114; *Warren v. Owosso*, 166 Fed. Rep., 309; 92 C. C. A., 227; *Morgan Co. v. Alliance Co.*, C. D., 1910, 438; 157 O. G., 1244; 176 Fed. Rep., 100; 100 C. C. A., 30; *Ferro-Concrete Co. v. Concrete Co.*, 206 Fed. Rep., 666; 124 C. C. A., 466; *International Co. v. Sievert*, 213 Fed. Rep., 225; 129 C. C. A., 569.)

(5) The test of the presence of invention in a new assembly of old elements is sometimes said to be whether a new result is accomplished. This is often not a helpful rule, because its application involves definition of the phrase "new result," and this opens the original difficulty. Within a narrow definition, every new combination of old elements gets a new result; but this is not the sense in which the phrase is rightly used as indicative of invention. The recent opinion of this court in *Huebner Co. v. Matthews Co.*, (C. D., 1919, 251; 262 O. G., 313; 253 Fed., 435; 165 C. C. A., 177) illustrates this situation. The ultimate practical result at which the patentee and his predecessors aimed was to carry packages by gravity upon a runway from one place to another. The patentee was the first to accomplish this with such a degree of efficiency as to make the device commercially popular; but the same result, except in efficiency degree, had several times been reached before, and by apparatus so similar as to be superficially indistinguishable. The patentee had simply added the well-known and common mechanical refinements and expedients already used by others, even in the same art—*e. g.*, he used roller-bearings, instead of ordinary journal-boxes—and we declined to regard this as a new result. We have no intention to depart from that line of our recent decisions⁴ of which

⁴ *Berger Co. v. Trussed Co.*, (C. D., 1919, 848; 266 O. G., 449; 257 Fed. Rep., 741; *Edwards v. Dayton Co.*, C. D., 1919, 351; 266 O. G., 597; 257 Fed. Rep., 980; *Van Dorn Co. v. Mathias Co.*, C. D., 1919, 435; 269 O. G., 886; 260 Fed. Rep., 400.

this one is typical; such refinements are not inventions. On the other hand, we recall no instance of combinations of old elements which has been held to produce "a new result" in a patentable sense and which better deserves that commendation than does Callahan's. The quasi-automatic elevation and distribution of wet concrete under the varying conditions of progressive building and by a single apparatus was an entire novelty. No one had tried to do it; apparently, no one had thought of it; it was useful in a very high degree; and when we find a new result in this complete and extreme sense accomplished by a confessedly new combination—though of known means—we think both the purpose of the patent law and the rightful application of the decisions thereunder require that it should be awarded the merit of invention.

(6) We have stated our conclusion that the device of the patent is not an aggregation in the sense that it represents such a mere assembling of old elements as might have been made by the exercise of only ordinary skill. It is at least equally clear that the device is not an aggregation in the more technical sense of the word, but is rather a true combination. It is true that the use of the apparatus involves successive steps, and is at each of its stages under direct or indirect manual control; but in a fair sense the entire operation of elevating and distributing the concrete is a unitary thing. From the time it starts on its journey from the ground to the time it is deposited in the forms, its progress might well be automatic. There is clear distinction between this performance and that of the associated washing and wringing machines, discussed by the Supreme Court in *Grinnell Co. v. Johnson Co.*, (C. D., 1918, 363; 254 O. G., 225; 247 U. S., 426; 38 Sup. Ct., 547.) In the latter case, both the judgment and the hand of the operator were involved, in submitting to the second operation the material which had finished the first; the juxtaposition of the two machines was a mere matter of convenience. In the present case, the operator can, at the most, only interfere to prevent the otherwise normal completion or second part of what is intended to be the unitary work; and even then his interference will only temporarily stay the normal action. We collected and commented on the decisions of the Supreme Court and other courts on this subject in *Gas Co. v. United Co.*, (228 Fed. Rep., 684; 143 C. C. A., 206.) Callahan's patent should not be condemned as an aggregation.

We do not overlook the fact that some, and perhaps a considerable portion, of the practical and commercial success has been due to the use of the feature covered by the Smith patent; but this does not detract from the patentable and inventive merit of Callahan's idea. An oscillating or swinging chute, even without Smith's secondary

swivel, would make the primary distribution of the concrete throughout the floor or level, leaving the secondary and more accurate distribution to be accomplished by further means. We have held that the particular means adopted by Smith did not involve invention, and we can hardly say that much of the credit due to public use should be taken away from Callahan, because he had not himself adopted an improvement and refinement which, however important to commercial success, was within the grasp of the men ordinarily skilled in the art.

We have considered claim 5. Claims 1, 2, and 13, also in suit, use more general terms and are superficially somewhat broader; but we think, in connection with the specification, they necessarily intend that the means for receiving the concrete from the raising means and taking it to the conduit are vertically adjustable in the tower. This may fairly be implied from the requirement that the material is to be raised to a "suitable point" in the tower. It is then seen that all these claims involve what we have thought Callahan's meritorious invention, resting upon the successive story-by-story operation of the device. With this interpretation, they are not very different from claim 5, but should be treated as other expressions of the same thought in terms nominally of somewhat broader equivalency. These claims, also, should be considered valid.

The infringement is not denied.

The decree below, as entered, must be set aside, and the record remanded for a new decree, modified in accordance with this opinion.

ON PETITION FOR REHEARING.

(7) The application for rehearing brings to our attention a matter not mentioned in the opinion. We selected claim 5 as the one most suitable for study, because it expressly incorporated those features in which we thought patentable novelty was to be found. One of these features was the horizontally-movable boom carrying the conduit, and—

being adjustably connected with the tower and adapted to be arranged at various positions in the height thereof.

We assumed that this referred to a vertical adjustment of the boom in the tower. The assumption is now challenged, because it is said that the adjustable connection between the boom and the tower was that mechanism which provided for a horizontal adjustment of the upper end of the boom on a horizontal track (which defendant has not used), and that the provision for vertical change of the boom in the tower is not adjustability, but rather refers to a disassembling of the parts in one location and reassembling them in another. It is true that the specification refers to a horizontal adjustability, but we do not think that it is this capacity to which claim 5 refers—at

any rate, this inference is not clear enough to justify limiting the claim to a comparatively unimportant detail. Such an inference is contradicted, both by the fact that this horizontal adjustability of the boom on the tower is made the special characteristic of a group of claims not in suit, and by the fact that the thought is stated in the claim in immediate connection with the reference to "various points in the height" of the tower, and after one reference has been made to the horizontal motion of the boom and the reference to that function apparently finished, while the draftsman turned to the thought of vertical change. It is true, also, that in the form of the invention shown in the drawings, and specifically described, the vertical change was to be made by taking out bolts, removing the horizontal platform, raising it, and bolting it again to a new position, and that this is not adjustability in the most precise definition. However, it is well within the sense in which the word is very often used, and we must define it as the patentee intended. For these reasons we adhere to the interpretation of the claim in this respect which the opinion assumed.

It is also true enough that Callahan specifically contemplated building his tower up section by section, as the building progressed; but this was a matter of preference. His drawing shows the completed tower, permitting operation anywhere along its height, and observation of his plan of erection does not change our conception of the real disclosure.

In other respects, further review of the case leaves our stated conclusions unchanged.

The application for rehearing will be disallowed.

[U. S. Circuit Court of Appeals—Second Circuit.]

GEO. BORGFELDT & Co. *et al.* v. WEISS.

Decided March 19, 1920.

278 O. G., 545; 50 App. D. C., —; 265 Fed. Rep., 268.

1. PATENTS—INFRINGEMENT OF DESIGN PATENT DEPENDS ON IMPRESSION PRODUCED ON PURCHASERS.

The question of infringement of a design patent for a doll is a question as to the impression produced on would-be purchasers.

2. SAME—DESIGN FOR DOLL VALID AND INFRINGED.

The Pfeffer design patent, No. 51,559, for a doll, *Held* valid and infringed.

3. SAME—TEST OF INFRINGEMENT OF DESIGN STATED.

Infringement of a design patent for a doll turns upon whether there is identity of appearance, whether the effect produced upon the eye is the same, and whether there is substantial identity of design, and the persons to be deceived are not experts, but ordinary observers, giving such attention to the matter as purchasers usually give.

4. SAME—DESIGN PATENT ENTITLED TO EQUIVALENTS RESPECTING NON-ESSENTIAL DETAILS.

A design patent for a doll entitles the holder to the usual range of equivalents with respect to known prior unessential details, and though the patent drawings show a doll with a cap the figure shown is included within the claim of the patent, whether the doll is provided with painted hair, real hair, bathing-cap, or military or naval cap or any other standard form of head-dress.

APPEAL from the District Court of the United States for the Southern District of New York.

Suit by George Borgfeldt & Co. and another against Leo L. Weiss. *From a decree dismissing the bill, complainants appeal. Reversed, with directions.*

Mr. Hans v. Briesen (Mr. Fred A. Klein of counsel) for the appellants.

Messrs. Kornbluth & Pollack (Mr. Herman C. Pollack of counsel) for the appellee.

Before WARD, ROGERS, and HOUGH, Circuit Judges.

ROGERS, *Cir. J.*:

The suit is for the infringement of United States Design Patent No. 51,559, issued to Miss Genevieve Pfeffer, San Jose, Calif., on December 11, 1917. The patentee states in her specification that she has invented a new, original, and ornamental design for dolls, of which—

the following is a specification, reference being had to the accompanying drawing.

There is no written description of the invention, and the claim is "the ornamental design for a doll as shown." Those drawings are reproduced herein:



The complainant gets its title from a contract with Miss Pfeffer, giving it the manufacturing rights, and reserving to herself a royalty.

The defendant has taken out no patent, but reproductions of the alleged infringing doll are here shown:



The plaintiff calls his doll "Splashme" and defendant names his "Duckme." The plaintiff's figurettes have met with remarkable success in the market; some 360,000 having been sold between April, 1918, when they were put on the market, and June, 1919, when the case was tried. The amount of the sales is said to be somewhere between \$500,000 and \$1,000,000.

(1) The dolls of the plaintiff and those of defendant differ from each other in certain details which are unessential. The defendant's doll is provided with painted hair, or imitation hair, where the doll of the patent shows hair covered by a cap. The defendant's doll omits the cap. The posture of the arms and legs has been slightly varied in the doll of the defendant, and the defendant's doll has painted slippers, where the plaintiff's doll has bare toes. The conclusion, however, is irresistible that defendant has copied plaintiff's design as a whole and sought to escape infringement by varying the ornamentation. In the opinion below the district judge, speaking of the two dolls, says:

At a glance one would, of course, see the patent plagiarism.

He also says that—

the only variation which the defendant has made, and which is at all observable, is to take off the bathing cap from the figure in the design. That would not be enough under ordinary circumstances, because a close-fitting cap is only distinguishable by some attention from an uncovered head.

He adds that when the cap is off—and it is removable from plaintiff's doll—the two figures are distinguishable beyond question. That is true, but in the stores, when the dolls are sold, they have their caps on; and the question is as to the impression produced on would-be purchasers.

In *Ashley v. Tatum* (186 Fed. Rep., 339; 108 C. C. A., 539) this court held that a patent for a design is not invalid because it does

not contain a written description of the design, although its absence may have a bearing upon the construction of the patent, and therefore on the question of infringement. The Supreme Court in *Dobson v. Dornam* (C. D., 1886, 202; 35 O. G., 750; 118 U. S., 10; 6 Sup. Ct., 946) had already held that the specification for a design, which is accompanied by a photographic illustration and merely states that the nature of the design is fully represented in the illustration and claims the configuration of the design annexed, is a sufficient description and claim.

(2) This court is of the opinion that plaintiff's patent is valid. The plaintiff's design is clever and attractive; the controlling features being the eyes and the posture of a doll in bathing-costume. It is not invalidated by anything in the prior art. The exhibits produced by defendant at the trial only served to emphasize the uniqueness and individuality of the plaintiff's design.

(3) The plaintiff's patent being valid, there remains the question whether the defendant infringes. The question of infringement turns upon whether there is identity of appearance; whether the effect produced upon the eye is the same; whether there is substantial identity of design; and the persons to be deceived are not the experts, but the ordinary observers, giving such attention to the matter as purchasers usually give. That is the test laid down in *Gorham Co. v. White*, (2 O. G., 592; 14 Wall., 511; 20 L. Ed., 731,) a case which has never been overruled.

The court below has decided that there is no infringement, and in doing so appears to have misapprehended the decision of this court in *Ashley v. Tatum*. That case was decided in the lower court in 1910, and the opinion of the district judge is found in 181 Fed. Rep., 840. The patent in that case was a design patent for an inkwell. The district judge held the patent valid and infringed, declaring that the prior art presented nothing which in the least suggested it. The complainant's design contained no ornamentation. The defendant's design did contain ornamentation, and the court declared it was "no doubt distinguishable" from complainant's design, but he also found that it contained "every element of complainant's design." He said:

The defendant has taken over bodily every element of the complainant's design, and he has added just enough, and that, too, injuriously, to make a colorable claim to differentiation. * * * The complainant's design appears to me to have been imitated, and I therefore find that the defendant's wells are an infringement.

The case was brought to this court upon appeal, and the decision is found in 186 Fed. Rep., 339; 108 C. C. A., 539; the opinion being written by Judge Lacombe. This court reversed the court below,

and held there was no infringement, although agreeing with the district judge that the two inkwells were plainly distinguishable.

The difference between the two is readily apparent to any one, expert or non-expert, * * *

said Judge Lacombe,

and there seems no likelihood that, whether looked at together or apart, the one could be mistaken for the other.

In *Ashley v. Tatum* there was no specification of any kind, and the patent consisted entirely of an illustration, and the article said to infringe was plainly distinguishable from the article which was said to be infringed. What was said in that case must be strictly confined to the class of cases to which it belongs. The case is plainly distinguishable from the case now before the court, as will presently appear. After this court decided *Ashley v. Tatum*, an attempt was made to get it before the Supreme Court by writ of certiorari; it being alleged that the Patent Office would allow no verbal description in design patents, and that over 30,000 of such patents were imperiled so far as their scope was concerned. The application, however, was denied. (225 U. S., 707; 32 Sup. Ct., 839; 56 L. Ed., 1266.)

In 1912 in *Graff, Washbourne & Dunn v. Webster* (195 Fed. Rep., 522; 115 C. C. A., 432) this court had before it a design patent for a dish. The question under consideration in the *Tatum* case was not discussed, and the case itself was not referred to. But Judge Coxe, speaking for the court, said:

Having seen the complainant's design in a show case or shop window, the ordinary buyer would be very likely to mistake the defendants' design for it, if seen in similar environment. This is the real test of infringement of design patents. If the ordinary buyer, having seen one of the complainant's dishes and wishing to procure one like it, would be induced to buy one of the defendants' dishes instead, it is enough. That he would be so deceived is plain, not only from the testimony that persons were actually deceived, but also from an examination of the dishes themselves. Their general appearance is so similar that a minute and careful inspection is required to distinguish the differences.

In 1914 in *Mygatt v. Schaffer* (218 Fed. Rep., 827; 134 C. C. A., 515) this court had before it a design patent for a prismatic glass reflector. In this case the *Tatum* case was not referred to. We held it not necessary that the alleged infringing article should be an exact copy of that of the patent to sustain a charge of infringement of design patent. There was nothing said in the opinion which has any bearing upon the question now under consideration.

In 1915 in *Ashley v. Weeks-Numan Co.* (220 Fed. Rep., 899; 136 C. C. A., 465) this court again had before it a design patent for an inkstand. But in this case there was a written specification, and we held that the patentee was not limited to the precise article shown in the drawing, but was entitled to the protection of the court

against the making and marketing of inkstands which contained the dominant features of the design described in the specification.

(4) The court agrees with the statement of plaintiff's counsel that, so far as the claim of the design patent is concerned, the plaintiff is entitled to the usual range of equivalents with respect to known prior unessential details, so that the figure shown is clearly included within the claim of the patent, whether the doll is provided with painted hair, real hair, bathing-cap, military or naval cap, or any other standard form of head-dress, since all of these were well-known equivalents in the actual art to which this patent relates.

The decision in *Ashley v. Tatum* did not enunciate a rule of law applicable to all design patents, but a rule applicable to the type of case then before the court, in which, on the face of the exhibits, the article of the design patent and the article alleged to be infringed were so clearly distinguishable that no likelihood existed of one being mistaken for the other. That case differs from this, in that in this case the article of the design patent and the article alleged to be infringed so closely resemble each other that there is a likelihood of the one being mistaken for the other by the ordinary observer. Where this is the case, infringement is made out, and the rule laid down in *Ashley v. Tatum* does not apply.

The decree is reversed, with costs, and the court is directed to reinstate the bill and to grant the relief prayed.

[U. S. Circuit Court of Appeals—Second Circuit.]

A. KIMBALL CO. v. NOESTING PIN TICKET CO.

Decided December 16, 1919.

278 O. G., 709; 262 Fed. Rep., 148.

1. PATENTS—ATTRIBUTES OF "INVENTION" STATED.

While patentable "invention" is not a term of legal art or capable of judicial definition, yet it is a means only, or the embodiment of the inventive idea, and merits the title, even if the want it meets is not apparent until some previous invention, imperfectly satisfying the more universal want, discloses the subordinate and narrower need.

2. SAME—PATENT FOR PIN-TICKET DEVICE VALID.

The Thompson patent, No. 1,252,862, for an improved pin-ticket device to be attached to textile and other articles offered for sale, *Held* valid against the contention that it did not disclose invention.

3. SAME—WHEN MECHANICAL SKILL BECOMES INVENTION STATED.

As a mechanic is one who applies his trade by rule or rote and only uses what he learned yesterday to do the work of to-day, it may become invention where a mechanic uses insight or foresight to comprehend a problem and uses even the learning of yesterday to do new things in a new way.

APPEAL from the District Court of the United States for the Southern District of New York.

Patent infringement suit by the A. Kimball Company against the Noesting Pin Ticket Company. *Decree for plaintiff, and defendant appeals. Affirmed.*

STATEMENT OF THE CASE.

Action is upon Patent 1,252,862, issued to Eugene W. Thompson January 8, 1918. The subject of invention is a "pin ticket," which means a card or tag intended to bear price marks or other descriptive matter, and affixed to articles offered for sale (usually textile), by means of a piece of wire, so formed as to present a staple whose prongs pass through both card and cloth; but the base of said wire staple is so formed and prolonged (at right angles to the staple-points) as to embrace (when bent) the conjoined edges of the pierced cloth and card. The staple ends are then also bent over or back against the rear face of the card.

Of the claims in suit, the sixth defines the invention in most general terms, and is as follows:

In a pin ticket having a plurality of round-pointed double-shank pins formed of a single piece of wire, the wire between said pins engaging with the ticket to form a support therefor, the shank of said pins passing through the ticket, and the free ends of the wire being bent to engage with both surfaces of the ticket to hold the pins in engagement therewith.

The seventh claim is not sufficiently different to require quotation. The court below found the patent valid and infringed; defendant appeals.

Mr. Cyrus N. Anderson and Mr. Walter K. Earle for the appellant.
Mr. Nathan Heard and Mr. Abr. A. Silberberg for the appellee.

Before WARD, ROGERS, and HOUGH, Circuit Judges.

HOUGH, *Cir. J.*, (after stating the facts as above:)

Appellant states that the only substantial question here presented is validity; *i. e.* can invention be found in this "pin ticket?"

We accept the statement, and shall endeavor to answer the query, without bolstering decision by dwelling on the presumption attaching to grant of letters, or the admitted fact that defendant controls and manufactures under another patent, over which priority was awarded Thompson after a protracted interference. Such proceedings assume a belief in validity on the part of both contestants. (*Roth v. Harris*, 168 Fed. Rep., 279; 93 C. C. A., 581.)

(1) Invention, as we are instructed by the highest court, is not judicially to be defined; *i. e.*, it can not be determined as to limit of meaning. But many attributes may be marked. Thus patentable invention is a means only; it is the embodiment of the inventive idea

(*Corrington v. Westinghouse, etc., Co.*, 178 Fed. Rep., 715; 103 C. C. A., 479); and even the smallest invention, if it merits the title, must meet an existing want, yet that want, invoking invention, may never be apparent until some previous invention, imperfectly satisfying the more universal want, discloses the subordinate and narrower need (1 Rob. on Pats., 134).

It is this thought that justifies, and indeed compels, study of the prior art, as distinguished from anticipatory patents or uses. To know, not only what the "more universal want" was, but how far and by what means it had been supplied, is a process not seldom resulting in the validation of modest inventions, and the destruction of many of great pretense.

This indicates that "invention" is not a term of legal art, like "common carrier" or "contingent remainder;" nor can applicability be fixed by consulting dictionaries, while reports furnish, not precedents, but only illustrations. What does connect the large word with the perhaps small thing is evidence; and litigations like this become studies of facts, as varying in patent matters as in other human contests.

(2) This record shows that, trivial as the article seems (*e. g.*) to ourselves, pin-tickets have long been a widely-used trade adjunct; also that much effort has been expended to produce them cheaply in quantity, yet affixable to a fabric's edge firmly and with ease, without pricking the operator or injuring what is marked.

The "more universal want" has been and still is largely supplied by the "Empire ticket," made under an expired patent (St. John, 340,961). The substantial difference between that ticket and Thompson's device is that the prongs of the latter's staple are formed, not by cutting a wire transversely and making thereby a sharp point, but by doubling the wire back on itself and so producing a smooth, blunt point.

The Bayer reissue, 13,769, shows that making smooth-pointed pins by doubling a small wire on itself was known before Thompson; no more is claimed for it. But the tool which rapidly and cheaply makes staple-points by cutting wire may leave burs or roughened edges, which, though usually negligible, cut (*e. g.*) delicate silk.

Thus the "narrower need" is disclosed, and Thompson is confessedly the first to supply it. Others have tried to; probably Bayer did; but his pin could not hold its ticket firmly, and devices clutching or binding, but not piercing, the fabric, have been put on the market, but without covering the ground.

Here, then, is a want shown to have long existed among intelligent merchants, whose desires are always studied by equally intelligent manufacturers, and the question recurs whether to furnish the means of supplying that want is invention.

(3) It is, of course, urged, and naturally, that no more than a mechanic's skill was needed to take the final step. But a mechanic is one who applies his trade by rule or rote, and only uses what he learned yesterday to do the work of to-day in the same old manner. He may do it excellently, but if he has, not only hindsight, but insight or foresight, first to comprehend the problem and use even the learning of yesterday to do the new thing in a new way, that mechanic has usually earned the inventor's title.

This is what Thompson has done, if the matter be reasoned from the premises of evidence. It is, however, an important evidential element that the trade world to which this little device must appeal, whether of manufacturers or buyers, evidently regards it as important. That word is always relative, and courts and juries should learn its meaning from the evidence, and not their own emotions.

Thus guided by the evidence, we find as matter of fact that the patent discloses invention, and in so doing we arrive at a result not new in this court, and do it in substantially the same way as heretofore. (*George Frost Co. v. Cohn*, 119 Fed. Rep., 505; 56 C. C. A., 185; *David v. Harris*, 206 Fed. Rep., 902; 124 C. C. A., 477; *Barry v. Harpoon, etc., Co.*, 209 Fed. Rep., 207; 126 C. C. A., 301; *Fonseca v. Suarez*, 232 Fed. Rep., 155; 146 C. C. A., 347.)

The decree is affirmed, with costs.

[U. S. Circuit Court of Appeals—First Circuit.]

BACKSTAY MACHINE & LEATHER CO. v. HAMILTON.

Decided January 6, 1920.

278 O. G., 710; 262 Fed. Rep., 411.

1. PATENTS—ENTIRE PRIOR ART CONSIDERED ON APPEAL IN DETERMINING VALIDITY, REGARDLESS OF CLAIM IN LOWER COURT.

Although appellant assigned as error that the court below erred in holding the patent in suit anticipated by a particular patent and lower court stated that no device except that particular patent embodied plaintiff's device, nevertheless the court on appeal will consider the entire prior art as disclosed by the whole record.

2. SAME—INVENTION FOR FINISHING-WELT ANTICIPATED.

The Schemmel patent, No. 1,226,600, claims 1, 2, 5, and 6, of May 15, 1915, for a finishing-welt, *Held* invalid because anticipated.

3. SAME—INVENTION FOR FINISHING-WELT HELD INVALID.

The Schemmel patent, No. 1,226,600, claims 3 and 4, of May 15, 1917, for a finishing-welt, is invalid because for a combination of the article claimed to have been invented with some other article which the inventor does not describe.

4. SAME—DESIGN FOR MOLDING OR WELT VOID FOR LACK OF INVENTION.

The Schemmel design patent, No. 51,804, for a design for a molding or welt, *Held* void for lack of invention.

APPEALS from the District Court of the United States for the District of Massachusetts; George H. Bingham, judge.

Two patent infringement suits by the Backstay Machine & Leather Company against Helen Wade Hamilton. *Decrees for defendant, and plaintiff appeals. Affirmed.*

Mr. William E. Dyre (Mr. Henry D. Williams and Mr. George K. Woodworth on the brief) for the appellant.

Mr. W. Orison Underwood for the appellee.

PATENT appeals Nos. 1423 and 1424.

Before JOHNSON and ANDERSON, Circuit Judges, and ALDRICH, District Judge.

JOHNSON, *Cir. J.*:

These were appeals from the final decrees of the District Court of Massachusetts in two patent cases. In one the plaintiff alleged infringement of Patent No. 1,226,600, issued May 15, 1917, to R. C. Schemmel, for a finishing-welt, hereinafter referred to as the article patent; and in the other infringement of Patent No. 51,804, issued February 19, 1918, to R. C. Schemmel, for a "design for a molding or welt," hereinafter referred to as the design patent.

There were six claims in the article patent, all of which were in issue. Under claims 1, 2, 5, and 6 a patent was claimed for a welt or molding constructed so that two longitudinal, parallel beads superimposed close together upon a base could be separated, the base between them nailed, stitched or otherwise sewed, to any article to cover rough joints, and then the beads, because of their resiliency, made to assume their former positions, thus hiding the tacks, stitches, or other securing means.

In his application the patentee thus described his invention:

My present invention pertains to the finishing of leather and analogous work as used on vehicles and in other connections; and it contemplates the provision of a finishing welt constructed and arranged with a view to being readily nailed, stitched or otherwise attached to the article by which it is carried in such manner that subsequently to the nailing, stitching or other attachment, the welt can be made to assume or assumes of itself such a state that the attaching means will be entirely hidden from view and the finished appearance of the work as a whole will be enhanced.

Claim 1 of the patent is as follows:

As a new article of manufacture, a welt comprising a body, and longitudinal parallel beads superimposed on and connected with the body, the body being constructed and arranged to permit of the beads being spread apart and subsequently resuming their normal close-together positions, for the purpose set forth.

Claims 2, 5, and 6 were substantially like claim 1.

Claims 3 and 4 were for a combination of an article, without describing any particular article, and the welt described in claim 1 and "attaching means" by which the welt could be attached to the article.

The court below found claims 1, 2, 5, and 6 void for lack of invention and anticipated, and claims 3 and 4 invalid. The reason for the finding of the court in regard to the latter claims was stated as follows:

It does not seem to me that the third and fourth claims are valid; the invention, if any, resides in the welt and cannot be held to extend to and include any and every article to which the welt may be attached.

The design patent was for "the ornamental design for a molding or welt as shown," the one "shown" being that described in the article patent. This was found void for lack of invention.

The errors assigned in the suit upon the article patent are:

(1) The court erred in holding claims 1, 2, 5, and 6 void for lack of invention over Patent No. 221,801, issued November 18, 1879, to A. B. Felt.

(2) The court erred in holding claims 3 and 4 void for the reason that the invention, if any, resides in the welt, and cannot be held to extend to and include any and every article to which the welt may be attached.

(5) The court erred in dismissing the bill of complaint, with costs to the defendant.

The other errors assigned were that the court erred in finding that the claims of the patent in suit were not infringed.

In the suit upon the design patent the errors assigned were:

(1) The court erred in holding the patent in suit void for lack of invention over the prior art offered in evidence by the defendant.

(4) The court erred in dismissing the bill of complaint, with costs to the defendant.

Errors 2 and 3, not given, related to infringement.

(1) The appellee contends that the validity of the article patent is not open on appeal, because the appellant, in his assignment of errors, has set out as error, not the decision, but the reason of the court, given in his opinion, for finding that claims 1, 2, 5, and 6 are void for lack of invention.

It is true that the learned judge sitting in the district court states in his opinion:

Moldings or welts of the character here under consideration pertain to the art of upholstering. Concealed tack moldings are old, and have been made in various forms; but none of the devices that have been called to my attention, with a single exception, have embodied the characteristics of the plaintiff's device. The exception to which I refer is the product of a machine upon which a patent was granted to Alvin B. Felt, November 18, 1879, in United States Letters Patent No. 221,801.

While the appellant has alleged that the court below erred in holding that the patent in suit was anticipated by the patent to Felt,

and although it was said by that court in its opinion that no other devices called to its attention "embodied the characteristics of the plaintiff's device," we think, upon appeal, we are not confined to a consideration of the patent to Felt only, but that we should consider the prior art as disclosed by the whole record. (*Electric Gaslighting Co. et al. v. Fuller et al.*, 59 Fed. Rep., 1003; 8 C. C. A., 422; Walk. on Pats., 5th Ed., sec. 655; *Brown v. Piper*, C. D., 1876, 464; 10 O. G., 417; 91 U. S., 37; *Slawson v. Grand Street R. R. Co.*, C. D., 1883, 313; 22 O. G., 99; 107 U. S., 649; 2 Sup. Ct., 663.)

We find, upon referring to the opinion, that the court below took into consideration, in determining whether the patent in suit was anticipated, not only the patent to Felt, but also the fact that "concealed tack moldings are old and have been made in various forms." We are entirely satisfied with the conclusion reached and the reasons stated in the opinion, which we quote:

In that patent (the patent to Felt) it states that the cording attachment for sewing machines for which he sought a patent related "to the manufacture and application of corded strips to various articles or fabrics," including "trimmings for dresses, for cording seams of military trousers or the edges of cushions, and for other purposes."

The cording produced by this machine is shown in defendant's Exhibit 23 and plaintiff's Exhibit W. It discloses two parallel beads or cords superimposed upon a base and close together, only one of which is capable of being moved back from the other, and, on being released, resuming or tending to resume its normal or close position to the other bead or cord. To make this corded structure into a finished welt it would only be necessary to turn under and secure the edges of the base as shown in plaintiff's Exhibit B introduced in evidence. This would involve nothing more than the use of mechanical skill, and that not of a high order. Although in the article produced by the Felt machine only one of the cords is capable of being moved back in relation to the other, and on being released of resuming its normal position, while in the structure of the plaintiff's patent each cord is capable of being moved back and again resuming its normal position, this is due to the positioning of the cords or strips. The principle by which it is accomplished is the same in both, and is clearly shown in the Felt construction.

The language of Judge Sanborn in considering a similar question in *Warren Webster & Co. v. Dunham Co.*, C. D., 1910, 490; 161 O. G., 531; 181 Fed. Rep., 836; 104 C. C. A., 346, seems to me applicable. He there said:

"Where a machine or a combination is discovered in a remote art, where it is used to perform a different function, and where it was not designed and was not apparently suitable to accomplish the thing desired, the application of it with proper mechanical adaptation to a new use is often the result of the exercise of the inventive faculty and may be protected by patent. But the thought that an existing machine or combination, discovered in the same art or one nearly analogous to it, designed and suitable to perform a similar function, may be used or adopted to accomplish the desideratum, is not the product of inventive genius, but the result of the application of the skill of the mechanic to the subject under consideration. It is only when the new use is so recondit and remote from that to which the old device and combination has been applied, or for which it was conceived, that its application would

not occur to the mind of the ordinary mechanic skilled in the art, seeking to devise means to perform the desired function, with the old machine or combination before him, that its conception may rise to the dignity of invention."

(2, 3) We therefore think there was no error in finding that claims 1, 2, 5, and 6 of the article patent lacked invention, because anticipated by the patent to Felt, and by the prior art as disclosed by the record; nor do we find that there was any error in finding that the third and fourth claims were invalid. These claims are not for an article of manufacture, but for the combination of the article which the inventor claims to have invented with some other article which he does not describe, and we think the court correctly held that—

the invention, if any, resides in the welt, and cannot be held to extend to and include any and every article to which the welt may be attached.

(4) In considering the design patent the court below said:

The question presented, so far as the validity of the design patent is concerned, is whether the patentee in his article patent having conceived of a welt having a base with superimposed parallel beads or raised portions, mechanically constructed to function in a given manner, which may be of various shapes, and beads of some shape being essential to the functioning of the device, can be said to have exercised inventive thought of a character sufficient to warrant a design patent for a welt with beads or raised portions circular in cross section. It seems to me that to state the question is to answer it; that, having devised an article of manufacture with a base having parallel beads which may be of any suitable shape and beads of some shape being essential to constitute the article, it cannot be invention warranting a design patent to conclude that they should be round in cross section rather than some other suitable shape.

Furthermore, the use of beads or raised portions, circular in cross section, in connection with moldings, whether superimposed upon a base or not, is of such long standing that I cannot on the evidence regard the use made of them by the patentee in his design as disclosing inventive thought. (*Tubular Rivet & Stud Co. v. Standard Fencing Co.*, 281 Fed. Rep., 170; 145 C. C. A., 858.) The conclusion reached renders it unnecessary to consider whether the design patent was an attempt at double patenting or not.

We see no occasion for disagreeing with the finding involved in this statement, or for adding anything to the reasoning by which it is sustained.

In each case—

The decree of the district court is affirmed, with costs to the appellee in this court.

[U. S. Circuit Court of Appeals—Seventh Circuit.]

JAY *et al.* v. WEINBERG *et al.**Decided April 29, 1919; rehearing denied December 5, 1919.*

278 O. G., 712; 262 Fed. Rep., 973.

PATENTS—INVENTION—ANALOGOUS USE—VACUUM SUCTION DEVICE FOR AUTOMOBILES ANTICIPATED BY WATER-LIFTING DEVICES.

The Higginson and Arundel patent, No. 1,067,814, and the Jay patents, Nos. 1,132,273 and 1,134,457, for vacuum suction devices for raising gasoline in an automobile from a main tank below the level of the carburetor to a secondary tank, *Held* anticipated by prior devices for lifting water from a lower to a higher level, which is not an analogous but the same art.

APPEAL from the District Court of the United States for the Eastern Division of the Northern District of Illinois.

Suit in equity by Webb Jay and the Stewart-Warner Speedometer Corporation against Frederick Weinberg and the Auto Parts Company. *Decree for defendants, and complainants appeal. Affirmed.*

For opinion below see 250 Fed. Rep., 469.

Mr. Charles Burton and *Mr. George L. Wilkinson* for the appellants.

Mr. R. A. Parker for the appellees.

Before BAKER, Circuit Judge, and LANDIS and ENGLISH, District Judges.

BAKER, *Cir. J.*:

This is an appeal from a final decree dismissing appellants' bill for infringement of the Higginson and Arundel patent, No. 1,067,814, and the Jay patents, Nos. 1,132,273 and 1,134,457, for vacuum suction means of raising gasoline in an automobile from a main tank below the level of the carburetor into a secondary tank from which gasoline flows to the carburetor by gravity.

(1) The trial court found that in the water-elevating art the principle of operation whereby a fluid is lifted by vacuum suction and discharged by gravity, and the general combinations of mechanical means for attaining the result, were old and well known long before appellants' patentees began their labors; that appellants' patentees, starting from this common ground, had made certain specific improvements which they were entitled to have protected; that the appellees, operating under Weinberg's patent, No. 1,229,360, had started from the same common ground and had made certain specific improvements; and that appellees' improvements do not overlap any of appellants'.

Consideration of the record, briefs, and oral argument, has led us to approve the findings of the trial court and the reasons therefor

as expressed at length in *Jay v. Weinberg*, (D. C., 250 Fed. Rep., 469.)

The exigencies of the case have caused appellants to contend that—the water-elevating art is too remote from the internal combustion engine art to warrant imputing knowledge of expedients in the former to persons engaged in the latter art.

No problem of the internal-combustion engine is present. To the gravity-fed carbureter it is immaterial where the feed-tank gets its supply. So appellants' insistence is that the art of elevating water from a lower to a higher reservoir is not analogous to the art of elevating gasoline from a lower to a higher reservoir. We agree that the arts are not analogous; they are identical.

(2) Where the general art has been developed by the pioneers, there is room for an adapter to have only a specific patent for his particular form of adaptation, and he is not privileged to exclude others from gleaning in the same open field. (*Loew Supply Co. v. Fred Miller Brewing Co.*, 138 Fed. Rep., 886; 71 C. C. A., 266.)

The decree is affirmed.

[U. S. Circuit Court of Appeals—Sixth Circuit.]

HIGGIN MFG. CO. v. WATSON *et al.*

Decided February 3, 1920.

279 O. G., 177; 263 Fed. Rep., 378.

1. PATENTS—FOR REWIRABLE SCREEN CONSTRUCTION VALID, BUT NOT INFRINGED.

The Watson patent, No. 956,239, for rewirable screen construction, *Held* valid, as involving a degree of invention over the prior art, but claims Nos. 3, 10, 11, 12, and 13 not infringed by a structure manufactured under the Higgin patent, No. 1,171,952.

2. SAME—EARLIER ISSUED PATENT WAS PRIOR ART, THOUGH LATER PATENTEE CARRIED INVENTION BACK OF ISSUE DATE.

A patent actually issued before plaintiff's patent was applied for was a part of the prior art as to plaintiff, though plaintiff carried his invention back of the issue date of the earlier patent but subsequent to the filing date thereof.

3. SAME—ANSWER IN INFRINGEMENT SUIT HELD TO SUFFICIENTLY ALLEGE PRIOR PATENT AS ANTICIPATION.

An allegation in the answer in a patent infringement suit that all the substantial and material parts of plaintiff's structure were, prior to the date of the alleged discovery or invention thereof, or more than two years prior to the date of the applications, invented, patented, described, and shown in numerous patents and printed publications, and more particularly in certain patents mentioned, including one to B., sufficiently pleaded the patent to B. as an anticipation.

4. SAME—AMENDMENT OF CLAIM TO MEET OBJECTION OF DOUBLE PATENTING IS BINDING ON PATENTEE.

An amendment of a patent claim to meet the Commissioner's objection of double patenting is as binding on the patentee as an amendment to avoid rejection on the prior art, especially as the limitation, if intentionally made, would be binding, though voluntary.

5. SAME—PATENT FOR IMPROVEMENT IN REWIRABLE SCREENS HELD INVALID IN PART, AND VALID AND INFRINGED IN PART.

Claims 1 and 2 of the Watson patent, No. 836,475, for an improvement on the tubular construction of rewirable screen frames, *Held* invalid as involving no more than the skill of a mechanic trained in the sheet-metal art, but claim 3 valid and infringed by a structure manufactured under the Higgin patent, No. 1,171,952.

6. SAME—COPENDING APPLICATION IS NOT PRIOR ART, THOUGH LATER APPLICATION PURPORTS TO COVER IMPROVEMENT THEREON.

The rule that where two patents are granted on copending applications of the same inventor, neither of which claims any invention claimed in the other, the one later granted, but earlier applied for, cannot, in determining invention, be considered prior art as against the later-applied-for but earlier-issued patent, is not changed by the fact that the later application purports to cover an improvement on the invention embraced in the earlier application.

7. SAME—EQUIVALENTS—SPOT-WELDING AND RIVETING—BRAZING.

Spot-welding and riveting are each the equivalent of brazing.

8. SAME—SLIGHT CHANGES—BRAZING OR WELDING PARTS TOGETHER—STRENGTHENING.

A frame for a rewirable screen construction, (Watson patent, No. 836,475,) each side and end being constructed from a metal sheet having an edge bent around in the form of a tube rectangular in cross-section, the free edges being brought against a flat portion of the metal and welded or brazed thereto, *Held* devoid of invention over a prior structure of a similar nature, except that the free edge did not quite contact with the flat metal part, as it did not involve invention to extend the edge a little to make a complete tube and secure the parts together by brazing or welding, even though a structure of greater rigidity was produced.

9. SAME—TIME FOR FILING DISCLAIMER AFTER DECISION OF APPELLATE COURT.

Decree of the district court holding claims of the Watson patent, No. 836,475, valid and infringed reversed as to claims 1 and 2 and an injunction and accounting granted as to claim 3, conditioned upon abandonment of the claims found to be invalid; plaintiffs given thirty days after filing of the mandate below, or such further time as the district court may allow, in which to show that claims 1 and 2 have been abandoned. (*Herman v. Youngstown*, 191 Fed. Rep., 579.)

APPEAL from the District Court of the United States for the Eastern District of Kentucky; Andrew M. J. Cochran, judge.

Suit by Henry W. Watson and others against the Higgin Manufacturing Company. *From an interlocutory decree for plaintiffs; defendant appeals. Reversed and remanded, with directions.*

Mr. Edward Rector for the appellant.

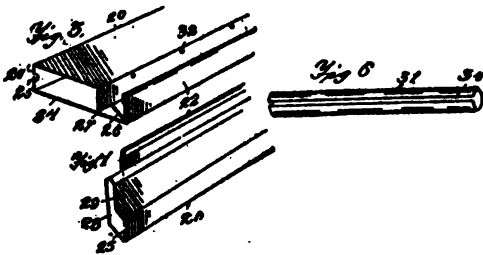
Mr. Livingston Gifford and *Mr. J. William Ellis* for the appellees.

Before KNAPPEN and DENISON, Circuit Judges, and McCALL, District Judge.

KNAPPEN, *Cir. J.*:

Suit for infringement of two United States patents to Watson, viz., No. 956,239, applied for July 27, 1905, and issued April 26, 1910; and No. 836,475, applied for October 30, 1905, and issued November 20, 1906. Both relate generally to rewirable screen construction for doors, windows, and the like openings, and particularly to a tubular sheet-metal frame, and means for attaching the screen-cloth thereto. No. 956,239, while issued later, was applied for earlier than the other. It is thus properly treated as the earlier patent, and is in fact the main or basic patent—No. 836,475 being for specific improvements upon the construction shown in the then pending application for the main patent. The appeal is from an interlocutory decree finding both patents valid and infringed.

(1) 1. The specification of the main patent (No. 956,239) discloses a frame having along its inner edge a lengthwise recess (for holding the wire-cloth and its retaining strip,) formed by extending both edges of the strip from which the tubular part of the frame is formed into a lengthwise angular flange, the inner edge of the sheet metal being left short and the outer edge extending inwardly over it and forming a locking edge, which thus slightly narrows the mouth of the recess. The retaining-strip as shown takes the form of a metallic tube, divided along one side, thus enabling it to be so compressed as to enter the narrowed mouth of the recess. This construction is sufficiently shown by the reproduced Figs. 3 and 6 of the patent drawings—the former being a perspective view of one of the ends of the frame sides; the latter, a like view of the “tubular spring locking strip.”



There was nothing novel in the idea of a rewirable screen-frame, whether of wood or of sheet metal, having a recess therein for holding the screen-cloth, and a removable retaining-strip. Wooley (1870) disclosed a wooden tongue or stay-rod in a groove in a wooden frame. Whittaker (1886,) disclosed a retaining-strip in the form of a rope or flexible packing. Connell (1888) showed a sheet-metal frame in tubular form; the retaining member being a non-removable, resilient

spring. Baker (1901) disclosed a non-removable gripping or clamping device in a metallic frame; the frame proper, as distinguished from the recess, not being closed, although substantially rectangular, and being stiffened by a rod therein. Baker, however, by Patent No. 787,818, applied for June 5, 1904, and issued April 18, 1905, showed a sheet-metal frame having a recess formed by an extension of one side only of the frame, a locking outer edge of the recess portion formed by an inward turn of the extended frame side, the tube and recess being thus formed from a single sheet, and having a removable sheet-metal retaining strip or spline, which differed from a wide-mouthed slotted tube in having its outer edge slightly upturned to engage (by slipping under) the outer (hooked) edge of the recess-wall, and provided to be "sprung into place" by compression against the inner side of the groove, and, by expansion, to hold the screen-wire in position, as indicated by Figs. 3, 4 and 8 of the patent drawings here reproduced, the first of which figures shows the retaining-strip in place; the second, with the parts of the frame separated; and the third, the manner of assembling. The specification states that the "stiffener rod" shown in each of these three figures may be omitted.



(2, 3) The second Baker patent was thus clearly prior art as to Watson; the former having been actually issued before Watson's patent was applied for. The fact that Watson carries his invention back of Baker's issue date, but subsequent to Baker's application, is not important under the rule recognized by this court. *Lemley v. Dobson-Evans Co.*, 243 Fed. Rep., 391; 156 C. C. A., 171, and cases cited.) We see no substantial merit in the proposition that the Baker patent was not pleaded. We think plaintiff could not fail to understand that Baker was claimed to be the first and true inventor of the device of the patent sued on. Although the answer does not expressly so state, we think it fairly implied.¹ But, even if not sufficiently pleaded as an anticipation, the second Baker patent is before us as part of the prior art. In fact, as will be seen, it was cited in the Patent Office as a reference against Watson's application.

¹ The allegation is that "all substantial and material parts thereof were, prior to the date of the alleged discovery or invention thereof by the said * * * Watson, or more than two years prior to the date of applications for said Letters Patent, invented, patented, described and shown in numerous Letters Patent and in numerous printed publications and more particularly in the following Letters Patent of the United States," among which is the Baker patent in question.

The device of Watson's main patent marked an advance over that of Baker's second patent; for, while each has a frame formed of a sheet-metal strip bent in tubular form, with a recess for the retaining strip or spline, formed by the extension of the strip which forms the tube, and the recess of each has an outer locking edge, yet Watson's extension of both edges of the tubular part of the frame, in forming the recess, practically, though not with strict accuracy, closes the tubular portion, giving a desirable feature of rigidity to both the tube portion and the recess part, thus increasing rigidity without increasing weight of the sheet metal used. (While the patent discloses other features of rigidity, they are not involved here.) Watson's spline, as described, also differs from that of Baker in the respects before mentioned, and is, we think, an improvement on it; the commercial history of Watson's device indicates that the features referred to had substantial utility; and we are disposed to regard his main patent as involving a degree of invention over the prior art. The claims in issue are Nos. 3, 10, 11, 12, and 13. The third claim reads as follows:

3. In a window screen, a frame consisting of sheet metal strips bent in tubular form, the length-wise edges of said strips formed in a recess, screen-wire, and a retaining strip consisting of a metal tube divided along one side to form separated edges, said tube adapted to fit said recess.

The tenth, eleventh, twelfth, and thirteenth claims were not contained in Watson's original application. The tenth claim was framed as the result of an interference between Watson and McFarland, and, on priority being awarded to Watson, the eleventh, twelfth, and thirteenth claims were inserted. The tenth claim is as follows:

10. In an improved window screen, the combination of the frame with grooves enlarged inwardly, the resilient slotted tubes forming a filling piece adapted to be inserted in said groove, the wire fabric to be engaged therein, substantially as described.

The differences between claim 10 and the three following claims, so far as seems important here, are these: In claim 11 the locking-bar is characterized as—

a resilient tubular locking strip, engaging and holding the fabric in said recess; said locking strip being longitudinally split to form separated adjacent edges, permitting the strip to expand and contract upon the application and release of pressure.

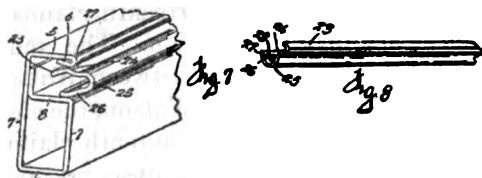
In the twelfth claim the locking member is described as—
being closed on all sides except one, with the edges of the inclosed side normally out of contact to enable the locking member to be pressed into said groove and to therein expand and lock the wire screen in place.

In the thirteenth claim the locking members are described as—
tubular members with edges separated along one side, said members adapted to be compressed into the grooves to bind the edges of the screen fabric against the walls thereof.

It will be seen that neither of the last four claims is in terms confined to a frame of tubular form, or even to one made of sheet or other metal, or to one having a recess formed by the extended walls of the frame proper, and that the specific and dominating element of each of these four claims is the resilient spline.

The alleged infringing structure (put out in 1915, and manufactured under Higgin's patent, No. 1,171,952, February 15, 1916, applied for to meet the demand for rewirable screens) differs from the disclosure of plaintiff's main patent, as shown in Figs. 7 and 8 (here reproduced) of the drawings of the Higgin patent.

The differences are (a) that in defendant's construction, so far as shown in Fig. 7 below, one of the edges of the sheet-metal from which the tubular part of the frame is constructed is extended only about three-fourths of the way across the floor of the recess; and (b) the retaining member, instead of being in split tubular form, adapted to be sprung past the locking edge, has a cam-shaped edge adapted for insertion past the locking-edge of the recess, whereupon the spline is rocked into position therein. Infringement turns upon the question whether plaintiff's patent, in view of the prior art, and its office history, is entitled to be construed broadly enough to cover defendant's construction.



We think it beyond doubt that the tenth, eleventh, twelfth, and thirteenth claims each call for a resilient slotted tube, whose resiliency is necessary to its insertion into the recess, and which assists in locking the screen-cloth therein. It follows that unless defendant's spline is the equivalent thereof, neither of these four combination claims is infringed.

While the language of claim 3—

a retaining strip consisting of a metal tube divided along one side to form separated edges, said tube adapted to fit such recess—

does not in express terms call for a resilient tube requiring compression to enable it to enter the channel, yet when considered, as it should be, in connection with the statement in the specification that the screen-wire is attached to the frame in the channel

by means of a tubular spring strip 31 which is formed of a strip of sheet metal bent in tubular form, with the edges a slight distance apart as at 34, so that they may spring together when pressed into channel 21,

such resiliency is by natural and normal construction called for; and the natural implication would be that the resilient "retaining strip," being intended to hold the screen-cloth by engaging it within the channel, was intended to fit the latter closely.

(4) Plaintiff contends, however, that claim 3 is not limited to a resilient strip. The Patent Office history of this feature of the third claim is this: The last clause of the claim as originally filed read—
and a retaining strip *formed of a folded strip of sheet metal to fit said recess.*

The claim was rejected on the second Baker patent, and was amended by substituting the words "consisting of a metal tube to fit said recess," in place of the italicized words above. After the claim had been formally allowed, and after the interference was disposed of, the words "divided along one side to form separated edges" were inserted, to meet the Commissioner's objection of double patenting, by reason of certain claims of Watson's improvement application. While Watson was thus not compelled to make the change to avoid rejection upon the prior art, he was required to make it in order to meet an objection which, if persisted in and sustained, would result in the disallowance of the claim.

On principle, we can see no controlling difference between an amendment so made and one made because of the prior art. We think Watson clearly bound by the language of his claim. It not only harmonizes with the express language of his specification, but, even if the limitation might be thought voluntary, it would be none the less binding if intentionally made. (*McClain v. Ortmyer*, C. D., 1891, 532; 57 O. G., 1129; 141 U. S., 419; 12 Sup. Ct., 76; *Cimioti v. American Co.*, C. D. 1905, 729; 116 O. G., 1452; 198 U. S., 399; 25 Sup. Ct., 697; *Ohmer v. Ohmer*, C. C. A., 6; 238 Fed. Rep., 182; 151 C. C. A., 258.) And that such was the intention is not open to doubt. It may further be noted that (by contrast with claim 3) in certain of the claims not in suit (Nos. 1, 2, 5, 6, and 7) the form of the retaining-strip is not an element. It should go without saying that the third claim is not infringed, unless defendant's retaining member is the equivalent of plaintiff's.

In view of the prior art, we think such equivalency is lacking. The metal of which defendant's spline is made is slightly resilient, and so is the spline itself; but the resiliency is apparently not enough to have substantial operative effect. The contrast with plaintiff's spline in this respect is sharp. True, defendant's spline, in the process of rocking into the channel, requires substantial force, to effect a compression of the screen-cloth, and is to some extent locked in place through the screen-cloth's resiliency; but the latter's resiliency is not the equivalent of plaintiff's slotted tube, for the latter (as in the case of all splines used for this purpose) has, to begin with,

the benefit of the screen-cloth's resiliency, and to this resiliency that of plaintiff's spline is an added and dominating feature. Nor, in our opinion, is the cam feature and operation of defendant's spline the equivalent of plaintiff's compressible and resilient spline. The former is not substantially (although it may be slightly) compressed in entering the channel, nor has it been found in practice to be securely enough held therein without the use of pins. Indeed, the pull of the screen-cloth seems to result in drawing the cam edge of the spline more firmly against the inner wall of the channel, and thus the outer edge of the spline away from the channel's outer wall, and without substantial resilient action in the spline. Were Baker's second patent not prior art (the learned district judge thought it was not), the result might be otherwise. But, in view of Baker, plaintiff's invention cannot, in our opinion, be construed broadly enough to embrace defendant's structure. The latter's spline has in fact as much substantial resemblance to Baker's as to plaintiff's. We therefore think defendant has not appropriated the device of plaintiff's main patent.

(5) 2. Plaintiff's improvement patent (No. 836,475) is confined to means for stiffening and strengthening the tube and channel disclosed in the main patent. The invention is stated in the specification to be "an improvement upon the tubular construction shown" in plaintiff's application for their main patent. The stated object is to—

provide means for stiffening and strengthening the tubular sheet metal frame sides and the side channel pieces for the frame to slide in, so that exceedingly light and thin sheet metal can be used without impairing the rigidity of the frame, thus making an exceedingly light and strong screen.

The means disclosed for accomplishing this end consist of, first, spaced reinforcing-ribs pressed into the walls of the tubes and channels, as illustrated in Figs. 2 and 3 here reproduced, which are in substantial effect Figs. 3 and 4 of the main patent, plus the ribs referred to; Fig. 4 (also here reproduced,) a sectional view of the tubular frame sides, being a substantial reproduction of Fig. 5 of the main patent (a special reinforced channel strip is provided for when "an exceedingly strong channel" is needed); and, second, the—
unlting of the two contacting edges which form the angular flange 12 * * * preferably by solder or brazing, so that they are as one, a solid tube as distinguished from a split tube.

This, as stated—

absolutely prevents the slipping of one edge on the other from torsional strain on the screen frame and gives greater rigidity to the construction.

Otherwise than already stated, no construction of frame, tube, or channel, except as shown in the main patent, is disclosed. The claims in suit are the first, second, and third. The first reads:

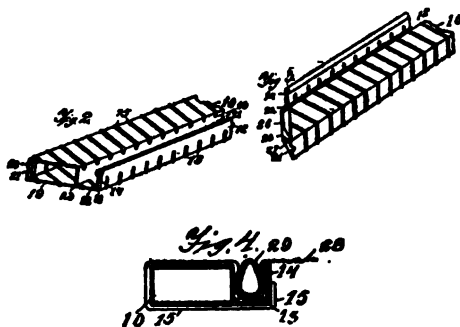
In a metal screen, a frame, the side and end pieces of said frame each *consisting of a solid tube*, a channel along said tube, screen wire, and a locking means to hold said wire in said channel.

Except that in the second and third claims the words "locking strip" are used, instead of "locking means," the second claim differs from the first only in substituting for the words italicized the following:

Composed of strips of bendable sheet metal formed in a brazed tube, and the third in substituting the phrase—

composed of strips of metal formed in a tube with lapped edges, said lapped edges brazed together and formed in [a channel along said tube, etc.].

The only new element in either of the claims in suit is thus the joining (for purposes of greater rigidity) of the two contacting edges of the sheet metal. In our opinion patentable invention was



not involved in the mere brazing or welding or riveting of the contacting edges of the sheet metal to prevent torsional strain. In view of the use of such devices for the same purpose in the sheet-metal art generally, their application to screen-frame construction when the necessity of stiffening or strengthening to prevent such strain appeared would seem to involve no more than the skill of the mechanic trained in the sheet-metal art. (*Johnson v. Toledo Traction Co.*, C. C. A., 6; 119 Fed. Rep., 885; 56 C. C. A., 415.) Baker's second patent disclosed a frame of sheet metal bent in tubular form (although not strictly a closed tube,) with but one edge of the sheet metal extended to form the channel. The first and second claims of Watson's improvement patent contain no reference to a channel formed by an extension of both edges of the sheet metal, or of the strengthening of the channel, except as involved in the closing of the tubular part. Neither of those two claims, therefore, marks any advance over the art prior to Watson, except as the tubular part of the frame is closed by the welding, soldering, or brazing; and this we think involves no invention, even if it was necessary, in order to entirely close Baker's

tube, that the down-turned extension of the upper edge of the sheet metal be slightly extended to accomplish actual contact with the extension of the lower edge.

(6) With respect, however, to the third claim of Watson's improvement patent the case is different, for the invention of his main patent is the earliest one brought to our attention in which the edges of the sheet metal forming the tube are lapped, and thus both extended edges employed in forming the channel, and the third claim of the improvement patent calls for a channel formed by extending both edges of the sheet metal which forms the tubular portion. The validity of the third claim in question thus depends upon the effect accorded to the main patent. On this subject plaintiff contends that the case falls within the general rule, which is recognized by this court, that where two patents are granted on copending applications, neither of which claims any invention claimed in the other, the one later granted, but earlier applied for, cannot, in determining invention, be considered prior art as against the later-applied-for, but earlier-issued, patent. (*Century Co. v. Westinghouse Co.*, C. D., 1914, 267: 207 O. G., 1249; 191 Fed. Rep., 350; 112 C. C. A., 8; *Toledo Co. v. Kawneer Co.*, C. C. A., 6; 237 Fed. Rep., 367; 150 C. C. A., 378.) Defendant contends, however, that as the invention of the second patent was specifically alleged and described as a mere improvement upon the main invention disclosed in the earlier application, it is invalid, if it contains in fact no invention over that disclosed by the main patent. In other words, if no invention is involved in the improvement, it is not a patentable improvement, regardless of the copendency of the applications.

Specific authority apart, this contention is not without attractiveness. The proposition as stated by counsel does not treat the main Watson patent as prior art, except as it requires the invention alleged to be "improved upon" to be considered in determining whether the alleged "improvement" upon it involves inventive faculty, and thus a second invention growing out of the same subject-matter. In the opinions in the following cases (in all of which copending applications were in fact involved, and which impress us as the strongest of the cases cited by defendant) statements are made which on their face lend support to defendant's contention. (*Westinghouse Co. v. New York Co.*, C. C. A., 2; 63 Fed. Rep., 962; 11 C. C. A., 528; *Thomson-Houston Co. v. Ohio Brass Co.*, C. C. A., 6; 80 Fed. Rep., 712; 26 C. C. A., 107; *Willcox & Gibbs Co. v. Merrow*, C. C. A., 2; 93 Fed. Rep., 206; 35 C. C. A., 269; *Thomson-Houston Co. v. Sterling-Meaker Co.*, C. C.; 171 Fed. Rep., 111.) In none of these cases, however, does the copendency of the application appear to have been set up as forbidding the conclusion reached, nor is there anything to indicate that the respective courts had in mind the rule relating to co-

pending applications which we have stated above, and which has received the approval of this court. Moreover, in each of the cases above cited the court was considering and passing upon the validity of the later-issued patent, and its language was thus, strictly speaking, *obiter*, as applied to a case involving a patent earlier issued, and so distinguishable from double patenting. No decision of the Supreme Court directly in point is brought to our attention.

Although the cases cited by defendant give rise to a degree of conflict and confusion, we do not, in view of the considerations to which we have called attention, think we would be justified in accepting them as taking the instant case out of what we believe to be the general and correct rule applicable to copending applications. We are the better satisfied with this conclusion in view of the meritorious nature of the invention of the third claim of the so-called improvement patent; the fact that the extension of the overlapping edges in forming the channel, in connection with their brazing, gives to those two steps a more or less single, although composite character, together with the query whether, in view of the actual nature of the claims of the respective patents in issue here as compared with each other, and the changes made in the course of passing through the Patent Office, too much stress is not laid by defendant upon the characterization of the patent later applied for, but earlier granted, as being for a mere improvement upon the invention of the other patent, which, due to the nature of its dominant retaining member, defendant has been found not to infringe. We are therefore disposed to find the third claim valid.

We think defendant's construction described herein, in connection with the discussion of Watson's other patent, infringes the third claim of the patent we are now considering, even if (as seems to be the case) one of the edges of the sheet metal from which the tubular part of the frame is constructed is extended (in all of defendant's manufacture) for but a portion of the width of the floor of the channel. The extensions of the metal which form the tube are lapped, and the lapped edges spot-welded or riveted together and "formed in a channel along said tube," and the consequent rigidity, although possibly not as great as in plaintiff's invention, is nevertheless substantial, and is apparently sufficient to prevent torsional strain. The lapping accomplishes the functions of closing and stiffening the tubular part, and stiffening the floor of the recess, and gives opportunity for fastening the contracted edges together. Several claims of the patent under which defendant manufactures describe the "sides of the strip" as "contacting and extending laterally to form a side channel," etc. Spot-welding and riveting clearly are each the equivalent of brazing. The language of the claim does not call for a resilient spline, and such call cannot be implied from the fact that the specification de-

scribes and the drawing shows a retaining member in the form of a closed tube, the sides of which, the specification says, "will spring slightly" when pressed into the channel—a construction characterized by defendant as inoperative and useless. The object of the improvement did not extend to the form of the spline, but was confined to means for stiffening and strengthening the frame proper. It is scarcely necessary to add that the alleged superior merit of defendant's structure, in employing spot-welding, instead of soldering (thus enabling a higher firing of the japan,) and the ability to ship the frames in the "knock-down," cut to lengths and ready for assembling, is quite unimportant.

The bill must be dismissed as to Patent No. 956,239, and as to the first and second claims of Patent No. 836,475. According to the practice indicated in *Herman v. Youngstown* (C. C. A., 6; 191 Fed. Rep., 579; 112 C. C. A., 185) plaintiff may have 30 days after the filing of the mandate below, or such further time as the district court may allow, in which to show that the first and second claims of Patent No. 836,475, found in this opinion to be invalid, have been duly abandoned, and thereupon plaintiffs may have the usual decree for injunction and accounting as to the third claim of that patent.

Appellants will recover their costs of this court. The record is accordingly remanded to the district court, with directions to enter a decree in accordance with this opinion, and to take further proceedings not inconsistent therewith.

[U. S. Circuit Court of Appeals—Ninth Circuit.]

MASTORAS v. HILDRETH.

Decided February 24, 1920; rehearing denied April 5, 1920.

279 O. G., 353; 263 Fed. Rep., 571.

1. PATENTS—PATENT FOR INOPERATIVE MACHINE NOT INFRINGED BY OPERATIVE MACHINE.

That under a patent no machine has ever been made and shown to work successfully does not prevent the owner from restraining infringement; but if the patented device is not operative it cannot be infringed by one that is.

2. SAME—PATENT CANNOT COVER MODE OF OPERATION.

A specified movement of a machine irrespective of the mechanism which causes it is not patentable. A patent cannot cover the mode of operation.

3. SAME—CLAIM TO COMBINATION INCLUDING "MEANS," ETC., LIMITED TO MEANS DESCRIBED.

The Dickinson patent, No. 831,501, for a candy-pulling machine, claim 1 for "a candy-pulling machine comprising a plurality of oppositely disposed candy hooks or supports, a candy-puller and means for producing a specified relative in-and-out motion of these parts for the purpose set forth," *Held*

limited to the in-and-out motion described in the specification (as a claim can not cover a mode of operation) and not infringed by the device of the Langer patent, No. 1,232,697, although it has means for producing a relative in-and-out motion.

APPEAL from the District Court of the United States for the District of Oregon; Wolverton, judge.

Suit by Herbert L. Hildreth against Jim M. Mastoras. *Decree for complainant, and defendant appeals. Reversed.*

Mr. Joseph L. Atkins, Mr. W. A. Robbins, and Mr. David E. Lofgren for the appellant.

Messrs. MacLeod, Calver, Copeland & Dike and Mr. Chester G. Murphy for the appellee.

Before GILBERT, MORROW, and HUNT, Circuit Judges.

GILBERT, *Cir. J.*:

The appellant appeals from a decree of the court below whereby he was adjudged to have infringed claim 1 of Patent No. 831,501, issued on September 18, 1906, to Herbert M. Dickinson, for an "improvement in candy-pulling machines." The appellant denied infringement and denied the validity of the Dickinson patent.

The only prior patent to which we find it necessary to refer is No. 511,011, issued to Firchau on December 19, 1893, for an improvement in "machines for working or pulling candy." Firchau's machine consists of a fixed drum wherein are placed heads which carry lateral fingers arranged so as to travel in different orbits in opposite directions. In operation the candy is hung upon the upper finger, and, upon the rotation of the heads in opposite directions, it is engaged by the lower finger and stretched in an opposite direction and worked. Say the specifications:

This takes place at each rotation of the heads, the candy being alternately massed and stretched.

In the Dickinson machine the candy is placed in a trough some eight feet in length in the bottom of which at the center is placed an upright fixed pin. Attached to an arm pivoted on a transverse traveling bar are two pins which project downwardly and nearly to the bottom of the trough. The bar with the arm on which are fastened the projecting pins is carried back and forth on the top of the trough from one end thereof to the other. As the bar approaches each end, a hook engages the arm from which the pins are suspended and turns it about upon the bar, whereby the pins make in the trough approximately a semirevolution, before returning to the opposite end. The specifications say:

The candy is acted upon in a manner and by means of the shifting hook along a path corresponding to what I term a figure 8.

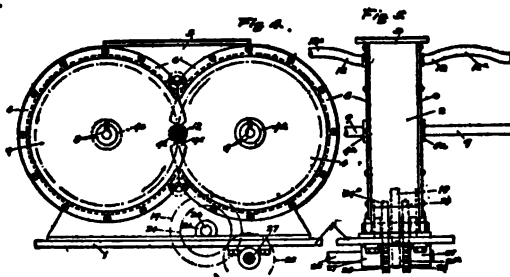
Claim 1 is as follows:

(1) A candy-pulling machine comprising a plurality of oppositely disposed candy hooks or supports, a candy-puller and means for producing a specified relative in-and-out motion of these parts for the purpose set forth.

The machine which was held to infringe is one made under the patent to G. L. Langer No. 1,232,697, issued July 10, 1917, for "a candy-pulling machine." Langer's specifications say:

My invention relates to candy-pulling machines, and more particularly to a machine adapted to automatically pull candy by means of a floating puller which is carried through a course of travel corresponding in form to the figure 8, and around fixed supporting pins arranged concentrically within the two circular portions of said figure 8, whereby the candy is pulled by said floating puller and alternately carried thereby around said fixed supporting pins.

The machine consists of a base supporting two circular or drum-like castings joined together at one side and standing on edge. In the center of each of these drums and on either side thereof, is a fixed pin, while a movable pin projecting on each side passes first around one drum and then around the other in continuous operation. Candy is simultaneously pulled on each side of the machine. It is stretched across the fixed pins on either side and above the moving pin. By the movement of the machine the moving pin pulls the candy and wraps it first around one fixed pin, then stretches it and wraps it around the other, and continues that operation alternately from pin to pin, thus pulling and stretching the candy as the floating pin is carried through its course of travel. The essence of the Langer invention is that it is adapted to carry a floating pulling member first around one circular course in one direction, and then around another circular course in the opposite direction. The machine is shown below:



It is said that the Firchau patent has no place in the prior art for the reason that it will not pull candy but will only mix it. To this we cannot assent. The moving fingers of that device undoubtedly will to some extent pull candy. The candy, being placed upon the upper finger which has projecting knobs to hold it, will as that finger moves be caught by the lower finger and pulled in the opposite direction. If it be said that the pulling operation is not continuous but

intermittent, the same may be said of the Dickinson device, for it is obvious that during the travel of the movable pins from the end of the trough toward and to the central pin there is no pulling of the candy or anything more than a pushing of the mass thereof in front of the moving pins. It is only as Dickinson's moving pins travel away from the center and toward the ends of the trough that any tension is placed on the candy. It is thus seen that Dickinson did not get very far beyond Firchau, and that in his device, as in Firchau's, the candy is "alternately massed and stretched." Although claim 1 of the Dickinson patent does not call for means to support the candy against gravity, it is obvious that the device will not operate without a trough for support such as the specifications describe, and that if the pins were placed in a horizontal position they could not be so operated as to sustain the candy against gravity, for the reason of the intermittent relaxation of the candy from all tension. In *Hildreth v. Auerbach* (D. C., 223 Fed. Rep., 545) Judge Learned Hand said:

I must confess that the conception of the pins as "supports" seems to me quite foreign to Dickinson's disclosure.

Dickinson was not the first to invent a machine to pull candy. But if he were the first, as the appellee contends, he acquired no more than the exclusive right to pull candy in the way which he specified, and he is not justified in claiming the exclusive right to pull it in some different way.

The testimony leaves it doubtful whether the Dickinson machine is operative. The only testimony as to its practical operativeness is that of the appellee. He testified that three machines were made, that two of them had been broken up, and that the third was still in his possession; that he did not use it in practical operation; that on one occasion, a number of years after he bought it, he had used and pulled candy with it; and that by shortening the pull and speeding the machine it would "pull candy all right."

Q. Will it pull it practically? A. Well, practically would be so it would be commercially.

Q. Well, would it pull it commercially, then? A. Well, not the way we pull our candy. It was not pulled enough. It would pull it, but the stroke was too long. We shortened up the stroke, and made it all right. * * *

Q. And that would not pull candy until you changed it? A. Oh, yes, it would.

Q. It would not pull it commercially? A. Well, no. It would not pull it, not as well as we wanted candy pulled.

A witness for the appellant, an experienced candy-worker, testified that the Dickinson device would stir candy but would not pull it, and stated as a reason therefor that—

it does not let in enough air, "doesn't get the air to it. It lays flat on the floor there on the bottom of the trough, and it certainly doesn't get air around. In

any of the pulling machines, as it is in existence now, the air is from all sides. It absorbs the air in knocking it around, but this one don't."

The appellee himself has recorded his adverse criticism of the principle on which the Dickinson machine operates. In his specification in Letters Patent No. 832,384, for a candy-pulling machine, issued to him October 2, 1906, he states:

Attempts have heretofore been made to work candy in a manner analogous to that in which dough and other substances are treated; that is to say, to place the mass within a receiving or supporting chamber into which moving arms project. An example of this construction is shown in United States Letters Patent No. 511,011, granted December 19, 1893, to P. J. G. Firchau. In such machines the mass of candy is supported in whole or in part by a chamber, and the function of the moving arms or projections is to alternately mass and stretch the material, as stated in said patent. This method of treatment and the machines which embody it are not successful or practical to produce the results heretofore obtained by hand-pulling, which results must be obtained in any successful candy-pulling machine.

(1) The fact that under a patent no machine has ever been made and shown to work successfully does not prevent the owner of the patent from restraining infringement. (*Bement v. National Harrow Co.*, C. D., 1902, 666; 101 O. G., 887; 186 U. S., 70; 22 Sup. Ct., 747.) But it is also true that, if the patented device is not operative, it cannot be infringed by one that is. (*Royer v. Coupe*, C. C., 29 Fed. Rep., 358; *General Elec. Co. v. Wise*, C. C., 119 Fed. Rep., 922; *Hale & Kilburn Mfg. Co. v. Oneonta C. & R. S. Ry. Co.*, C. C., 129 Fed. Rep., 598; *Bowers v. San Francisco Bridge Co.*, C. C., 91 Fed. Rep., 381; *Chadeloid Chemical Co. v. Frank S. De Ronde Co.*, C. C., 146 Fed. Rep., 988.) It is true, as Judge Hough said in *Engineer Co. v. Hotel Astor*, (D. C., 226 Fed. Rep., 779)—

a device need not be perfect in order to escape the charge of inoperativeness.

But that was a case in which the court found the evidence to show "substantial performance." The case at bar is not one of those in which the first embodiment of a generic invention works imperfectly, but in which the defects may be remedied by readjustment or relative changes in size or shape or construction of members. It is not a case in which the invention as described is crude or defective, but is susceptible of improvement. If there is inoperativeness here, it is inherent in the very conception and structure of the device. If it is not susceptible of use commercially, it has no utility, for it is obvious that such a machine can have no utility except in the commercial field.

(2-4) But aside from the question of the operativeness and utility of the Dickinson machine, we are of the opinion that the decree should be reversed for failure of the appellee to sustain the charge of infringement. It is unnecessary to follow the appellee into the

field of his prior litigation in suits in court, or in interference proceedings in which the Dickinson application and several other applications for patents, including an application of the appellee, were involved, resulting in the award of priority to the Dickinson invention. In the determination of the question of infringement involved in the present case, the appellee must stand upon the Dickinson patent. It is a legal presumption that a later patent does not infringe an earlier patent. (*Putnam v. Keystone Bottle Co.*, C. C.; 38 Fed. Rep., 234; *Ney v. Ney Mfg. Co.*, 69 Fed. Rep., 405; 16 C. C. A., 293; *St. Louis Car-Coupler Co. v. National Malleable Castings Co.*, 87 Fed. Rep., 885; 31 C. C. A., 265; *Griffith v. Shaw*, C. C.; 89 Fed. Rep., 313; *Norton v. Jensen*, 90 Fed. Rep., 415; 33 C. C. A., 441; *Century Elec. Co. v. Westinghouse Co.*, C. D., 1914, 267; 207 O. G., 1249; 191 Fed. Rep., 350; 112 C. C. A., 8; *Benthall Mach. Co. v. National Corporation*, D. C., 222 Fed. Rep., 918.) Prior to the use of machines, candy was pulled by hand with the aid of a single hook. To pull it successfully by machinery two or more hooks are necessary. Dickinson used three, and Langer uses three. But the principle and mode of operation of the two machines are different. One of the elements of claim 1 of the Dickinson patent is—

means for producing a specified in-and-out motion of these parts for the purpose set forth.

Of course, a specified movement of a machine irrespective of the mechanism which causes it is not patentable. The patent laws give protection to the inventor of a—

new and useful art, machine, manufacture, or composition of matter.

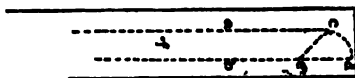
Here the subject of the patent is a machine, and it creates a monopoly in the use and sale of the machine only. It does not and can not cover a mode of operation. (*Burr v. Duryee*, 1 Wall., 531; 17 L. Ed., 650; *American Crayon Co. v. Sexton*, 139 Fed. Rep., 564; 71 C. C. A., 548; *Knapp v. Morss*, C. D., 1893, 651; 65 O. G., 1593; 150 U. S., 221; 14 Sup. Ct., 81.)

In *Westinghouse v. Boyden Power-Brake Co.* (C. D., 1898, 443; 83 O. G., 1067; 170 U. S., 537; 18 Sup. Ct., 707; 42 L. Ed., 1136), Mr. Justice Brown said:

Because the law requires a patentee to explain the mode of operation of his peculiar machine, which distinguishes it from others, it does not authorize a patent for "a mode of operation as exhibited in the machine."

Comparing the Dickinson machine with that of Langer, with reference to claim 1 of the former, we find that Langer's machine has a "plurality of oppositely-disposed candy hooks" which are also supports, and that the Dickinson machine has a plurality of "oppositely-disposed candy hooks" which are hooks only and not supports.

Both machines have means for producing a relative in-and-out motion of hooks. Dickinson's claim for a "specified" relative in-and-out motion must be held to mean the in-and-out motion which is specified in the claims and specifications and exhibited by the machine itself. Dickinson acquired no monopoly of all in-and-out motions in candy-pulling machines. It is said that the specification of the Langer patent shows that it adopts the figure 8 movement of the Dickinson patent. It is true that in both patents there is the common use of the term "figure 8," as descriptive of the operation of the respective devices. In the Langer patent the term is applicable, for the moving puller and the candy which it carries describe a true figure 8. In the Dickinson specification two moving pins in conjunction with a stationary pin "move the candy" along a path corresponding to "what I term a figure 8." It is impossible, however, to find in the operation of the Dickinson machine a movement of candy in the course of a figure 8. As the candy reaches the end of the trough, it stands in the shape of a letter V. When the movable pins are reversed, the sides of the V are brought together, and the ends are twisted about, and then the candy is massed and pushed on the reverse movement back to the stationary pin, which again divides it into the form of a letter V. Dickinson's in-and-out movement is shown by the accompanying plat. The movable pins travel in the trough past the fixed pin *f*, proceeding respectively on the lines *a* and *b* to the end of the trough, the right-hand pin in advance of the left. When they reach the end of the trough they are respectively at *d* and *c*. As they turn to the left on their common axis and start on their return travel, one pin describes the arc *d c*, and the other the arc *c e*, and they continue in their course past the fixed pin *f* to the opposite end of the trough, where the same turning movement is repeated.



In the Dickinson machine the pulling-pins, yoked together, move with a reciprocating motion back and forth in a trough, with a reversing motion at each end of a trough, and they alternately push and pull a mass of candy lying in a trough. There is no lapping of candy, strand upon strand. In the Langer machine, a single pulling member moving in a continuous circular path continuously exerts a pulling force on a mass of candy suspended in the air.

In *Burr v. Duryee* (1 Wall., 531; 17 L. Ed., 650) the court said :

That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other. * * * An infringement involves substantial identity, whether that identity be described by the terms "same

principle," same "*modus operandi*," or any other. It is a copy of the thing described in the specification of the patentee, either without variation or with such variations as are consistent with its being in substance the same thing. If the invention of the patentee be a machine, it will be infringed by a machine which incorporates in its structure and operation the substance of the invention; that is, by an arrangement of mechanism which performs the same service or produces the same effect in the same way.

And in *Westinghouse v. Boyden Power Brake Co.* (C. D., 1898, 443; 83 O. G., 1067; 170 U. S., 537; 18 Sup. Ct., 707; 42 L. Ed., 1136) the court said:

But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent his function.

The decree is reversed, and the cause is remanded, with instructions to dismiss the bill.

[U. S. Circuit Court of Appeals—Sixth Circuit.]

J. H. DAY CO. v. MOUNTAIN CITY MILL CO. *et al.*

Decided May 11, 1920.

279 O. G., 731; 264 Fed. Rep., 963.

1. PATENT NO. 865,461, FOR IMPROVEMENT IN CRACKER-CUTTING MACHINES, INVALID AND NOT INFRINGED.

The Ward patent, No. 865,461, for means for moving the cutting mechanism of cracker-cutting machines during the cutting operation in line with and at the same rate of speed as the moving sheet of dough to be cut and for means for removing the scrap from the cut sheet, *Held* void for want of invention over the prior art and not infringed, even if valid, as to the specific mechanical means devised.

2. SAME—SUBSTITUTING FOR MEANS EMPLOYED BY EARLIER PATENTEE OF MEANS EMPLOYED IN ANALOGOUS ART NOT INVENTION.

Where an earlier patent disclosed means for effecting unison of movement between biscuit-cutting machinery and the material to be cut, the substitution therefor of means already employed in the brick-making art in connection with the cutting of plastic clay was not invention, there being a substantial analogy between the two arts.

3. SAME—NOTICE OF DEFENSE OF PRIOR INVENTION NOT INSUFFICIENT FOR OMISSION OF INVENTOR'S ADDRESS.

In a patent infringement suit notice of the defense of prior invention by G. was not insufficient, though G.'s address was omitted, where the notice identified him as the president of one of the defendants, a corporation which bore his name.

4. SAME—FINDINGS OF ANTICIPATION AND PRIORITY OF INVENTION NOT INCONSISTENT.

In a patent infringement suit the finding that plaintiff's invention was anticipated by a machine manufactured by G. and a finding of priority of invention as disclosed by G.'s patent specification and claims were not inconsistent.

APPEAL from the District Court of the United States for the Eastern District of Tennessee; Edward T. Sanford, judge.

Suit by the J. H. Day Company against the Mountain City Mill Company and another. *From a decree dismissing the bill* (257 Fed. 561) *plaintiff appeals. Affirmed.*

Mr. Jas. L. Hopkins for the appellant.

Mr. Laurance A. Janney for the appellees.

Before KNAPPEN, DENISON, and DONAHUE, Circuit Judges.

KNAPPEN, *Cir. J.*:

Suit for infringement of United States patent to Ward, No. 865,461, September 10, 1907, and United States patent to Allison & Pinkney, No. 1,112,184, September 29, 1914, both relating to cracker-cutting machines. The district judge found the claims of the Ward patent in suits (Nos. 1 to 9, both inclusive) void for anticipation, and that patentees were not the first and original inventors of the mechanism disclosed in the claims of the Allison & Pinkney patent in suit, viz., claims 1 and 2. This appeal is from a decree dismissing the bill.

(1) 1. *The Ward patent.*—In the usual type of cracker-cutting machines previous to Ward the dough sheet, formed between rollers, was deposited upon and carried by a traveling apron, which was given a step-by-step forward movement. This was known as the ratchet or step-by-step type. The cutting of the dough into desired form was done by vertically-reciprocating cutters descending upon the dough while the apron is standing still. The stated object of Ward's invention is to provide a mechanism by which the crackers are cut from the sheet by a cutter moving in unison with the feed of the sheet, and without stopping the sheet during the cutting stroke of the dies. For effecting this result he disclosed a crank and pitman and bell-crank mechanism, connected with the cutter-carrying bed and the dough-carrying apron, by which, as the bell-crank is rocked, the entire cutting mechanism is reciprocated in the line of travel of the apron, so that at the instant of cutting the cutter and dough sheet (as designed) move together at substantially the same speed, so effecting a continuous and uninterrupted operation. The first claim is as follows:

1. In a machine for cutting crackers and the like, means for feeding the sheet of dough continuously through the machine, reciprocating mechanism for cut-

ting same into cakes, with means for moving the cutting mechanism during the cutting operation in line with and at the same rate of speed as the continuously moving sheet.

The remaining claims in suit contain nothing calling for special mention at this time, except that claim 2 contains a general element of "means for removing the scrap from the cut sheet," and in claims 3, 5 and 9 the words, "a cutter acting at right angles to the apron" are used, instead of "reciprocating mechanism for cutting the same into cakes."

Setting to one side for the present the scrap-removing feature of claim 2, it is obvious that, so far as the claims in suit are concerned, Ward's contribution to the cracker-cutting art is limited to such invention as may be found in his provision for unison of movement between cutters and dough sheet. In our opinion such invention is not present. Ward was not the first, even in the biscuit-cutting art, to provide for unison of movement between cutter-knives and the material to be cut. Perky, in 1901 (thus antedating Ward's application nearly five years), disclosed a machine for cutting shredded-wheat biscuit, by which the biscuit material, carried upon a continuously-moving conveyer, is subdivided by a series of vertically-operating knives carried by endless belts and below the biscuit-conveyor, the knives thus traveling in unison with the feed of the material during the cutting operation. The idea of unison of movement between cutters and material was thus old in what is essentially a biscuit-cutting art; and although Ward's method, as applied to ordinary crackers, of accomplishing unison of movement by horizontal reciprocation of the vertically-reciprocating cutter-heads of that old art differed from Perky's method of a plurality of knives carried by belts moving constantly in unison with the feed of the material, yet in the mechanical arts generally not only was it old to effect unison of movement between cutters and the material to be cut, but it was old to accomplish such unison by a longitudinal reciprocation of the cutting element. This is illustrated by the patent to Slick (1902) on mechanism for punching a traveling iron strap as it is fed continuously forward by rolls; the punching being accomplished by a reciprocating movement of dies, causing their travel with the same speed as that of the strap at the instant of cutting. It is further illustrated by the patent to Hovey, which requires more extended reference.

The Hovey patent (No. 129,411, July 16, 1872) disclosed, in a brick-machine, mechanism whereby the clay, after leaving the die, is carried by an endless apron under a vertically-reciprocating knife, which is also reciprocated longitudinally with the movement of the apron; the knife thereby moving forward at the instant of cutting with the same velocity as that at which the column of clay is moving.

Hovey's mechanism for longitudinal reciprocation of the cutter-heads is the substantial equivalent of that employed by Ward. It is this Hovey device which the district judge found to anticipate the device of the Ward patent. The differences between the mechanism of Hovey and that of Ward are so slight that Hovey would unquestionably anticipate Ward, were Hovey's device in the biscuit-making art. Indeed, this is conceded by plaintiff's expert.

(2) We may concede, for the purposes of this opinion, that the brick-making art and its problems are not so closely analogous to the cracker-making art as to make Hovey's disclosure an absolute anticipation of Ward. It may also be assumed, for the same purpose, that, were the Perky patent out of the case, the presence of the Hovey and kindred devices in the brick-cutting art would not be enough to deny invention to Ward in adapting the Hovey device to the cracker-cutting art. But such is not the case presented. There is a substantial degree of analogy between the brick-cutting and cracker-cutting arts; both deal with the problem of cutting a moving sheet of plastic material; and the Patent Office recognized a substantial analogy between the two arts in citing, as against the Ward application, the Chambers patent of 1884, on brick-making mechanism. The dominant fact is that, when Ward entered the field, Perky had already applied to the biscuit-cutting art the idea of moving cutters and material to be cut in unison, had reduced the idea to practice, and had disclosed to the public operative mechanism therefor. It clearly would not have been invention to apply to ordinary cracker-cutting Perky's method of vertically-operating knives carried by belts moving in unison with the feed of the biscuit material. It seems equally clear that there was no invention in substituting for Perky's means of effecting unison of movement the means disclosed by Hovey for effecting such unison in an art containing so much analogy as that of cutting a sheet of plastic clay, (*Ransome Co. v. United Co.*; C. C. A., 2; C. D., 1910, 494; 161 O. G., 754; 177 Fed. Rep., 413; 101 C. C. A., 217; *McKay-Copeland Co. v. Copeland Co.*, C. C.; 77 Fed. Rep., 306; *Id.*, C. C. A., 1; 80 Fed. Rep., 518; 25 C. C. A., 611; *Ohmer v. Ohmer*, C. C. A., 6; 238 Fed. Rep., 182; 151 C. C. A., 258,) and that the patent is therefore invalid.

But, even were Ward entitled to protection to the extent to which he may have devised or adopted specific mechanical means for adapting Hovey's device to the cutting of crackers, he would be entitled in no event to more than that, and such specific means we think defendant cannot be said to employ, in view of the prior art on this subject. While defendant employs a horizontally-reciprocating cutter-head, its back-and-forth movement, communicated through a rock-shaft, is made, by a highly complex mechanism, to combine a

rotary movement of the crank connecting the main shaft to the rock-shaft with a bodily back-and-forth movement of the bearing about which the crank-shaft revolves, thus producing a constant and invariable movement of the cutter-head during about one-third of the revolution of the crank-shaft instead of (as in Ward's device) during only the movement when the cutter is completing the cut and is starting on its upward movement. Defendant's mechanism in this regard is concededly superior to Ward's. Indeed, infringement is not alleged as to either of Ward's last five claims, which include Ward's mechanism for effecting the back-and-forth movement, although defendant's mechanism is also adjustable.

The inclusion in claim 2 of the scrap-removing element—"means for removing the scrap from the cut sheet"—does not work an exception in favor of invention in that claim. A scrap-remover was a well-known feature of the old step-by-step cracker-cutting machine. The types employed by Ward and defendant, respectively, are both old in the art. The addition to the "unison" type of machine of this old and common feature of the step-by-step machine involved no more than mechanical skill.

2. *The Allison & Pinkney patent.*—The claims in suit relate entirely to a "pan-skipping" mechanism; they are printed in the footnote.¹ As already said, the trial judge found that Allison & Pinkney were not the inventors of the mechanism disclosed. The pertinent history is briefly this: February 20, 1909, Thomas L. Green applied for a patent, which was issued April 18, 1916. Meanwhile, on August 3, 1912, (three years after Green's application,) Allison & Pinkney filed their application, and patent thereon was issued September 14, 1914. One of Green's original claims covered generally the subject-matter of Allison & Pinkney's first and second claims. After the issue of the Allison & Pinkney patent the Patent Office declared an interference between Allison & Pinkney's first and second claims and the fortieth and forty-first claims of Green as amended to meet the Patent Office requirement. That Office adjudicated the inventions to be identical and awarded priority of invention to Green. Allison & Pinkney's appeal to the Court of Appeals for the District of Columbia was there dismissed.

On the trial of the instant case below, priority of invention, as between Allison & Pinkney and Green, was directly in issue. Green testified on this subject, as did also one Morton, an engineer in Green

¹ 1. A pan carrier, consisting of an endless conveyer, a pan-skipping mechanism co-operating with said conveyer and means for setting said conveyer relatively forward or backward while in motion for the purpose of registering the pans with the pan skip.

2. A pan carrier consisting of an endless conveyer, a pan-skipping mechanism arranged to actuate said conveyer at certain intervals, means for driving said conveyer, and manually operated means for accelerating or retarding the movement of said conveyer for the purpose of registering the pans with the pan skip.

& Co.'s factory in 1909. The testimony of both of these witnesses was taken in open court. Judge Sanford not only found by his decree that Green was the first and original inventor of the improvement in question, but in his opinion, filed as basis of that decree, said :

The proof shows, in my opinion, beyond reasonable doubt, that Allison & Pinkney were not the first and original inventors of the differential pan-skip mechanism disclosed in claims 1 and 2 of the Allison & Pinkney patent, * * * and that the first and original inventor thereof was Thomas L. Green, the president of the defendant Green Company, who, as early as 1909, invented this mechanism, constructed a machine embodying the same and successfully operated it in Cardiff, Wales. On this point I am entirely satisfied as to the truthfulness and substantial accuracy of the testimony given by defendant's witnesses, Green and Morton, the correctness of which I see no substantial ground for questioning.

The Cardiff machine was manufactured in the United States.

(3) Consideration of the testimony suggests no sufficient reason for questioning the correctness of Judge Sanford's conclusion, and we see no merit in the objection that the notice of the defense of prior invention by Green is insufficient. Its only defect was in omitting Green's address; but the notice identified him as the president of the Thomas L. Green Company, (one of the defendants,) which in fact bears his name, and no one could well have failed to understand Green's identity. The objection impresses us as devoid of substance.

This conclusion makes it unnecessary to pass upon plaintiff's contention that Green's patent, applied for before he built the Cardiff machine, does not cover what plaintiff claims to be the invention of Allison & Pinkney, viz., the employment of a differential gearing as either an accelerating or retarding mechanism, and the registering of the plans with the pan-skip while the pan-conveyers are moving, in accordance with which contention plaintiff disclaims an interpretation of the Allison & Pinkney patent which would include what plaintiff claims is the mechanism shown by Green's patent (priority to that extent being conceded to Green,) but which plaintiff says requires disconnecting the pan-conveyer from its driving power and pan-skipping mechanism. However we think plaintiff's contention in this regard not well taken. It does not accord with what seems a proper interpretation of Green's specification, which we think discloses a continuous pan-feed through a positive gear transmission and adjusting means for setting the pan-carrier forward or backward during the operation of the machine, so as to register the pans with the skipping mechanism. Plaintiff's contention in this respect was also specifically rejected by the Circuit Court of Appeals for the Seventh Circuit, in a suit upon the Green patent. (*Taggart Baking Co. v. Green*, C. D., 1919, 357; 267 O. G., 341; 257 Fed. Rep.,

87; C. C. A., 299.) Plaintiff's contention is also opposed to the view taken by the Patent Office in awarding priority to Green.

(4) We see no inconsistency between a finding of anticipation by Green's Cardiff machine and priority of invention as disclosed by Green's patent specification and claims.

It results from these views that the decree of the district court should be affirmed.

[U. S. Circuit Court of Appeals—Second Circuit.]

NATHAN ANKLET SUPPORT CO., INC., *et al.* v. CAMMEYER, INC.

Decided February 24, 1920.

280 O. G., 194; 264 Fed. Rep., 968.

PATENTS—INNERSOLE FOR SHOES—VOID FOR LACK OF INVENTION.

The Nathan patent, No. 873,775, for an innersole for shoes having variously-located pockets for the insertion of filling to correct abnormal tendencies of the foot, *Held* void for lack of invention and anticipation in the prior art, as it involved only duplication of the pocket of a prior device and the provision of an insert at other locations.

APPEAL from the district Court of the United States for the Southern District of New York.

Suit in equity by the Nathan Anklet Support Company, Incorporated, and the Arrowsmith Manufacturing Company, Incorporated, against Cammeyer, Incorporated. *Decree for defendant, and complainants appeal. Affirmed.*

Mr. Stephen J. Cox for the appellants.

Mr. James Love Hopkins and *Messrs. Redding & Greeley* for the appellee.

Before WARD, HOUGH, and MANTON, Circuit Judges.

MANTON, *Cir. J.*:

Letters Patent No. 873,775 were issued December 17, 1907, to Benjamin Nathan. Later the patent was assigned by his executors to the Nathan Company on July 31, 1917. The Arrowsmith Manufacturing Company, Incorporated, is the sole licensee. Both corporations have joined in this action against the appellee claiming infringement. The appellants are engaged in manufacturing and selling innersoles or supports. The appellee is a New York corporation engaged in selling the alleged infringing supports. What the appellee sells is manufactured by the Wizard Foot Appliance Company, of St. Louis, Mo. The appellee's product is made pursuant to the Block patents No. 1,043,058, No. 1,191,655, and No. 1,127,349. The district court dismissed the bill on grounds of non-infringement and because the trial judge found that the patent in suit was not sufficiently success-

ful to warrant a liberal interpretation of the claims. The claims in suit are 1, 2, 6, and 7, and are as follows:

1. An inner sole comprising a plurality of layers secured together and having between the same as a substantially wedge-shaped pocket, which is open along the contiguous marginal edge of the inner sole, and a removable substantially wedge-shaped filling member for said pocket.

2. An inner sole comprising a plurality of layers secured together and having between the same a plurality of pockets, which are open at the opposite marginal edges of the inner sole and are narrowed toward the longitudinal center of the same, and a removable substantially wedge-shaped filling member, which is adapted to either of said pockets.

6. An inner sole comprising a plurality of layers with a pocket, which is open along the marginal edge of the insole, and a removable filling member, which is adapted to said pocket and is thicker at its outer than at its inner edge.

7. An inner sole comprising a plurality of layers secured together and provided between said layers with a pocket, which is open along the marginal edge of the insole and narrows thence toward the longitudinal center of the insole, and a removable substantially wedge-shaped filling member, which is adapted to said pocket, said filling member being thicker at its outer than at its inner edge and narrower at its inner edge than at its outer edge.

The appellants contend that the prior art does not disclose anything tending to limit the scope of the patent in question, and that the inventor has provided improvements relative to innersoles adapted to be worn in shoes and provided with means for adjustably supporting various portions of the bottom of the foot, thus correcting weakness or abnormalities, such as flat foot, metatarsalgia, and Morton's painful toe. The specifications of the patent describe the embodiment in detail and show an innersole composed of two layers of material secured together, so as to form pockets for wedge-shaped inserts, being for the ball of the foot, or the metatarsal bone, or the instep-arch, and for the heel. The two layers of material are not sewn or secured together in the ordinary manner, but are left open at their edges and secured in the interior, so that the pockets thus formed for the reception of the wedges are entirely open at the margin of the insole to receive the wedges, which have every edge substantially coincident with the marginal edges of the insole. The ball, instep, and heel pockets are separated from each other by stitches. They take the form substantially of parallelograms, and thus secure the separation of the pockets and the correct placement for the wedges. The wedges may be of any desired form, and two or more of them may be used in one pocket, if required. It is further provided:

For example, if the wearer has a tendency to throw his right foot forward and wear out the sole of his shoe at its outside front edge, and by the strain thus produced upon the foot cause callous or corns to develop, by inserting the insert or filling member 41 in the pocket from the corresponding side of the insole, the foot of the wearer is thrown toward the other side, the pres-

sure upon the skin relieved, and the corn or callous soon caused to disappear. Similarly, if the tendency is such that the sole has greater wear imposed on its inside front edge, it can be corrected by placing the insert or filling member in the side of said pocket 40 opposite to that hereinbefore mentioned. Again, if the wearer of a shoe finds that the arch of the foot needs an extra support, the insert 42 may be placed in the pocket 50, provided for that purpose, and at either side thereof, thus furnishing the support required. In a similar manner, the wedge 43 may be inserted in the pocket 60 at the heel of the inner sole, from either side thereof. The location of these pockets in forms of inner sole illustrated herein are merely suggestive. It is obvious that, by varying the position of the stitches employed to unite the lower and intermediate layers of the sole, pockets may be formed at any desired place along the edge of the sole for the reception of an appropriate insert or filling member, and while I prefer the form herein illustrated, yet it is not to be understood that the invention in all respects is restricted thereto.

The inserts are removable and may be made of any devised thickness and placed in different pockets to accommodate the correction required for the wearer's foot. The appellants contend that the fundamental composition of the patent improvements was a support for correcting abnormal tendencies of the foot in every portion thereof, without necessitating a change of supports, or any alteration or adjustment that could be made by a person of ordinary skill and intelligence, and without tools. Thus it is claimed that the inventor's idea has led to a universally-adjustable support for all foot troubles, whether located at the ball, instep, or heel, or at two or more of these places.

The art was well and highly developed before Nathan entered the field, and this was best illustrated by what took place in the Patent Office on Nathan's application. The entire description and claims of Nathan were canceled on October 19, 1906. The original description detailed the uses of the innersoles with their variously-located pockets, in which wedges were to be seated to increase the thickness of the sole. The new description described the insole as adapted for use without any insert, and the layers of the insole as being of approximately the same size, so as to lie smoothly upon each other when the inserts or filling members were removed. These characteristics were not developed in the original description. The idea of "means" by which this is accomplished is new, and was not contained in the original description. The original description provided for means whereby inequalities in the sole may be provided when needed. No new oath accompanies the new description, and for want of it a patent has been held to be void. (*Stewart v. American Lava Co.*, C. D., 1909, 557; 149 O. G., 602; 215 U. S., 161; 30 Sup. Ct., 46.)

But we think the patent lacks invention, and is therefore invalid. The patent granted to Korwan, No. 632,529, September 5, 1899, shows a marginally open pocket and a removable wedge insert. Nathan acquiesced in this construction, by admission in the Patent Office that

Korwan anticipated appellants' first claims, and accordingly withdrew his claims. The Patent to Waite, No. 797,243, granted August 15, 1905, has a pocket in the heel-lining forming layers, and that pocket receives a wedge-shaped insert. The description of the patent says that the cushion gives a general wedge-shaped section to the completed devices. Both of these patents, we think, anticipated the appellant's invention. Waite shows a Block insert (Block's patent) in a single pocket, in an insole, located at the heel of the shoe. .

What Nathan did was to duplicate that pocket and provide for an insert at various other locations. Mere duplication is not invention, but ordinary mechanical skill. (*Topliff v. Topliff*, C. D., 1892, 402; 59 O. G., 1257; 145 U. S., 156; 12 Sup. Ct., 825; *Slawson v. Grand St. Ry. Co.*, C. D., 1883, 313; 22 O. G., 99; 107 U. S., 649; 2 Sup. Ct., 663.) Where the use of one deflecting-plate in a lumber-sawing machine was old, there is no invention in using two such plates. (*Dunbar v. Meyers*, C. D., 1877, 140; 11 O. G., 35; 94 U. S., 187.) Nathan in his claims, as above stated, refers to the innersole as comprising a plurality of layers secured together and having between the same a substantially wedge-shaped pocket. This is shown in the patent to Waite, No. 797,243. The Waite patent shows an innersole comprising a plurality of layers secured together and having between them a substantially wedge-shaped pocket, which is open along the contiguous marginal edge of the innersole, and a removable substantially wedge-shaped filling member for said pocket. At best, for appellants, it may be said that he progressed step by step to the desired result, but not one completed whole; and each is entitled only to the specific form or device which he produces. Each other inventor is entitled to his own specified form, so long as it differs from those of his competitors and does not include theirs. (*Railway Co. v. Sayles*, C. D., 1879, 349; 15 O. G., 243; 97 U. S., 554.) Nathan accepted from the Patent Office a narrower claim than that contained in his original application. This claim, as allowed, must be read and interpreted with reference to the rejected claim in the state of the prior art. It cannot cover that which was rejected by the Patent Office or disclosed by the prior art. (*Hubbell v. U. S.*, 179 U. S., 77; 21 Sup. Ct., 24; 45 L. Ed., 95.)

Nathan is deemed to have surrendered and disclaimed what he conceded, and to have accepted the language of the patent as it was ultimately granted. (*American Stove Co. v. Cleveland Foundry Co.*, 158 Fed. Rep., 978; 86 C. C. A., 182.) We think that the Nathan alleged invention is but a duplication of what has already been disclosed by the prior art, and is not sufficient to support the claim of invention.

The decree is affirmed.

[U. S. Circuit Court of Appeals—Second Circuit.]

KOHN v. EIMER *et al.**Decided February 28, 1920.*

280 O. G., 391; 265 Fed. Rep., 900.

1. PATENTS—EXPERT TESTIMONY NOT REQUIRED IN PATENT CASES, IF COURT UNDERSTANDS SPECIFICATIONS.

Expert testimony as to the meaning of patent specifications is only permissible to enable the judge to understand the specifications, and when the judge understands the specifications without such testimony it is not necessary since the adoption of the new equity rules. (198 Fed. Rep., xix; 115 C. C. A., xix.)

2. SAME—DETERMINATION OF NECESSITY OF EXPERT TESTIMONY NOT REVIEWABLE, EXCEPT IN CLEAR CASES.

It is for the judge trying a patent infringement suit to decide whether he needs the assistance of experts to understand specifications of patents relied on as prior art, and his decision will not be disturbed, except in the clearest case.

3. SAME—CLAIMS FOR ELECTRIC FURNACE INVALID.

Claims 1, 3, 8, and 11 of the Kohn patent, No. 983,291, for an electric furnace consisting of separate heating units, each form being removable, and the coil being removable from each form, *Held* invalid for anticipation and want of invention.

4. SAME—LICENSEE FROM UNAUTHORIZED PARTY NOT ESTOPPED TO DENY VALIDITY.

Under an assignment of a patent, providing for reversion to the patentee in case of dissolution or termination of the assignee, if, as claimed by the patentee, the sale by the corporate assignee of all its assets caused the patent to revert, a license subsequently granted by the assignee did not estop the licensee to dispute the validity of the patent.

APPEAL from the District Court of the United States for the Southern District of New York.

Suit by William M. Kohn against August Eimer and another. *From a final decree dismissing the bill of complaint, with costs, plaintiff appeals. Affirmed.*

STATEMENT OF THE CASE.

The invention related to small electric furnaces and was aimed at providing a furnace consisting of separate heating units, such that if any one of them should become defective it might be replaced by a standard form. In general, it consisted of a vertical cylindrical outer body of non-conducting material, with a circular space within, fitted to receive a cylindrical pot. The inner and heating wall of the furnace were formed of duplicate units or forms made of non-conducting material standing upright around the inside. The concave or inner face of these forms had vertical grooves, within which passed the resistance coils to carry the current, in a way well known.

The coil was continuous from one end of each form to the other, and the terminals of the four forms were so arranged that they could be used either in multiple or in series at will. As each form could be separately removed and the coil of each itself removed from the form, the device offered an easy means for correcting any defect in the wiring in any single form.

Upon the trial the plaintiff confined the case to four of the claims, Nos. 1, 3, 8, and 11, which are as follows:

1. An electric heater, comprising a body portion, a plurality of forms which are duplicates of each other, a heating element located in each of said forms and removable therefrom without injury thereto, means located in said body portion for connecting the ends of said heating elements, and a lining wall adjacent to said forms and having a chamber formed therein.

3. An electric heater, comprising a body portion having an upwardly extending wall, a plurality of forms located adjacent to said wall, an electric conductor carried by each form, means for connecting the conductors in one form to that of an adjacent form, means for covering and holding said forms in position within the body portion, and means for connecting said conductors in series or multiple circuit arrangement.

8. An electric heater, comprising a body portion having an upwardly extending wall, a plurality of forms located adjacent to said wall, an electric conductor carried by each form, means for connecting the conductors in one form to that of an adjacent form, and means for covering and holding said forms in position with the body portion.

11. A heater, comprising a body portion having an upwardly extending cylindrical wall, a plurality of removable forms shaped to conform to said upwardly extending wall and each provided with an electrical conductor, a separable inner wall located adjacent to said forms, and means for covering the top ends of said forms.

In claims 1 and 11 the phrase, "inner wall located adjacent to said forms," refers to the cylindrical pot which slipped up and down within the furnace and held the forms in place. Electrical furnaces of this general character have been familiar for some time in the art. Patent No. 580,048, to C. A. Timme, issued in 1897, disclosed one form. The furnace was cubical with the opening at one side. Wires were imbedded in removable horizontal heating plates of refractory material at the bottom and top, and there might be vertical plates along the sides as well. The resistance of these wires created the heat within the furnace. The form of the furnace was different from that of the plaintiff's, and the wires could not be removed from the plates as in the plaintiff's case.

The defendant Eimer in 1903 took out a patent (No. 736,509) for a similar furnace, horizontal and lying on a flat bottom. The top, however, consisted of an arch or dome, making the whole a half cylinder lying upon its flat side. The base plate was of refractory material and could be slid in and out, and the wires were so arranged that they could be removed from the base plate, if broken, and

rethreaded. The arched dome could also be removed, and in it the conductor might be threaded in grooves, so as to be removed if broken.

On the same day Eimer took out another patent (No. 736,917) for a modified form of furnace. This was composed of three horizontal sections end to end; each section having three heating walls, apparently removable, one at the base and one on each side. The heating wires in the refractory material might be sunk in longitudinal grooves, which permitted them to be removed and rethreaded, if broken. Proper connections permitted the three longitudinal sections to be used, either in series or multiple. Likewise the conductors in each section might be separated, and could then be used either in series or in multiple.

Capek, 449,035, showed an upright furnace, which might be of any shape, containing a pot within, a heater at the base, made up of two forms, which might be arranged in either multiple or series. In several prior art furnaces the chamber was a cylinder, as in Hatch (No. 640,283,) Conlin (No. 677,399,) Hatch (No. 741,333,) and Marsh (No. 861,744).

The relations of the parties were as follows: On June 15, 1910, Kohn assigned his patent to the Multiple Unit Electric Company, a corporation, with the following reservation:

In the event of the dissolution or other termination of the party of the second part within five years from the date of these presents, that said patents and property rights shall revert to and again be the sole property of the party of the first part (Kohn).

The corporation continued business for 18 months, but finally, on January 31, 1902, sold all its tangible assets to the defendant Eimer. In February the corporation wrote to several of its customers that it was no longer in active business and had sold its plant to Eimer. All its books were taken to the office of its attorney and its business office was closed. Eimer took over the business and eventually organized a corporation, the Electric Heating Apparatus Company, the other defendant. The plaintiff went to work for the two defendants until, because of certain differences between them, he was discharged on June 30, 1913. On July 2, 1913, possibly in fear of some action of the plaintiff, Eimer obtained a license from the Multiple Unit Electric Company under the patent in suit, and paid license fees until May 22, 1914. The defendants' manufacture was a frank copy of the patent in suit, except that they did not supply the cylindrical pot which fitted into the middle of the furnace proper. The bill was filed in February, 1918.

Ralph L. Scott (*C. A. L. Massie* and *Clifford E. Dunn*, of counsel) for the appellant.

Messrs. Rose & Paskus (*Conrad A. Deiterich*, of counsel) for the appellees.

Before ROGERS and MANTON, Circuit Judges, and LEARNED HAND,
District Judge.

HAND, *Dis. J.*, (after stating the facts as above:)

[1, 2] At the outset the appellant challenges our right to examine the prior-art patents at all, because the appellee called no expert at the trial to explain them. (*Waterman v. Shipman*, C. D., 1893, 449; 64 O. G., 713; 55 Fed. Rep., 982; 5 C. C. A., 371.) We have not the slightest wish to minimize the vital importance of expert testimony in patent suits or to suggest that we are not absolutely dependent upon it within its proper scope; but that scope is often altogether misapprehended, as the appellant has misapprehended it here. Specifications are written to those skilled in the art, among whom judges are not. It therefore becomes necessary, when the terminology of the art is not comprehensible to a lay person, that so much of it as is used in the specifications should be translated into colloquial language; in short, that the judge should understand what the specifications say. This is the only permissible use of expert testimony which we recognize. When the judge has understood the specifications, he cannot avoid the responsibility of deciding himself all questions of infringement and anticipation, and the testimony of experts upon these issues is inevitably a burdensome impertinence.

Now the question whether the judge needs the assistance of experts to understand the specifications is for him to decide. Doubtless he ought to be chary of assuming too readily that he does understand what he may not; but, if he is too confident, his mistake eventually transpires. The important point is that it is he who must determine when he needs the help of experts and when he does not, and that decision, except in the clearest case, we should not be disposed to disturb. *Waterman v. Shipman*, *supra*, was written when no judges presided at the trial, and when, therefore, there was no one to decide whether or not expert testimony was necessary. It has no application whatever since the new equity rules, (198 Fed. Rep., xix; 115 C. C. A., xix,) the whole purpose of which, in this regard, was to render suits in equity less oppressive to suitors by some control over the admission of evidence. One of the chiefest scandals of the old procedure was the interminable examination of experts, to extract their opinions upon the very issues which the courts alone could decide. The logomachy which resulted from the cross-examination of an expert by the opposing lawyer was arid beyond belief. No one read it, every one was annoyed by it, and some one paid for it.

In the case at bar we see no reason whatever to differ from the learned district judge in his conclusion that the specifications of all these patents speak a language comprehensible enough, without ex-

perts, for the disposal of the case. As this was all that he ought to have used it for in any event, we do not see how he could have done differently.

[3] Kohn's invention depends upon the shape of the furnace, the interchangeability of the duplicate forms, the removability of the coils from each form, and the possibility of change from multiple to series connection. The first Eimer patent (No. 736,509) showed in the clearest way the removability of the wires from the bottom plate, (p. 1, lines 75-85,) and the same function was disclosed for the curved dome, (p. 2, lines 12-20.) Both bottom plate and dome were separately removable, though of course not mutually interchangeable. furthermore, this patent shows an added conductor in the bottom plate (Fig. 7,) which may be connected in multiple or in series with the main conductor (p. 1, lines 95-102.)

Eimer's second patent was for a longitudinal series of furnaces, of which each one contained three heating-plates, the two side plates being duplicates. The conductors in these plates, as well as the separate furnaces, might be connected in series or in multiple, (p. 2, lines 110-116.) An optional form of setting the conductors in the refractory plates is shown in Fig. 4, where they are not embedded, but are sunk in grooves or depressions, (p. 1, lines 86-91,) from which they might be removed.

Timme's two patents (U. S., No. 589,048; German, No. 95,322) contained removable and interchangeable sides and top and bottom heating-plates. If set up on end, it would differ from Kohn's only in that its horizontal section was a square, instead of a circle, the wires were embedded in the plates, and there was no alternate connection in multiple or series.

Capek (No. 449,035) clearly supplied the last requirement, which he described in detail, (p. 2, lines 24-60.) Even if Eimer's disclosures were insufficient, this left nothing for Kohn in this feature, because Capek's heater was divided into two similar sections, of three units each. These units are each separably removable, and the wire from each as well. He also shows a pot slipping in and out vertically, precisely like Kohn's, and, we think, circular in horizontal section, (p. 1, lines 19-21,) though perhaps that is not wholly clear.

In the face of this art we fail to see any invention in Kohn's furnace. Each element is old, and if the combination of all the elements is not shown, as it is not, the difference appears to us to be only one of design. Certainly it was not invention to set on end the cylindrical furnaces of Hatch, Conlin, or Marsh. Assuming it is a convenience, as we do not deny, to have forms of but one shape, so that any broken form may be replaced by a single reserve, Timme shows it.

The removability of the conductors, an element only in claim 1, is shown in both Eimer's patents, as well as a form of segmental shape in his first patent. The connection in series or in multiple Capek shows, as well as the removable pot.

As in any other case, we should of course yield our *a priori* conclusion to the history of the art itself; but here we get no evidence from that. The patent has not displaced other furnaces; the art got on quite as well before as after it. That it was a handy design, combining the prior elements, though in no new functional relation, we agree; but that, we think, did not put it beyond the competence of an ingenious journeyman designer. All the parts operate as they had before, and produce the same combined result as before. We think the claims void for lack of invention.

[4] As to the estoppel, the appellant is in this dilemma: Either the patent did not revert to him by the sale of January 31, 1912, of the assets of the Multiple Unit Electric Company or it did. He asserts, and indeed must assert, that it did, upon the theory that the sale was a termination of the corporate life within the meaning of his original contract. As to that, we are not disposed to quarrel with his position. But, if so, the Multiple Unit Electric Company ceased to be the owner of the patent on that date, and, if it did, its license on July 2, 1913, was the license of an outsider. Now it appears to us absurd to say that, where some one other than the patentee grants a license the licensee is estopped to dispute the validity of the patent. We make no question of a case in which the license had originally come from the patentee and his assignee subsequently sues. But that is not this case. The estoppel which arises from a license is mutual and includes as much the protection of the licensor from suit for infringement as the licensee's incapacity to dispute the validity of the patent. Were it not so, a license once accepted would be an estoppel forever, though the rule is settled that when the license is ended the estoppel disappears with it. (*Tate v. Baltimore, etc., R. R.*, 229 Fed. Rep., 141; C. C. A., 417; *Dueber Watch-Case Mfg. Co. v. Robbins*, C. D., 1896, 517; 77 O. G., 154; 75 Fed. Rep., 17; 21 C. C. A., 198.) There must be some privity between the two, some bargain between the licensee and one who holds title at the time. Mere admissions may be of weight, but they are not conclusive. Here the motive was clear and explains the reason for taking a license. No one, we suppose, would urge that a defendant in ejectment would be estopped by a lease taken from an earlier owner who had conveyed before the lease was given. We accept the reasoning of the learned district judge on this question.

Decree affirmed with costs.

The following is the opinion of Augustus N. Hand, District Judge, on final hearing in the court below :

HAND, *Dis. J.*:

This is a suit for infringement of United States Patent No. 983,291 to Milton M. Kohn, brought by the inventor against August Eimer, individually, and the Electric Heating Apparatus Company, which Eimer owned and controlled. The complainant, on June 15, 1910, assigned to the Multiple Unit Electric Company, by written instrument of that date, "his certain applications for patents on his inventions for electric furnaces, numbered 520,515, dated October 1, 1910, for electric cooking and heating devices, numbered 525,425, dated October 30, 1909, together with all his right, title, and interest of, in, and to the same, or any of them, and also to any improvements or developments of any of the same which he may hereafter invent or make, for a period of ten years from date of this agreement—

it being expressly understood and agreed that in the event of the dissolution or other termination of the party of the second part, within five years from the date of these presents, that said patents and property right shall revert to and again be the sole property of the party of the first part and that all rights and liabilities of either party hereto under this contract shall cease and come to an end.

The foregoing instrument provided that the complainant should receive a majority interest in the stock of the Multiple Unit Electric Company in consideration for the above assignment and that he should contract to serve the company as general manager for a period of five years at a salary of not less than \$2,600 for the first year. The application, No. 520,575, mentioned in the agreement, thereafter resulted in the patent in suit, No. 983,291. January 31, 1912, the Multiple Unit Electric Company sold all its tangible assets to the defendant Eimer, and that very month the complainant, who had protested against the sale, which had been authorized by a board of directors of the Multiple Unit Electric Company, the majority of which differed with his views, went into the employment of the defendant Eimer and worked upon electric heaters of the general sort embraced in complainant's invention. The president of the Multiple Unit Electric Company wrote various persons having business relations with that company that it had sold its plant to Eimer, who has since conducted business under the trade-name of the company, and that it was no longer engaged in active business. All the books of the company were taken to the office of its attorney, and its business office was discontinued. Eimer in a letter written shortly after (Plaintiff's Exhibit 2) said: "Until the company is liquidated" he would carry on the business in his own name, or "under the name of Electric Heating

Apparatus Company—the new company, which has not as yet been incorporated.”

Kohn remained working for Eimer and the defendant Electric Heating Apparatus Company, which the latter incorporated to do his business, for a year and a half. Kohn did not satisfy Eimer and was finally discharged. Thereupon, on July 2, 1913, the Multiple Unit Electric Company made a written license to Eimer to make and sell furnaces under the Kohn patent upon a 5 per cent. royalty, and Eimer has paid \$251.88 under this license, for 120 electric furnaces made and sold under the Kohn system. This, he says, he ceased to do May 22, 1914.

It is in general true that the existence of a corporation cannot be attacked collaterally, and dissolution only occurs when decreed by a court in dissolution or quo warranto proceedings. The reverter clause contains the word “termination,” as well as “dissolution.” This clause should be given some meaning, and I think its meaning was that of a practical cessation from all business. This is the only meaning, I think, which gave Kohn any protection, and it seems clear to me that, if it abandoned its business and sold its property, the parties intended that Kohn should receive the entire interest in his patents and patent applications. In this view, it is immaterial whether the rights transferred to the Multiple Unit Electric Company were legal or equitable. If the former, the legal title reverted to Kohn; and, if the latter, he had never parted with the legal title, and the equitable title, which he had transferred, reverted to him by virtue of the termination of the corporation.

The letter from the Multiple Unit Electric Company to the Huttoon Simmons Ice Company, under date of February 14, 1912, gives the contemporaneous construction of the rights of the Multiple Unit Electric Company in the Kohn patent, and contains the following formal notice:

Please take notice that the Multiple Unit Electric Company, a corporation, is not now actively engaged in business, having sold its plant, stock, etc., on January 31, 1912, to Mr. August Eimer, of New York City, who has since conducted business under the trade-name and style heretofore used by our company.

Such action, accompanied by an abandonment of the business of the company on its part, and employment of Kohn by Eimer, not only constituted the sort of “termination” of the company referred to in the reverter clause, but completely estopped the company from claiming that Kohn, who had left it by mutual consent to work on electric heaters for Eimer, had not a right to avail himself of his patent rights. The subsequent license to Eimer was, I think, taken by the latter to protect himself as far as he could from any claims of Kohn after he had parted with the latter. Eimer could not, of course,

question the validity of the patent as against the Multiple Unit Electric Company; but he can question it as against another owner, and by virtue of the reverter clause, I think, Kohn, and not the Multiple Unit Electric Company, is the true owner. As the Multiple Unit Electric Company does not own the patent, its license is of no effect.

Passing to the question of original validity, I cannot find any invention in the patent in suit, in view of the patents to Eimer, Nos. 736,509 and 736,917. In Eimer's patent, No. 736,509, the heating wire is placed in undercut grooves, and in No. 736,917 there are no undercut grooves. These furnaces are illustrated in the Eimer & Amend catalogue of 1905, at page 139, and the difference in design shown in the Kohn diagrams did not constitute invention. The lining wall called for by claims 1 and 11 of the patent in suit could be readily employed instead of a crucible, if preferred. I can not imagine such an addition to a then well-known form of furnace a sufficient improvement to create a patentable combination. The Timme German patent is a further reference from which Eimer may have derived most of his original ideas. Whether it be a competent reference, in view of the answer to the interrogatories, has been questioned; but it can make no difference in any case. The Eimer patents are sufficient to deprive the Kohn furnace of any such novelty as justifies patentability. I may say, however, that the case of *Johnson v. Lambert* (234 Fed. Rep., 886; 148 C. C. A., 484) in my opinion allows proof of the state of the art by any pertinent reference.

The Eimer patent, No. 736,917, has a body portion, an upwardly-extending wall, a plurality of forms, an electric conductor carried by each form, means for covering and holding the forms in position within the body portion, and the specification indicates that the conductors can be connected in series or multiple. There is really no element of claims 3 and 8 of the Kohn patent that is not referred to.

It is to be particularly noticed that the Eimer patent, No. 736,917, says that—

Instead of being embedded within said sections, the conductor, as 10, may be sunk or located in longitudinal or other depressions or grooves, as 13, (see Fig. 4,) formed in the inner surface of the sections, which depressions or grooves partly inclose the conductor, while leaving it partly exposed to permit a more intense radiation of its incandescence within the furnace.

This discloses not only the ready removability of the section, but also of the wire dwelt upon in the Kohn patent. I think Eimer evidently testified correctly when he said he claimed Kohn was infringing his patents and that the latter said:

Mr. Eimer, if you let me be your manager and go with you, with your patents and mine, and my knowledge of the manufacture and my system, I can make a good success.

I think it evident that Kohn did not make a success as manager and was discharged for that reason. Eimer took a license from the Multiple Unit Electric Company to protect himself, but really received nothing. Whatever there was belonged to Kohn, and I can see nothing in the Kohn patent, in view of the prior art.

The bill is dismissed, with costs, because the patent is void for lack of invention.

[U. S. Circuit Court of Appeals—Seventh Circuit.]

DE VRY CORPORATION v. ACME MOTION PICTURE PROJECTOR CO.

Decided January 6, 1920.

280 O. G., 809; 262 Fed. Rep., 970.

PATENTS—INVENTION—ANALOGOUS USE—FAN FOR VENTILATING MOTION-PICTURE CABINET.

The employment of a rotary fan for withdrawing heated air from a moving-picture cabinet is not an improvement in the moving-picture art. The alleged improvement relates only to ventilation, and the use of ventilating-fans being common no invention is involved in the specific application; otherwise anyone could obtain a monopoly of the use of a ventilating-fan in every cabinet or box or room into which he put a different apparatus or in which existed a different condition on account of which he desired ventilation for a different purpose. Lockwood patent, No. 929,678, *Held void on motion to dismiss bill.*

APPEAL from the District Court of the United States for the Eastern Division of the Northern District of Illinois.

Suit by the De Vry Corporation against the Acme Motion Picture Projector Company. *Decree for defendant, and complainant appeals. Affirmed.*

Mr. Fred Gerlach for the appellant.

Mr. Luther Johns for the appellee.

Before BAKER, EVANS, and PAGE, Circuit Judges.

BAKER, *Cir. J.*:

This is an appeal from a decree dismissing for want of equity the appellant's bill for alleged infringement of Patent No. 929,678, issued on August 3, 1909, to Lockwood for improvements in apparatus for exhibiting moving pictures. The decree followed a ruling sustaining appellee's motion to dismiss, which was in the nature of a general demurrer.

Claims 14, 15, and 16 were the only ones counted on in the bill. As these claims are all of the same effect so far as determining

the correctness of the ruling on demurrer is concerned, only one of them is subjoined.

16. In an apparatus for exhibiting moving pictures, the combination with a cabinet having a picture film therein, of a light and a light condenser therein, an inclosing casing for said lamp and condenser, and a rotary fan for withdrawing the heated air from said casing and discharging it without said cabinet.

In his specification the applicant acknowledged that the motion-picture cabinet, with its necessary projecting means, was old in the art. He noted that the pictures are printed on a highly-inflammable film of celluloid.

To guard against the possibility of igniting the inflammable film—he said—

I have provided a ventilating apparatus by means of which the air heated by the lamp and in the projector is withdrawn and discharged from the cabinet. As shown, this comprises a rotary fan driven by the motor and which is connected to the casing surrounding the lamp and containing the light condenser; and the fan is connected with a conduit for discharging the hot air out of the cabinet. Thus the temperature within the chamber is prevented from rising to the danger point.

In *Lange v. McGuin* (177 Fed Rep., 219; 101 C. C. A., 389) we spoke of the demurrer in equity pleading in this way:

It is not the province of a demurrer to speak of matters beyond the bill. Of course, every bill is written against the background of common knowledge; and in that view a demurrer may be said to invite the chancellor to take judicial notice of the background. But if a bill, in and by its own averments, states a *prima facie* case, that case cannot properly be overthrown by the chancellor merely on the ground that he judicially knows of facts that would support an answer. His judicial knowledge must go farther, and be so broad and all-embracing that he can properly hold that no facts exists that would tend to controvert the supposed answer and support a replication and the bill. This is so because, if such facts exist, the complainant is entitled to a hearing where he can present and argue the facts, and such a hearing cannot be had on demurrer to the bill.

Under that rule we upheld bills against demurrers in *Westrumite Co. v. Commissioners* (174 Fed. Rep., 144; 98 C. C. A., 178) and *Krell Piano Co. v. Storey & Clark Co.*, (C. D. 1914, 246; 206 O. G., 313; 207 Fed. Rep., 946; 125 C. C. A., 394,) *Wright v. Wisconsin Lime & Cement Co.*, (239 Fed. Rep., 534; 152 C. C. A., 412,) and sustained demurrers to bills in *Chas. Boldt Co. v. Turner Bros. Co.* (199 Fed. Rep., 139; 117 C. C. A., 621) and *Bronk v. Chas. H. Scott Co.*, (211 Fed. Rep., 338; 128 C. C. A., 17.)

In the present case the claims in suit and the specification explanatory thereof make it clear that Lockwood contributed nothing to the strict art of projecting moving pictures, and that his improvement consisted in ventilating by means of a rotary fan the moving-picture

cabinet in order to prevent the inflammable film from being subjected to excessive heat. If invention may be predicated upon that act, then any one could obtain a monopoly of the use of a ventilating-fan in every cabinet or box or room into which he put a different apparatus, or in which existed a different condition on account of which he desired ventilation for a different purpose. (*Jones v. Cyphers*, 126 Fed. Rep., 753; 62 C. C. A., 21; *Baker v. Duncombe Mfg. Co.*, 146 Fed. Rep., 744; 77 C. C. A., 234; *Voightmann v. Perkinson*, 138 Fed. Rep., 56; 70 C. C. A., 482; *National Regulator Co. v. Powers Regulator Co.*, 160 Fed. Rep., 460; 87 C. C. A., 444; *Alexander v. De Moulin Bros. & Co.*, 199 Fed. Rep., 145; 117 C. C. A., 627.)

The decree is affirmed.

[U. S. Circuit Court of Appeals—Seventh Circuit.]

WALKER MFG. CO. *et al* v. ILLINOIS BRASS MFG. CO.

Decided February 24, 1920.

280 O. G., 810; 265 Fed. Rep., 279.

PATENTS—BRACE TO STRENGTHEN RADIUS RODS NOT INVENTIVE.

Claims of the Knudsen patent, No. 1,221,190, for a brace supporting the V-shaped radius-rods of the Ford automobile. *Held* void for lack of invention. When the patentee "found that the radius rods were insufficient to support the strain which hard usage entailed, he sought to strengthen them. Not only was the strengthening of the radius rods the obvious remedy, but a brace was the means which even a layman would have adopted to accomplish the end. To fasten one end of the brace to the lower side of the axle and to attach the other end to the radius rod was not only the obvious way, but it was practically the only way."

APPEAL from the District Court of the United States for the Eastern Division of the Northern District of Illinois.

Suit by the Walker Manufacturing Company, Becker Christian Knudsen, and the Vaughn-Harris Company against the Illinois Brass Manufacturing Company. *Decree for defendant, and complainants appeal. Affirmed.*

Otto R. Barnett for the appellants.

Max W. Zabel for the appellee.

Before BAKER, EVANS, and PAGE, Circuit Judges.

EVANS, *Cir. J.*:

Suit to restrain infringement of patent to Knudsen, No. 1,221,190, covering "radius rods for automobiles." The device, while not limited in its application, is intended primarily to support radius rods in Ford automobiles; the inventor stating that his—

invention relates to radius rods employed to brace and hold in position the front axle of an automobile of the type consisting of the two rods meeting and

joined together at an angle at which point an enlargement of globular form is situated and contained in a ball and socket bearing attachment to the bottom of the engine and crank case. * * * My invention consists in a brace attached to said radius rods at a point between the two extremities and extending to that point on the lower side of said front axle, where the end of the spring hanger in the form of a thread bolt protrudes through a hole in the axle, the end of said brace rod which is of a shape suitable for the purpose is attached to said lower end of said spring hanger and * * * securely fastened thereto.

Four claims appear in the patent, two of which are herewith quoted and are typical:

2. The combination with a V-shaped radius rod, for motor vehicles, the crotch of said radius rod having a swivel connection with the transmission case of the motor vehicle, and having its legs connected to the top of the front axle, of a V-shaped subradius rod having an attachable and detachable connection with the crotch of the radius rod and having its legs connected to the bottom of said front axle.

4. The combination with a V-shaped radius rod for motor vehicles, the crotch of the radius rod having a swivel connection with a fixed part of the motor vehicle and having its legs connected to the top of the front axle, of a V-shaped subradius rod and connected at one end to said radius rod near its crotch and at its other end to said axle.

The patentee clearly made known the object of his invention when he said:

The object of my invention is to re-inforce and strengthen said front radius rods, so that they will resist the violent jar imparted to them on the road and yet maintain their original shape thereby successfully serving to keep the front axle in alinement and facilitate safety and the easy steering qualities of the automobile.

In other words, the applicant sought and secured a patent upon a brace that supported the V-shaped radius rods of the Ford automobile. Appellee denied infringement and also attacked the validity of all claims.

Claims 1 and 2 provide for the attachment of the brace to the radius-rod "at the crotch." The importance of the place of attachment is emphasized by examining the third and fourth claims, both of which provide for the attachment "near its crotch." The infringing structure is not attached at the crotch, and we therefore dismiss these claims without further consideration, on the ground that their infringement does not appear.

This defense does not exist as to claims 3 and 4, but as to them appellee insists that both are invalid for want of invention.

The problem which patentee attacked was certainly not a difficult one. When he found that the radius-rods were insufficient to support the strain which hard usage entailed he sought to strengthen them. Not only was the strengthening of the radius-rods the obvious remedy, but a brace was the means which even a layman would have

adopted to accomplish the end. To fasten one end of the brace to the lower side of the axle and to attach the other end to the radius-rod was not only the obvious way, but it was practically the only way. Such attachment might be either at the end of the radius rod—that is, at the crotch—or between the crotch and the axle, or it might be nearer to the crotch than to the axle. Certainly to describe it as being “near the crotch” does not suggest, nor has the counsel furnished us with any reason for attributing, genius to patentee in selecting his place of attachment. With the location of the place of attachment eliminated, we find nothing in the patent but a brace for a rod. We are unable to agree with the Patent Office that this constitutes invention. (*Crouch v. Roemer*, C. D., 1881, 202; 19 O. G., 1067; 103 U. S., 797; 26 L. Ed., 426; *Pope Mfg. Co. v. Arnold*, *Schwinn & Co.*, 193 Fed. Rep., 649; 113 C. C. A., 517; *Stevenson v. Shalcross*, 205 Fed. Rep., 286; 123 C. C. A., 438; *W. F. & John Barnes Co. v. Vandyok Churchill Co. et al.*, 213 Fed. Rep., 637; 130 C. C. A., 301; *Streit v. Kaiper et al.*, 143 Fed. Rep., 981; 75 C. C. A., 167; *Luten v. Washburn*, C. D., 1919, 292; 263 O. G., 481; 253 Fed. Rep., 950; 165 C. C. A., 392.)

The decree is affirmed.

[U. S. Circuit Court of Appeals—Sixth Circuit.]

JENNISON-WRIGHT Co. v. HEMPY.

Decided May 4, 1920.

281 O. G., 207; 266 Fed. Rep., 372.

1. PATENTS—ACQUIESCENCE IN REJECTION OF CLAIM IMMATERIAL UNLESS CLAIM ISSUED INCLUDES DEFENDANT'S DEVICE.

Under usual conditions acquiescence in the rejection of a claim by the Patent Office is of no importance unless the court is called on to determine whether the claim as issued has a scope sufficiently broad to include defendant's somewhat variant device.

2. SAME—CLAIM FOR WOODEN PAVEMENT VOID FOR WANT OF INVENTION.

The Jennison patent, No. 1,061,296, for a wooden pavement consisting of wood paving-blocks with a spacing projection extending in the direction of the grain along the vertical side of the block, *Held* void for want of invention, such spacing projection having been used on clay and brick paving-blocks and the only specific advantages of the patentee's pavement being those inherent in the material selected.

3. SAME—CHANGE OF MATERIAL NOT PATENTABLE.

A mere change of material is not patentable.

APPEAL from the District Court of the United States for the Eastern Division of the Southern District of Ohio; John E. Sater, judge.

Suit by the Jennison-Wright Company against George L. Hempy.
From a decree dismissing the bill, plaintiff appeals. Affirmed.

Mr. A. M. Allen and Mr. Ralph Emery for the appellant.

Mr. Edward Rector for the appellee.

Before KNAPPEN, DENISON, and DONAHUE, Circuit Judges.

PER CURIAM:

The appellant, as owner of the patent in suit, appeals from a decree dismissing an infringement bill on Patent No. 1,061,296, granted to Jennison May 13, 1913, for a wooden pavement. The second claim sufficiently indicates the subject-matter involved. It is:

The combination with a wood paving block, provided with an integral wood projection extending in the direction of the grain of the block along a vertical side of the block, of a second block spaced from the first by the said projection.

If, as is claimed, the defendant uses the identical construction, the validity of the patent is the only thing involved. A wooden-block pavement should be laid with the end of the grain at the top, and properly spaced to permit filling the interstices; each block should also be capable of expansion without distorting or "buckling" the pavement. Plaintiff's "integral wood projection" or rib, running with the grain, serves as an index, facilitating laying the block with the grain vertical, and also serves as a spacer in the laying operation. It is also said that this rib will crush, with relative ease, in case of block expansion, thereby permitting adjacent blocks to fill the intervening space, and that, in spite of such crushing, the rib and the adjacent portions of the block will have sufficient elasticity to resume in part their original shape when contraction later occurs. It is denied that these elements of usefulness exist in more than negligible form; but, for present purposes, we assume that that they carry substantial utility.

(1) In his original application, Jennison asked for a claim on a paving-block with a "crushable spacer." This being rejected upon reference to a brick of similar form with a similar rib or spacer, which the Patent Office considered crushable, he amended so as to claim a paving block with a "fibrous, crushable spacer." This was again rejected, both because he was attempting to describe his invention by adjectives, and because of the existence of wooden-block pavements having a horizontal wooden strip interposed as a spacer between adjacent rows of blocks. He then formulated his claim as it was issued. It is evident that the specific form of spacer finally described in the issued claim is crushable in the sense in which Jennison uses the word, and is fibrous, and the case is therefore one where, having made a broad claim and then having accepted a narrower one, the patentee would not be permitted to expand his claim as issued, so as to have the broader scope which he once abandoned;

but, since we assume that the defendant uses the exact and specific form to which the patentee limited himself, there is no occasion to resort to the rules of estoppel by Patent Office proceedings, or to place any dependence upon those rules in reaching a conclusion. Under all usual conditions, acquiescence in the rejection of a claim is of no importance, unless the court is called upon to determine whether the claim, as issued, has a scope sufficiently broad to include defendant's somewhat variant device. (*Baltzley v. Spengler Co.*, C. C. A., 2; 262 Fed. Rep., 423.)

(2, 3) However, we do not find this Patent Office history wholly irrelevant. It emphasizes the fact that whatever special utility is attributable to the precise form and location of the spacing-rib, as described in the claim and as compared with former known structures, is due to the inherent qualities of wood as compared with baked clay. There were earlier clay or brick paving-blocks of substantially the same form. Wooden paving-blocks were in common use; it was known that they should be set with the grain vertical; an integral spacing-rib would naturally be made with the grain parallel with the grain of the block—indeed, it might be difficult to make it in any other way; and this made the rib vertical, just as were the spacing-ribs of the clay block. Because the wooden block and the rib were fibrous, with corresponding grain, the rib would crush or sink into the block with comparative ease, and there would be a measure of elasticity tending to return the parts to their original shape. These things would not be true of the brick of similar shape; but these results come from the known qualities of wood. All the specific advantages which the patentee, at the end of his course in the Patent Office, found himself relying upon were merely those which were inherent in the selected material itself; and those qualities of wood were familiar to all. We think the case is a plain one for the application of the rule that a mere change of materials is not patentable; because, after all is said, it remains clear that Jennison did nothing else. There is rather close analogy to the facts involved in *Brown v. District of Columbia* (130 U. S., 87; 9 Sup. Ct., 437; 32 L. Ed., 863) and in *Pressed Steel Co. v. Brownell & Co.*, (C. C. A., 6; 123 Fed. Rep., 86; 59 C. C. A., 216,) and the situation is practically parallel to that discussed by the Second Circuit Court of Appeals in *N. Y. Belting & Packing Co. v. Sierer* (158 Fed. Rep., 819; 86 C. C. A., 79,) where rubber tiles of smooth, rectangular form had been well known (as wooden paving-blocks of that form had been,) and tongue-and-groove tiles of a pottery material were also known, and the patentee made a rubber tile in the tongue-and-groove form of the old pottery material. This was held not to involve invention.

Appellant relies especially upon *Frost Co. v. Cohn* (C. C. A., 2; 119 Fed. Rep., 505; 56 C. C. A., 185.) This may be easily distin-

guished. Clamping-studs of the shape and for the purpose shown had been made of metal, and yet it was held to be invention to make one of the same shape out of rubber. If it had been old to make these studs out of rubber in other forms and shapes, the patent, clearly, would not have been sustained; but what impressed the court as deserving was the thought that rubber could be used at all in that association and for that purpose. To make the present case parallel, it would have to be supposed that wooden paving-blocks had never been used at all, and that would put a very different aspect on the matter.

The decree is affirmed.

[U. S. Circuit Court of Appeals—Second Circuit.]

WHITLOCK COIL PIPE CO. v. MAYO RADIATOR CO.

Decided April 14, 1920.

281 O. G., 412; 266 Fed. Rep., 215.

1. PATENTS—AUTOMOBILE-RADIATOR MADE OF "CONTINUOUS STRIP."

The Brinkman patent, No. 843,864, for a cooler or radiator for motor-cars, claims of which specify the refrigerator-section as constructed of a "continuous strip of metal," the specification stating how it may be bent upon itself, *Held* not restricted to the literal terms employed, but to cover a radiator made up of a plurality of separate sections.

2. SAME—"CONTINUOUS STRIP" MAY CONSIST OF SEPARATE STRIPS SOLDERED TOGETHER.

In the Brinkman patent, No. 843,864, for a radiator for motor-cars, in a claim for a "continuous strip" of metal, "continuous" should be taken in a mechanical sense, and two pieces of metal contiguously placed and soldered together may be considered as a continuous strip when together they function like one strip.

3. SAME—BRINKMAN PATENT, No. 843,864, FOR MOTOR-CAR RADIATOR, VALID AND INFRINGED.

The Brinkman patent, No. 843,864, for a cooler or radiator for motor-cars, *Held* valid and, as disclosing the first honeycomb construction of an automobile-radiator, is entitled to a liberal range of equivalents; also *Held* infringed.

APPEAL from the District Court of the United States for the District of Connecticut.

Suit by the Whitlock Coil Pipe Company against the Mayo Radiator Company. *Decree for defendant, and complainant appeals. Reversed.*

For opinion below, see 257 Fed. Rep., 752.

STATEMENT OF THE CASE.

Plaintiff owned and sued upon the three claims of patent to Brinkman, No. 843,864, dated February 12, 1907, application filed January

29, 1903. The invention is for a "cooler." The article described finds its use as a radiator for motor-cars driven by gasoline-engines. Water in the jacket of such engine is cooled by going through passages or conduits, whose external surface is as freely as possible exposed to the air. Earlier and familiar types of radiators are illustrated by the Daimler apparatus (British 10,257, of 1898), which is (in the language of a claim) a—

vessel adapted to receive the water, with tubes passing through said vessel and being opened at both ends, and with means for effecting a strong draft through said tubes.

In various forms it was art prior to Brinkman to make a radiator of tubes of appropriate length spaced apart and parallel with each other, and fixed at each end in a wire or metal screen or holder into which the tube ends were soldered or otherwise appropriately made water-tight. Into the box thus interrupted by tubes which were air-passages water flowed, and passing between the tubes was cooled. Brinkman's effort was, according to his specification, to—

simplify the construction, decrease the weight, and reduce the cost of this class of refrigerating apparatus, and at the same time increase its efficiency * * * by constructing [the refrigerating section of a radiator] from a continuous strip of sheet metal which is crimped or corrugated, so that when the corrugated sheet is bent or returned upon itself at regular intervals the corrugations will match and form the opposite sides of a tubular space for the passage of air. But * * * the sheet at every alternate interval is corrugated in opposite directions, in order that every alternate fold of the sheet will produce a narrow, continuous, serpentine passage through which water may flow in a thin layer in contact on both sides with the walls of the air-tubes.

His water-passage was made of appropriate and desired width by "offsetting" the edges of the corrugated metal strip and bringing said set-off edges into soldered contact. This construction produces what is fairly described as the "honeycomb" or "cellular" type of radiator, fabricated of thin sheet metal, preferably copper. It avoids the construction of a framework of pipes held by terminal wires or sheets in spaced relationship.

Brinkman in his specification declared that he did not confine himself to any particular shape of corrugations, and his first and most general claim is as follows:

In an apparatus of the class described, the combination with a water chamber 5 and a water chamber 7, of an interposed refrigerating section, consisting of a continuous strip of corrugated sheet metal doubled upon itself in a series of folds, with the ends of the folder sections attached to said water chambers, and inclosing a series of restricted water spaces communicating at the ends of the folds with said water chambers, substantially as described.

The second claim varies from the first in specifying the "offset edges" of the strip of corrugated metal, and the third is as follows:

In an apparatus of the class described, the combination with upper and lower water chambers, of a refrigerating section between said water chambers, said refrigerating section consisting of restricted water passages between said chambers, said water passages having inclosing walls of sheet metal with their edges offset in opposite directions, brought into contact and soldered together, and of a series of parallel air passages between said water passages and transversely thereto, formed by the contact of said inclosing walls.

Defendant's radiator is likewise composed of corrugated metal, but the corrugation or bending is so acute that, when one bent strip is fitted to another, a series of square air-passages is produced, but the water-passages result from offset edges as described by Brinkman. The trial court held the patent invalid, but, if so construed as to be valid, not infringed. *Plaintiff appeals.*

Mr. Harrie E. Hart (Mr. Robert H. Parkinson of counsel) for the appellant.

Mr. Franklin G. Neal for the appellee.

Before WARD, ROGERS, and HOUGH, Circuit Judges.

HOUGH, *Cir. J.*, (after stating the facts as above:)

(1) That broad claims do not broaden invention, nor protect what (usually in the light of subsequent competition) the patentee thinks he invented, is a sound rule, (*Lovell v. Seybold, etc., Co.*, 169 Fed. Rep., 288; 94 C. C. A., 578;)¹ and the dismissal below was rested on this doctrine. The evidence submitted, however, compels us to find that this case is not within the rule. Whether Brinkman made an invention, and, if so, the grade or importance thereof, depends, not only on what he did, but when he did it; for it is common knowledge that ever since about the time of his filing date inventors of all ranks have been very busy with motor-cars and their appurtenances. The trial court made no finding as to date of invention, but we perceive no difficulty in assigning the early summer of 1901 as the time when Brinkman physically embodied his fundamental idea in a section of radiator. Commercial construction followed in the fall of 1902.

In 1901, so far as this record reveals facts, Brinkman was the first to make or propose to make a radiator suited for the hard service of a motor-car out of thin sheet metal, using the corrugations thereof, connected or slightly separated as desired, to form tubes or passages for both air and water, and to obtain by attaching one corrugation to another and indefinitely repeating the conjunction a structure of any desired size that may almost be called integral and is both

¹ This ruling was long ago made by Blatchford, J., in *Masury v. Anderson*, (11 Blatchf., 165; Fed. Cas., No. 9,270.) He added that if, while operating under his patent, the patentee "at one time insists on too much, or at another on too little, he does not thereby work any prejudice to the rights actually secured" to him by his patent.

strong and light. The rank of an invention often depends on the nature or extent of the art which may be invoked to explain or limit it. Corrugated sheet metal had been used to facilitate the condensation of steam, (Ljungstrom, No. 574,157,) and that art may be admitted as cognate; but Brinkman first made the honeycomb-radiator of an automobile, and he therefore stands "at the head of a class [and] is entitled to a liberal range of equivalents" (*Lamson, etc., Co. v. Hillman*, 123 Fed. Rep., 423; 59 C. C. A., 517) unless defeated by some weakness other than the nature of his inventive thought.

The only prior art worthy of mention is Maybach, whose several foreign patents are earlier than his United States Patent No. 709,416. That device may be described, in words largely taken from specifications, as a means of determining and maintaining a spaced arrangement of preëxisting tubes; the air going through the tubes and the water through the spaces. It may be as good a radiator as that described in the patent in suit, but to us it does not even suggest the "honeycomb" construction.

Unless the patent be limited to the exact device, or rather to the mode or method of making the machine set forth in the specification, infringement can not be denied; and indeed we think it is not denied.

Such limitations is asserted, because the first and second claims specifically define the "refrigerating section" of the cooler as "consisting of a continuous strip of corrugated sheet metal;" and the specification tells at considerable length how the sheet can be doubled upon itself and the operation repeated. If the radiator of a large truck were thus fabricated, it would require a metal strip 550 feet long, and Brinkman never made his machines in that way; he has always taken strips of convenient length and soldered them together when in place, and so does the defendant.*

(2) Accordingly defendant asserts that upon "the continuous strip of sheet metal the whole patent is predicated." The argument is not without strength, but cannot prevail; for the matter is not in the ordinary sense one of construction whereof the rules have been recently restated in *Fulton Co. v. Powers, etc., Co.*, (C. C. A., 263 Fed. Rep., 578.) The construction here appropriate is purely verbal, for if the substance of invention as described be regarded, the defendant is plainly within any reasonable range of equivalents, as that phrase is so well defined by Sanborn, J., in *National, etc., Co. v. Interchangeable, etc., Co.*, (C. D., 1897, 739; 81 O. G., 1423; 106 Fed. Rep., 710; 45 C. C. A., 544;) and if we have rightly apprehended the essential nature of this invention it is equally certain that defendant has taken "the substance" thereof. (*Cimioti, etc., Co. v. America, etc., Co.*,

* We have not overlooked Brinkman's later patent, No. 779,581, but think it relates to a different type of radiator, and that it contains no language inconsistent with plaintiff's position as to the patent in suit.

C. D., 1905, 729; 116 O. G., 1452; 115 Fed. Rep., 504; 53 C. C. A., 230.)

Thus the final question is whether the unfortunate phrase, "continuous strip" of metal, puts claims 1 and 2 in the list of—

patents * * * couched in language so plain and unambiguous as to leave no room for construction. (*Ryan v. Metropolitan, etc., Club*, 144 Fed. Rep., 699; 75 C. C. A., 515.)

We think not; and as matter of verbal interpretation we agree with Coxe, J., (*Brown v. Reed Mfg. Co.*, C. C.; 81 Fed. Rep., 48; appeal dismissed, 96 Fed. Rep., 1005; 37 C. C. A., 665,) that "continuous" may and here should be taken in a mechanical sense; and two pieces of metal contiguously placed and soldered together may be considered as a continuous piece when together they function like one piece.

Acceptance of this signification for "continuous" renders it unnecessary to inquire along somewhat broader lines whether, considering that generic inventions in their first embodiments frequently work imperfectly, Brinkman's severing of metal sheets was more than that "mere readjustment" thought immaterial by this court in *Scott v. Fisher Co.* (145 Fed. Rep., 922; 76 C. C. A., 447) or whether defendant has—

used the idea of the patent modified only in respects which the patentee left open for modification. (*Van Kannel, etc., Co. v. Straus*, 235 Fed. Rep., 137; 148 C. C. A., 631.)

It also avoids consideration of the third claim.

Decree reversed, with costs, and the cause remanded, with directions to sustain the claims in suit and grant the usual interlocutory decree.

[U. S. Circuit Court of Appeals—Sixth Circuit.]

OHIO RAKE CO. v. BUCHER & GIBBS PLOW CO.

Decided June 8, 1920.

281 O. G., 790; 266 Fed. Rep., 891.

1. PATENTS—COMBINATION OR AGGREGATION—NOVEL COMBINATION OF ELEMENTS.

The Niesz reissue patent No. 13,163, for a four-gang disk harrow consisting of a set of inthrow-disks connected by a flexible reach-bar behind a set of outthrow disks, so that the whole harrow may be turned without tearing up the earth, *Held* to cover a new and patentable combination, although inthrow and outthrow disk machines were old, four-gang plows were old, and cultivators of other types had been previously arranged in tandem fashion and connected by a flexible reach-bar, the combination of the flexible reach-bar with the other elements being novel and possessing utility.

2. SAME—INFRINGEMENT—EQUIVALENT.

Claims of the Niesz reissue patent, No. 13,163, for a four-gang disk harrow, which include a "central" reach-bar, *Held* not limited to a reach-bar "on the median line" or to a reach-bar made of a single piece, as disclosed in the patent, the word "central" being taken to mean a central location generally and "reach-bar" being broad enough to include, at least as equivalent, two draft-bars.

APPEAL from the District Court of the United States for the Southern District of Ohio; Howard C. Hollister, judge.

Suit by the Bucher & Gibbs Plow Company against the Ohio Rake Company. *Decree for plaintiff, and defendant appeals. Affirmed.*

Mr. Alfred H. Allen (*Messrs. Allen & Allen* on the brief) for the appellant.

Mr. Harry Frease for the appellee.

Mr. Thomas A. Banning *amicus curiæ*.

Before KNAPPEN, DENISON, and DONAHUE, Circuit Judges.

KNAPPEN, *Cir. J.*:

Suit for infringement of reissued Patent No. 13,163, November 1, 1910, to Niesz. The device of this patent is a four-gang disk harrow: that is, one consisting of two sets, a front and a rear, each carrying two gangs of oppositely-facing concavo-convex disks, the gangs of each set being adjusted angularly to each other. In the front set the disks face outwardly, the angle of the gangs extending rearwardly, thus making what is called an "outthrow" harrow. In the rear set the disks face inwardly, the angle of the two gangs extends forwardly, thus making an "inthrow" harrow. The front set, when connected with the tongue, forms a completely-operable outthrow-harrow; the rear set, if its frame were similarly connected, would form a completely-operable inthrow-harrow. In each case the concave face of the disks is presented to the earth.

It is necessary to the most effective cultivation that the disks carried by the rear frame track between those carried by the front frame, so that the soil turned by the forward disks is by the rearward disks turned back into the trench caused by the forward disks, thus leaving the soil smooth and uniform. It is also essential to the best results that the harrow be able to make short turns in the field without cutting into or scraping off the surface of the soil. To maintain proper tracking between the front and rear gangs, and at the same time sufficient flexibility to enable the harrow to turn without digging into the ground, the inventor connects the rear disk-carrying frame to the front disk-frame by a reach pivotally connected to the rear end of the tongue, thus making a central, flexible draft connection. Supports for the ends of the gang-frame between plates secured to the main rear frame are provided, to prevent tilting of the gangs in making a turn.

The first three claims embrace the front and rear disk-carrying frames as described, together with the central, flexible draft connection between them. The fourth, fifth, and sixth claims include also the antitilting device. We print in the margin the first claim in full, together with a description of the antitilting device contained in the fourth claim.¹ Both invention and infringement are denied. The district judge found each of the six claims valid and infringed. This appeal is from the interlocutory decree awarding injunction and accounting.

1. *Invention*.—Both separate outthrow and separate inthrow harrows, carrying respectively two gangs of disks diagonally disposed to each other, were old. The same is true of mere tandem arrangement of cultivating devices (as distinguished from front and rear double-disk gangs,) as shown by Lyon's revolving harrow, Thompson's land-roller, and Bramer's "wheel-harrow."

The tilting device of the patent in suit was disclosed by Gault and Tracy (1886,) and substantially by Clark (1002.) Dow (1888) and Clark (1894 and 1902) had disclosed four-gang disk harrows, but neither had a central, flexible draft connection, but, on the contrary, each had a rigid connection between the two harrow-frames. While Thompson's land-roller and Lyon's revolving harrow, as well as some other cultivating implements, had shown central, flexible draft connections between front and rear members, Niesz was the first to clearly disclose in a four-gang disk harrow belonging to the art immediately in question a central, flexible draft connection between the two disk-carrying frames.

In so saying we do not overlook the fact that Wildman (No. 686,174, November 5, 1901) disclosed a four-gang disk harrow; its rear portion being divided into two separate parts, whose shafts were mounted in frames pivotally connected together, the forward central part being—

swivelly mounted in the frame * * * at the butt end of the tongue.

But Wildman's invention involved no problem of preserving tracking alinement between front and rear gangs, for his front portion was merely—

adapted to cultivate the central strip of ground not touched by the other two parts,

¹ 1. In a disk harrow, the combination with a front draft frame having two separate disk-carrying shafts adjustable to assume a rearwardly converging angle, and harrow disks carried by said shafts, of a separate rear disk frame having two separate disk-carrying shafts adjustable to assume a rearwardly diverging angle, harrow disks carried by the shafts, a reach bar having its rear end connected to the rear frame and extending forward to the front disk frame, and a horizontally swinging pivotal connection between the reach bar and the front frame and located in a longitudinal line with the apex of the converging angle of the forward disk-carrying shafts.

And horizontal slidable engaging members between the disk frames and the rear frames to prevent a tilting movement of the disk frames.

which were widely separated. Moreover, it does not clearly appear that Wildman's rear frame was pivotally or flexibly connected with the front frame. Such connection is not disclosed in his specification, nor is it clearly contained as an element of either of his claims, nor clearly disclosed by either of the drawings. The words "pivotally mounted," found in the first claim, seem quite as likely to refer to the pivoting of the two portions of the central part to prevent tilting. The Wildman reference falls, in our opinion, within the rule referred to in *Munising Paper Co. v. American Sulphite Pulp Co.* (C. C. A., 6; 228 Fed. Rep., 700; 143 C. C. A., 222, and cases there cited.)

Nor do we overlook the Tschantz disk-harrow patent, No. 344,293, June 22, 1886. But while in the Tschantz harrow the frame carrying the rear set of disks is pivotally attached to the tongue, Tschantz does not properly belong to the art we are considering. Not only are both his front and rear shafts integral, and thus without angular adjustability of oppositely-facing disks (as expressly called for in the first three claims of the patent in suit, and impliedly in the remaining three), but the disks are not concavo-convex, as are those of the patent in suit. All three expert witnesses so treat the disks of the Niesz patent, as do counsel for both plaintiff and defendant. The angular arrangement of the two gangs of disks in a given set seems to be provided on account of the concavity of the disks. Certain it is that in the modern disk cultivator the disks are concave, and nowadays such concavity is usually implied in the term "disk cultivator," although, strictly speaking, a disk need not be of that form. Moreover, the specification of the Tschantz patent states that—

the clod-cutting disks are fixed rigidly on a shaft at an obliquity or inclination from a right angle, and both shaft and disks revolve. In revolving, therefore, the disks have a wobbling motion.*

"The action of one part of the entire structure modifies and affects the action of the other part, and there is during the active period more than that mere aggregation which defeats a patent." (*Houser v. Starr*, C. C. A., 6; 208 Fed. Rep., 264; 121 C. C. A., 462; *Mausoleum Co. v. Stevert*, C. C. A., 6; 213 Fed. Rep., 225; 129 C. C. A., 569.)

(1) If Niesz's central, flexible draft connection, as applied to disk harrows of the type in question, involved invention, the claims are all, in our opinion, valid. Each contains that element, in some form of expression, and we are not impressed with the contention that the claims are subject to the defense of aggregation. It is not correct to

* It is a matter of at least curious interest that in defendant's Lathrop patent on disk harrows, applied for July 6, 1910, (four days before the application for the Niesz reissue, 24 years after Tschantz and nine years after Wildman), it is said: "Heretofore in such constructions the frames carrying the two gangs of disks have either been rigidly connected together to form a single rigid frame, or the frames for the two gangs have been separate and merely coupled in tandem, by a central coupling bar."

say, as defendant's counsel says, that whatever invention there is in the Niesz patent must rest in—

coupling an old single in-throw harrow in tralling or tandem relation to an old out-throw harrow.

We think each of the claims in suit covers a true combination.

(2) The defense of aggregation apart, the claims may of course involve invention, despite the fact that every element is old, provided the combination accomplishes a materially better result or reaches that result in a new and materially better way. (*Loom Co. v. Higgins*, 105 U. S., 591; 26 L. Ed., 1177; *Loose Leaf Co. v. Leaf-Binder Co.*, C. C. A., 6; 230 Fed. Rep., 120; 144 C. C. A., 418; *Ferro Concrete Constr. Co. v. Concrete Steel Co.*, C. C. A., 6; 206 Fed. Rep., 666; 124 C. C. A., 466.)

(3) But, in the view we take of the case, the question, so far as concerns this branch, is whether there was invention in applying to the four-gang-disk-harrow art the central, flexible draft connection previously used in cultivator arts not employing concavo-convex disks. In our opinion there was such invention. When Niesz entered the field, disk harrows had been in use thirty or more years. Every one knew that proper cultivation of the soil required that the disks be in angular relation to the line of draft; also that, if all the disks carried by a given frame faced in one direction, the lateral pressure of the soil and the diagonal inclination of the disks would tend to cause the entire series to move laterally on a diagonal line, causing what is called "side thrust;" but that the opposite facing of the disks of the gangs in a given series tends to counter-balance the side thrust of one gang with that developed by the opposing gang; hence the opposite facing of the two gangs of disks in a given set. But while, as appears without dispute, and indeed by concession, the disk harrow art had for years presented the live problem of how to combine sufficient rigidity for ordinary forward operation with flexibility enough to permit turning of the machine, without tearing up the earth and materially increasing the draft, yet until Niesz it had occurred to no one to employ the central, flexible draft connection used in other cultivating-machines. Whether this was because the prior art recognized that the combination of inthrow and outthrow sets of disks had a tendency to lateral displacement, and so to interfere with the proper trailing of front and rear sets of disks (plaintiff's expert testifying, without dispute, to such prior art recognition,) is not of controlling importance.

The fact of real significance is that, for some reason, prior to Niesz it seems to have been the accepted view among those interested in developing the disk harrow art that a rigid connection between front and rear gangs was necessary to the preserving of proper aline-

ment in the forward operation. It is not important to determine the basis of that belief, nor is it necessary to invention on the part of Niesz that he should have known just why it was that through a central, flexible draft connection (notwithstanding, as stated, a supposed contrary tendency) the rear gang of disks would turn fully as effectively as in the case of an ordinary wagon wheel, or, as plaintiff's counsel contends, even more effectively. While, in the light alone of what Niesz did, it would now seem that his conception ought to have been always obvious, the question of invention must be determined in the light of the further facts that until Niesz manufacturers were seeking a satisfactory solution of the problem before referred to, without finding it, and notwithstanding central, flexible draft connections as applied to other cultivating instruments were well known, and that Niesz's invention was received with great public favor; a large number of manufacturers, including defendant itself, obtaining licenses for manufacturing thereunder and operating under such licenses. The Niesz reissue was sustained, and infringement found, by District Judge Day in 1913; the decision not being appealed from. (*Bucher & Gibbs Plow Co. v. International Harvester Co.*, D. C., 211 Fed. Rep., 473.)

2. *Infringement.*—The important question on this branch of the case is whether Niesz's invention is broad enough to cover defendant's draft connection as a substantial equivalent for the device of the patent. We think this question must be answered in the affirmative. It is true that defendant's draft connection is not in the form of a single reach on the median line of the machine, but consists of two draft-bars a short distance apart, one on each side of the median line and equidistant therefrom; each bar being pivotally and flexibly connected with the tongue, and at its rear end rigidly connected to a coupling-bar, which in turn is pivotally connected at its front end to the respective gangs of the rear set. In our opinion the word "central," found in the fifth and sixth claims, does not necessarily mean "on the median line," but may properly refer to the central location generally. Equally, we think, the words "reach" and "reach bar" of the first three claims are not necessarily limited to a "one-piece" reach. We think that defendant has the substantial equivalent of plaintiff's central, flexible draft connection, notwithstanding the presence in defendant's machine of two draft-bars which never change their relative position, and in spite of the fact that at one point in the turning the pull seems to be entirely on one bar, thus making a "lopsided pull, while the other [Niesz's] has a straight pull."

Defendant's circular advertises its draft connection as—

flexible to a sufficient degree to allow turns to be made without straining the frame,

and it accomplishes this result in substantially the same manner as does plaintiff's draft connection, and within the meaning of all the claims of the patent, unless plaintiff is to be limited to a unitary reach on an absolute median line. It is true that defendant's expert states that in his judgment defendant's device operates in better alinement in straightforward work than does plaintiff's, but not so effectively in the turning movement; but plaintiff's expert testifies to careful observation of both machines in practical field work, and that so far as he can see both are equally effective and work in exactly the same way in both straightforward operation and in the turning movement. It is also not without significance that during the five years between the issue of plaintiff's patent and the issue of the patent owned by defendant, and under which it manufactures, defendant acquired three separate patents, each apparently with the hope of accomplishing the result effected by plaintiff's patent, but without success, and that the still later Imus patent, under which defendant operates, was obviously designed to accomplish the result found in plaintiff's patent and in the same manner, so far as possible without infringing. While no criticism is intended upon this action, yet the history stated, in connection with the previous history of the art, helps to throw light upon the question of infringement.

In our opinion plaintiff is not limited by the prior art, or by the terms of his claims, or both, to the specific construction shown in his patent. We think defendant should be held to infringe each of the six claims in suit.

The judgment of the district court is accordingly affirmed.

[Supreme Court of the United States.]

BONE v. COMMISSIONERS OF MARION COUNTY.

Decided December 15, 1919.

272 O. G., 734; 251 U. S., 184.

1. PATENTS—RETAINING-WALL—PATENT NOT INFRINGED.

Patent No. 705,732, (claims 1, 3, 5, 16, and 17,) to Frank A. Bone, for the combination, with a retaining-wall having a heel, of a metal structure embedded vertically in the wall and obliquely in the heel, so that the weight of the retained material upon the heel of the metal structure will operate to retain the wall in vertical position, or of such a structure having also a toe opposite to the heel, was anticipated in its broad aspects by other patents and publications as to its specific form; *Held* not infringed.

2. SAME—ANTICIPATION—FOREIGN PATENTS AND PUBLICATIONS.

Patentable novelty or originality cannot be asserted of a device which has previously been described in printed publications in foreign countries,

although unknown to the patentee or to others in this country. (Rev. Stats., sec. 4886, ch. 391; 29 Stat., 692, p. 144; 249 Fed. Rep., 211, affirmed.)

THE case is stated in the opinion.

Mr. Clarence E. Mehlhope (*Mr. Arthur H. Ewald* on the brief) for the petitioner.

Mr. V. H. Lockwood for the respondents.

Mr. Justice McKENNA delivered the opinion of the Court.

Suit brought in the District Court of the United States for the District of Indiana to restrain the infringement of a patent for a retaining-wall, which, to quote petitioner, is—

a wall to prevent the material of an embankment or cut from sliding.

After issue joined and proofs submitted, the district court (Anderson, J.) entered a decree dismissing the bill for want of equity. The decree was affirmed by the circuit court of appeals, to review which action this writ of certiorari was granted.

The bill in the case is in the conventional form and alleges invention, the issue of a patent numbered 705,732, and infringement by respondent. The prayer is for treble damages, an injunction and accounting.

The answer of respondent is a serial denial of the allegations of the bill and avers anticipation of petitioner's device by prior patents and publications, in this and other countries.

This summary of the issues is enough for our purpose and we need only add preliminarily to their discussion that Bone's device has the sanction of a patent and a decision sustaining it by the District Court for the Northern District of Ohio and the Circuit Court of Appeals for the Sixth Circuit. The difference of decision in that circuit and the seventh circuit is an important consideration and must be accounted for, which is best done by a display of the patent and the case.

First as to the patent: It describes the invention as being one that—

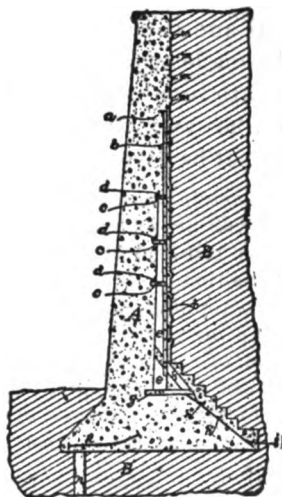
relates to improvements in retaining-walls for abutments of bridges * * *, and such places as it is desired to retain earth or other matter permanently in place with its face at an angle nearer vertical than it would naturally repose when exposed to the action of the elements or gravity;

and—

consists principally of introducing into masonry of concrete, stone, or brick a framework of steel or iron in such a way that the whole wall is so much strengthened thereby that the volume of the masonry may be greatly reduced, and yet the height, base, and strength against overturning, bulging, or setting will still be ample.

The following figure represents a cross-sectional view of the device—A representing the masonry, B the material retained and B¹

the earth on which the wall rests. The metal parts within A are indicated by the smaller letters.



The patent does not insist upon that form of the masonry in all particulars. The base of the wall may be, it is said, "varied to suit the circumstances;" the base may extend to the rear rather than the front—

with proper proportions of metal * * * the form shown in the drawings being what might be called an inverted T, while those suggested would be in the form of an L or reversed L.

The utility of the wall of these shapes is represented to be that it is—

not so liable to be overturned from the pressure of material behind it as would a wall of the same height and area of section, but having a rectangular trapezoidal or triangular-shaped section,

the latter shapes requiring more masonry. And it is said that the patented wall, "having more base and less weight" than such other shapes—

will rest more securely on a soft or yielding foundation, the weight of the material resting on the heel—

causing the latter—

to press on the earth below and thus cause friction to prevent the whole wall from sliding outward.

This is the especial effect of the patent, achieved by the wall of the shape described and distinguishes it, is the contention, from the retaining-walls of the prior art.

The patentee admits, however, that retaining-walls had been "constructed of concrete and steel, but none" to his "knowledge" had

"been supported on their own base as" his, nor had "any of them entirely inclosed the steel within the concrete" nor had "any of them used the weight of the material retained as a force to retain itself."

Such, then, is the wall and the utility attributed to it. The combinations which may be made with it are set forth in 17 claims, of which 1, 3, 5, 16 and 17 are involved in the present action. Counsel for petitioner considers, however, that 1 and 17 are so far illustrative that the others need not be given. They are as follows:

1. The combination with a retaining-wall having a heel, of a metal structure embedded vertically in said wall and obliquely in said heel, so that the weight of the retained material upon the heel of the metal structure will operate to retain the wall in vertical position.

17. The combination with a retaining-wall having an inclined heel and a toe at opposite sides thereof, of a metal structure embedded within said wall and heel, said structure consisting of upright bents at the back part of the vertical wall and continuing down along the upper part of the heel of said wall to the back part thereof, whereby by reason of the toe and the heel the weight of the retained material upon the heel of the metal structure will operate to maintain the wall in a vertical position.

So much for the device of the patent. How far was it new or how far was it anticipated?

Bone's idea was conceived in 1898 and his patent issued in 1902 upon an application made in 1899, but according to his counsel, the value of the invention was not recognized "until after the lapse of several years," when he, Bone, brought a suit against the city of Akron, Ohio, in the District Court for the Northern District of Ohio, in vindication of the patent and in reparation for its infringement. He was given a decree which was affirmed by the Circuit Court of Appeals for the Sixth Circuit. (*City of Akron v. Bone*, 221 Fed. Rep., 944.)

The district court (Judge Day) gave a clear exposition of the patent, the relation of its metal parts¹ to the masonry parts, and their cooperating functions, and adjudged the patent valid and the wall of the city of Akron an infringement of it.

¹ The following is an extract from Judge Day's opinion:

"The reinforcing members [metallic members] are placed near the back face of the wall and heel and near the lower face of the toe. The oblique reinforcing bars in the heel acting in conjunction with the uprights serve the function of a cantilever beam whereby the weight of the material pressing upon the heel is transferred to the upright portion of the wall and operates to retain the wall in a vertical position. * * *

"Considering the claims of the patent, and the testimony, I am of the opinion that Bone, the patentee, was the first to reinforce the retaining wall, or similar wall of concrete or masonry in such a manner that the weight of the retained material would be utilized to impart through the reinforcing members tensile resistance to the stern or vertical part of the wall, thereby fortifying this part of the wall against breaking strains.

"This was an advancement in the art and possessed novelty and the structure of the defendant city infringed this patent.

"While many of the features of concrete structures were old, yet this combination as outlined and described in this Bone application for a patent, was new. It is also in evidence that there has been a large sale and general acquiescence in the Bone patent."

The circuit court of appeals affirmed the decree. The court said that the record disclosed nothing which anticipated "the substantial thought of the patent." If it had done so, or, to quote the exact language of the court—

if the prior art had shown a structure intended for a retaining wall, and having a heel such that the weight of the earth thereon would tend to keep the wall erect, it might be difficult to find invention in merely adding the form of reinforcement most suitable to create the desired tensile strength; but we find no such earlier structures.*

On application for rehearing the court refused to direct the district court to open the case to permit the defendant to put in proof regarding a German publication of 1894.

Those decisions confronted the district court in the present suit and fortified the pretensions of the patent. They were attacked, however, as having been pronounced upon a different record and this conclusion was accepted by the district court. The latter court found from the new evidence the existence of a structure upon the non-existence of which the Circuit Court of Appeals for the Sixth Circuit based its conclusion. The district court said that Bone was not the first to do the things he asserted he was the first to do, and that whatever the record in the sixth circuit might have shown, so far as the record before the court "was concerned, the absolute converse of that proposition" had "been demonstrated."

The court, therefore, as we have said, dismissed the bill for want of equity.

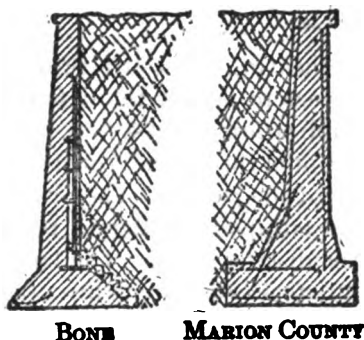
The decree was affirmed by the circuit court of appeals; indeed, the reasoning of the district court was approved after painstaking consideration of the patent and an estimate of the anticipatory defenses; none of which the court said was introduced in the Akron case, "otherwise a different conclusion would have been reached," adducing the opinion of the court. (249 Fed. Rep., 214.) This being so, and there is no doubt it is so, the present case is relieved of

* The following is an extract from the opinion of the circuit court of appeals:

"The record discloses nothing anticipating the substantial thought of the patent. Masonry or concrete retaining walls were deep and heavy, and maintained by gravity in their resistance against a horizontal stress. There was no occasion for reinforcement. Sustaining walls had been built of concrete with vertical reinforcement; but they were maintained against side strain by cross-ties or beams, without which they might tip over. If the prior art had shown a structure intended for a retaining wall, and having a heel such that the weight of the earth thereon would tend to keep the wall erect, it might be difficult to find invention in merely adding the form of reinforcement most suitable to create the desired tensile strength; but we find no such earlier structures. Those which have that shape are sustaining walls only, and were so obviously unfit for use as retaining walls that no one seems to have seen the utility for that purpose, of which the form, when properly adapted and strengthened, was capable. There is also a prior wall, wholly of metal, fairly disclosing a unitary heel adapted to hold the wall erect; but to see that this could become merely a skeleton embedded in concrete may well have required, in 1898, more than ordinary vision. Upon the whole, we think invention was involved, and the claims are valid."

the authority or persuasion of the Akron case and it becomes necessary to consider the prior art and decide the extent and effect of its anticipation.

We have given a cross-section of the device of the patent, showing its shape and strengthening "metallic members," and the patent informs of their coöperative function. We reproduce the device and set by its side the Marion county wall for comparison.



If we may assign novelty to the Bone wall and consider it a broad advance upon the prior art (the extent of its advance, if any, we shall consider later,) we may assign infringement of it by the Marion county wall. To an examination of the prior art we are, therefore, brought.

It would be difficult to add anything to the consideration and comment of the court of appeals. The court cited in support of its judgment a patent issued to François Coignet in 1869, and one issued to Stowell & Cunningham in 1899 upon an application made in 1897, and two articles written by P. Planat which appeared in 1894 and 1896 in a scientific magazine called "*La Construction Moderne*," published in Paris; also a publication which appeared in Germany in 1894 concerning a wall which is given the name of Bauzeitung wall. The article recites that a "utility model patent" had been granted, consisting "of a vertical and a horizontal member."

The Coignet patent is somewhat indefinite. It relates, according to its declaration, to "monolithic structures, or articles made of artificial stone paste" into which irregular-shaped irons are introduced to be—

arranged in such a manner as to interlace each other, so that by the combination of this metallic skeleton and of agglomerated artificial-stone paste the thickness of the walls or size of the articles may be considerably reduced and yet great strength be attained.

It will be observed that there is nothing explicit of how "stone paste" and the "irregular shaped irons" operate or coöperate, aside

from their cohesion or interlacing. Their arrangement is not definite as the "metallic members" in the Bone patent are, so that there might be as in that patent, reinforcing metal in the heel of the wall acting with its upright portion serving the function, to quote Judge Day—

of a cantilever beam whereby the weight of the material pressing upon the heel is transferred to the upright portion of the wall and operates to retain the wall in a vertical position.

If there was any prophecy (to borrow counsels' word) in it the world was slow to discern it, and we are not disposed to give much anticipating effect to it, a view in which we have confirmation in the disclaimer of Bone—he conceding he was not the first to discover the art of reinforcing concrete.

The Planat publications are more explicit. We there see a relation between the metallic and masonry parts of a wall and their coöperation to produce strength in the wall and resistance to the pressure of and bulging from the stress of earth behind it. Both articles, the court of appeals said, "deal with retaining walls of reinforced concrete of the cantilever type" and quoted from the article of 1896 as follows:

These computations suppose that one has effectively realized the fixing of the vertical wall to the horizontal slab at their junction. This fixing requires special precautions. The bars at the point of junction exert a pulling force which tends to pull them out of the concrete. * * * But here we have only a half beam on a cantilever span. It is necessary that the extremities of the bars in the region of fixation should be held in a sufficient mass of concrete or maintained by some other means. * * *

One is able to reduce these projections in a very large measure if one takes care to bind together the vertical bars and the horizontal bars at their point of intersection. In this way the pull of the bar is carried not only on its prolongation, arranged for anchorage, but also on the bar which is perpendicular to it and whose great length permits it to offer a large resistance to the force tending to pull it out transversely.

The court did not enlarge upon other examples of the prior art nor do we think that it is necessary to do so. The court, however, referred to a publication in "*Bauzeitung*" and the patent to Stowell & Cunningham. The former is too technical to quote and the latter has not the simplicity of the Bone device; but both publication and patent represent structures that resist a tendency to tilting or bulging from the pressure of the earth in their rears. The *Bauzeitung* article did this by a wall which consisted of a "vertical and a horizontal member" which were "rigidly connected with each other" and—

the ratios are so chosen that the resultant of the earth thrust passes through the horizontal part or through the foundation respectively, so that there exists no longer any tendency to tilting so long as the two parts continue to be firmly connected with each other.

It is further said:

To increase the stability, the horizontal part is furthermore connected at its rear end by means of anchors with the underground.

It will be observed, therefore, that there are no metallic reinforcing members. It is the shape of the wall—one having a base extending to the rear in the form of an L, the exact antecedent of one of the shapes described by Bone as having advantage over other shapes. And there was also the suggestion of the value of a firm connection between the “vertical and horizontal member.” In other words, the publication showed a retaining-wall having a heel such that the weight of the earth thereon would tend to keep the wall erect, an effect and operation that Bone declares in his patent no wall had attained prior to his invention. And that effect and operation the Circuit Court of Appeals for the Sixth Circuit considered the essence of the Bone patent and the court said that—

it might be difficult to find invention in merely adding the form of reinforcement most suitable to create the desired tensile strength.

The Stowell & Cunningham structure is, as we have said, somewhat complex in its mechanical parts. But these are but details; the physical laws that they are to avail of are explained so that “the volume of masonry” of retaining-walls may be reduced yet retain their strength by the use of metallic reinforcements.

Counsel attack the sufficiency of the asserted anticipations, especially the publications, and in effect say that whatever conceptions lurked in them conveyed no suggestion of a “concrete entity,” to use counsels’ words, to execute them and lament that Bone should be robbed of the credit and reward of adding to the world useful instrumentalities which, but for him, would have remained in theories and the “dust from which respondent recovered them.”

To execute theories by adequate instrumentalities may indeed be invention, but an answer to petitioner’s contention we have given by our comment on the *Bauzeitung* and Planat publications and the fullness of their expositions. Bone may have been ignorant of them and his device may not have been their suggestion. They seem to have been unknown to American engineers, not even the interest of the controversy in the sixth circuit having developed their existence. From this local ignorance nothing can be deduced favorable to the patent. Its device having been described in printed publications, although in foreign countries, patentable novelty or originality cannot be asserted for it. (Sec. 4886, Rev. Stats.; 29 Stat., 692, ch. 391.) Such is the provision of the law and we cannot relax it in indulgence to what may seem the individual’s merit.

The circuit court of appeals, to show the progress of the prior art, made use of the illustrations³ of the patents and publications that preceded Bone's and we also avail ourselves of the same to show that Bone's patent was a step, not a leap, in that progress, and that the only originality that can be accorded it is in its special form and there can be no infringement except by a copy of that form or a colorable imitation of it. We do not think the Marion county wall is subject to either accusation.

The decree of the circuit court of appeals is affirmed.

Mr. Justice DAY took no part in the consideration or decision of this case.

[Supreme Court of the United States.]

CHAPMAN AND CHAPMAN v. WINTROATH.

Decided March 1, 1920.

272 O. G., 913; 252 U. S., 126.

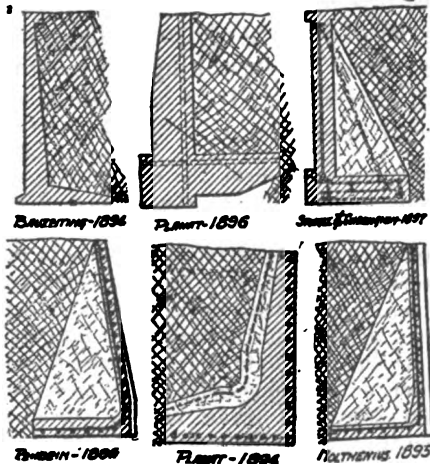
[For opinion below see C. D., 1918, 9; 248 O. G., 1004; 47 App. D. C., 428.]

1. PATENTS—EQUITABLE ESTOPPEL—COPYING CLAIMS OF PATENT.

An applicant who has pending in the Patent Office an application disclosing but not claiming an invention claimed in a patent granted on an application filed during such pendency is within his rights in filing a divisional application for such invention within two years after the granting of said patent and copying claims therefrom for the purpose of interference.

2. SAME—DIVISIONAL APPLICATION ENTITLED TO BENEFIT OF DATE OF ORIGINAL APPLICATION DISCLOSING THE INVENTION.

Divisional applications have not been dealt with "in a hostile spirit by the courts, but, on the contrary, designed as they are to secure the patent to the first discoverer, they have been favored to the extent that where



an invention clearly disclosed in an application, as in this case, is not claimed therein but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date of the earlier, with all of its priority of right. (*Smith & Griggs Manufacturing Co. v. Sprague*, C. D., 1887, 616; 41 O. G., 1037; 123 U. S., 249; *Von Recklinghausen v. Dempster*, 84 D. C. App., 474.)"

ON WRIT of certiorari to the Court of Appeals of the District of Columbia.

Mr. John L. Jackson, (*Mr. Albert H. Adams* on the brief), for the petitioners.

Mr. Paul Synnestvedt for the respondent.

Mr. Justice CLARKE delivered the opinion of the Court.

In 1909 Mathew T. Chapman and Mark C. Chapman filed an application for a patent on an "improvement in deep well pumps." The mechanism involved was complicated, the specification intricate and long, and the claims numbered thirty-four. The application met with unusual difficulties in the Patent Office, and, although it had been regularly prosecuted, as required by law and the rules of the Office, it was still pending without having been passed to patent in 1915, when the controversy in this case arose.

In 1912 John A. Wintroath filed an application for a patent on "new and useful improvements in well mechanism," which was also elaborate and intricate, with twelve combination claims, but a patent was issued upon it on November 25, 1913.

Almost twenty months later, on June 6, 1915, the Chapmans filed a divisional application in which the claims of the Wintroath patent were copied, and on this application such proceedings were had in the Patent Office that on March 24, 1916, an interference was declared between it and the Wintroath patent.

The interference proceeding related to the combination of a fluid-operated bearing supporting a downwardly-extending shaft, and auxiliary bearing means for sustaining any resultant downward or upward thrust of such shaft. It is sufficiently described in count three of the notice of interference:

3. In deep well pumping mechanism, the combination with pump means including a pump casing located beneath the surface of the earth and rotary impeller means in said casing, of a downwardly extending power shaft driven from above and adapted to drive said impeller means, a fluid operated bearing cooperating to support said shaft, said fluid operated bearing being located substantially at the top of said shaft so that the shaft depends from the fluid bearing and by its own weight tends to draw itself into a substantially straight vertical line, means for supplying fluid under pressure to said fluid bearing independently of the action of the pump means, auxiliary bearing means for sustaining any resultant downward thrust of said power shaft and auxiliary bearing means for sustaining any resultant upward thrust of said power shaft.

Wintroath admits that the invention thus in issue was clearly disclosed in the parent application of the Chapmans, but he contends that their divisional application, claiming the discovery, should be denied, because of their delay of nearly twenty months in filing, after the publication of his patent, and the Chapmans, while asserting that their parent application fully disclosed the invention involved, admit that the combination of the Wintroath patent was not specifically claimed in it.

Pursuant to notice and the rules of the Patent Office, Wintroath, on April 27, 1916, filed a statement, declaring that he conceived the invention contained in the claims of his patent "on or about the first of October, 1910," and thereupon, because this date was subsequent to the Chapman filing date, March 10, 1909, the Examiner of Interferences notified him that judgment on the record would be entered against him unless he showed cause within thirty days why such action should not be taken.

Within the rule day Wintroath filed a motion for judgment in his favor "on the record," claiming that conduct on the part of the Chapmans was shown, which estopped them from making the claims involved in the interference and which amounted to an abandonment of any rights in respect thereto which they may once have had. The Chapmans contended that such a motion for judgment could not properly be allowed—

until an opportunity had been granted for the introduction of evidence.

But the Examiner of Interferences, without hearing evidence, entered judgment on the record in favor of Wintroath, and awarded priority to him, on the ground that the failure of the Chapmans to make claims corresponding to the interference issue for more than one year after the date of the patent to Wintroath, constituted equitable laches which estopped them from successfully making such claims. This holding, based on the earlier decision by the Court of Appeals in *Rowntree v. Sloan*, (C. D., 1916, 192; 227 O. G., 744; 45 App. D. C., 207,) was affirmed by the Examiner-in-Chief, but was reversed by the Commissioner of Patents, whose decision, in turn, was reversed by the court of appeals in the judgment which we are reviewing.

In its decision the court of appeals holds that an inventor whose parent application discloses, but does not claim, an invention which conflicts with that of a later unexpired patent, may file a second application making conflicting claims, in order to have the question of priority of invention between the two determined in an interference proceeding, but only within one year from the date of the patent, and that longer delay in filing constitutes equitable laches, which bars the later application. By this holding the court sub-

stitutes a one-year rule for a two-year rule which had prevailed in the Patent Office for many years before the *Rowntree decision*, rendered in 1916, and the principal reason given for this important change is that the second application should be regarded as substantially an amendment to the parent application, and that it would be inequitable to permit a longer time for filing it than the one year allowed by Revised Statute 4894 for further prosecution of an application after office action thereon.

The question presented for decision is, whether this conclusion is justifiable and sound, and the answer must be found in the statutes and rules of the Patent Office made pursuant to statute, prescribing the action necessary to be taken in order to obtain a patent,—for the whole subject is one of statutory origin and regulation.

The statute which is fundamental to all others in our patent law (Rev. Stat., 4886, as amended March 3, 1897; 29 Rev. Stat., 692, ch. 391) provides with respect to the effect of a United States patent upon the filing of a subsequent application for a patent on the same discovery, which is all we are concerned with here, that any discoverer of a patentable invention, not known or used by others in this country, before his invention or discovery, may file an application for a patent upon it, at any time within two years after it may have been patented in this country. Such a prior patent is in no sense a bar to the granting of a second patent for the same invention to an earlier inventor, provided that his application is filed not more than two years after the date of the conflicting patent. The applicant may not be able to prove that he was the first inventor but the statute gives him two years in which to claim that he was and in which to secure the institution of an interference proceeding in which the issue of priority between himself and the patentee may be determined in a prescribed manner.

This section, unless it has been modified, by other statutes or, in effect, by decisions of the courts, is plainly not reconcilable with the decision of the court of appeals, and should rule it. Has it been so modified?

The section of the Revised Statutes dealing with inventions previously patented in a foreign country (Rev. Stat., 4887, as amended March 3, 1903; 32 Rev. Stat., 1225) provides that no patent shall be granted on an application for a patent if the invention has been patented in this or any foreign country *more than two years* before the date of the actual filing of the application in this country.

Section 4897 of the Revised Statutes, (16 Rev. Stat., 202, ch. 230. sec. 35,) in dealing with the renewal of an application in case of failure to pay the final fee within six months of notice that a patent has been allowed, provides that another application may be made for the

invention "the same as in the case of an original discovery." But such application must be made *within two years* after the allowance of the original application.

And in Revised Statute 4920, providing for pleadings and proofs in infringement suits, it is provided that when properly pleaded and noticed the defendant may prove in defense that the patent declared on had been patented prior to the plaintiff's supposed invention "or *more than two years* prior to his application for a patent therefor," and also that the subject-matter of the patent "had been in public use or on sale in this country for *more than two years*" before the plaintiff's application for a patent.

Thus through all of these statutes runs the time limit of two years for the filing of an application; there is no modification in any of them of the like provision in Revised Statute 4886, as amended, and no distinction is made between an original and a later or a divisional application, with respect to this filing right.

A brief reference to the decisions will show that until the *Rown-tree case*, the courts had left the filing right under Revised Statute 4886 as untouched as the statutes thus had left it.

There is no suggestion in the record that the original application of the Chapmans was not prosecuted strictly as required by the statutes and the rules of the Patent Office and therefore, it is settled, their rights may not be denied or diminished on the ground that such delay may have been prejudicial to either public or private interests.

A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they were unwise or prejudicial to the interests of the public. (*United States v. American Bell Telephone Co. et al.*, C. D., 1897, 442; 79 O. G., 1862; 167 U. S., 224.)

In reissue cases, where there was no statutory time prescribed for the making of an application for the correction of a patent, and although unusual diligence is required in such cases, this court adopted the two-year rule as reasonable by analogy to the law of public use before an application for a patent. (*Mahn v. Harwood*, C. D., 1885, 144; 151; 30 O. G., 657, 660; 112 U. S., 354; *Wollensak v. Reiher*, C. D., 1885, 314; 31 O. G., 1303; 115 U. S., 96.)

To this we must add that not only have later or divisional applications not been dealt with in a hostile spirit by the courts, but, on the contrary, designed as they are to secure the patent to the first discoverer, they have been favored to the extent that where an invention clearly disclosed in an application, as in this case, is not claimed

therein but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date of the earlier, with all of its priority of right. (*Smith & Griggs Manufacturing Co. v. Sprague*, C. D., 1887, 616; 41 O. G., 1037; 123 U. S., 249; *Von Recklinghausen v. Dempster*, C. D., 1910, 365; 154 O. G., 252; 34 App. D. C., 474.)

These, a few from many, suffice to show that prior to the *Rowntree case*, the decisions did not tend to modification of the statutory two-year rule.

The court of appeals recognizes all this law as applicable to an original application, but it finds warrant for cutting the time limit to one year in the case of later applications in three reasons, viz: because it is inequitable to allow so long a time as two years for filing a new application, claiming a discovery for which a patent has issued; because such a time allowance is contrary to public policy, as unduly extending the patent monopoly if the new application should prevail, and, finally and chiefly, as we have pointed out, because, regarding such a later application as substantially as amendment to the original application the court discovers, in analogy to the time allowed by statute for amendment to applications, (Rev. Stat., 4894,) a reason for holding that the failure for more than one year to make a later, in this case a divisional, application, amounts to fatal laches.

However meritorious the first two of these grounds may seem to be they cannot prevail against the provisions of the statutes, (*United States v. American Bell Telephone Co.*, *supra*,) and the third does not seem to us persuasive because of the difference in the kind of notice which is given to the applicant under Revised Statutes 4894 and that given him when a patent is issued conflicting with his application.

The one-year provision of Revised Statute 4894, as amended March 3, 1897, (29 Rev. Stat., 693,) is that an applicant for a patent, who shall fail to prosecute his application within one year after Patent Office action thereon, "of which notice shall have been given" him, shall be regarded as having abandoned his application, unless the Commissioner of Patents shall be satisfied that such delay was unavoidable. But when a conflict between inventions disclosed in applications escapes the attention of the Patent Office examiners (Rev. Stat., 4904) and a patent is issued, with claims conflicting with the disclosures of a pending application, the applicant receives only such notice of the conflict as he is presumed to derive from the publication of the patent. In the one case the notice is actual and specific, in the other it is indefinite and constructive only. When the great number of patents constantly being issued is considered, many of them of a voluminous and complicated character, such as we have

in this case, with many and variously-worded claims, such an implied notice must necessarily be precarious and indefinite to a degree which may well have been thought to be a sufficient justification for allowing the longer two-year period to inventors who must, at their peril, derive from such notice their knowledge of any conflict with their applications.

As has been pointed out, the Examiner of Interferences did not permit the introduction of any evidence with respect to laches or abandonment and the court of appeals rests its judgment, as he did, wholly upon the delay of the Chapmans in filing their divisional application for more than one year after the Wintroath patent was issued, as this appeared "on the face of the record." While not intending to intimate that there may not be abandonment which might bar an application within the two-year period allowed for filing, yet upon this discussion of the statutes and decisions, we cannot doubt that upon the case disclosed in this record, the Chapmans were within their legal rights in filing their divisional application at any time within two years after the publication of the Wintroath patent.

The judgment of the court of appeals must be reversed.

Mr. Justice McREYNOLDS *dissents*.

[Supreme Court of the United States.]

BECKWITH v. COMMISSIONER OF PATENTS.

Decided April 19, 1920.

274 O. G., 618; 252 U. S., 538.

1. TRADE-MARKS—ACT OF 1905, SECTION 5 CONSTRUED—MARKS MERELY DESCRIPTIVE.

In the Trade-Mark Act of 1905, (33 Stat., 724,) the proviso of section 5 that "no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods * * * shall be registered" is simply an expression in statutory form of the prior general rule of law that words merely descriptive are not a proper subject for exclusive trade-mark appropriation.

2. SAME—SAME.

The requirement of the act of 1905, section 5, that "no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless, etc." is just as imperative as the prohibition of the proviso against registration in cases specified.

3. SAME—REGISTRATION—LIBERAL ATTITUDE SHOULD BE ADOPTED.

"Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute.

and this should not be done if it can be avoided by fair, even liberal, construction of the act, designed as it is to promote the domestic and foreign trade of our country."

4. SAME—COMPOSITE MARKS CONTAINING DESCRIPTIVE TERMS—REGISTRATION NOT PROHIBITED.

A composite mark including arbitrary matter and a descriptive term forming a definitely-positioned part of the mark does not fall within the terms of the statute, since such a mark does not consist merely ("only") of descriptive words.

5. SAME—SAME—REQUIREMENT TO DELETE DESCRIPTIVE WORDS IMPROPER.

The requirement that descriptive words constituting part of a composite mark be deleted as a prerequisite to registration *Held* improper, since such deletion would often result in so changing the mark sought to be registered from the form in which it had been used in actual trade that it would not be recognized as the same mark.

6. SAME—SAME—PRACTICE OF ALLOWING DISCLAIMERS APPROVED.

"While there is no specific provision for disclaimers in the trade-mark statute, the practice of using them is commended to our judgment by the statement of the Commissioner of Patents that, so far as known, no harm came to the public from the practice of distinguishing, without deleting, non-registrable matter in the drawing of the mark as registered, when a statement, forming a part of the record, was required that the applicant was not making claim to an exclusive appropriation of such matter except in the precise relation and association in which it appeared in the drawing and description."

7. SAME—"MOISTAIR HEATING SYSTEM"—DESCRIPTIVE.

The words "Moistair Heating System" applied to "hot air and combined hot air and hot water heaters and furnaces" are merely descriptive of a claimed property or quality of applicant's heating system, that by it moisture is imparted to the air in the process of heating.

8. SAME—SAME—COMPOSITE MARK—REGISTRATION.

A trade-mark for heating systems consisting of certain arbitrary matter and the descriptive words "Moistair Heating System" *Held* registrable if an appropriate disclaimer of the descriptive words be made by the applicant.

ON WRIT of certiorari to the Court of Appeals of the District of Columbia.

Mr. Harry C. Howard for the petitioner.

Assistant Attorney-General Davis and *Mr. Edward G. Curtis* for the Commissioner of Patents.

Mr. Justice CLARKE delivered the opinion of the Court.

The petitioner, a corporation, filed an application in the Patent Officer for the registration of a trade-mark, which is described as follows:

A design like a seal, comprising the head of an Indian chief surmounting a scroll bearing his name, "Doe-Wah-Jack" and surrounded by a circle, outside of which appeared the words "Round Oak" and "Moistair Heating System" in a circle, and the whole being surrounded by a wreath of oak leaves.

It will be useful to reproduce the drawing filed with this application:



It was averred that the petitioner had used the mark for more than eighteen months before the application was made by applying it to—hot air and combined hot air and hot water heaters and furnaces by having the same cast into the metals of which the systems were constructed.

The Commissioner found that the mark did not conflict with any other that was registered, and that the petitioner was entitled to the exclusive use of it excepting the words "Moistair Heating System." It was ordered that the mark might be registered if the excepted words, objectionable because descriptive, were "erased" or "removed" from it, but that the filing of a disclaimer would not suffice to secure registration.

Not satisfied with this result, the petitioner appealed to the Court of Appeals of the District of Columbia, and its judgment affirming the decision of the Commissioner of Patents is before us for review.

The ground of both decisions is that the words "Moistair Heating System" are merely descriptive of a claimed merit of the petitioner's system—that in the process of heating, moisture is added to the air—and that one person may not lawfully monopolize the use of words in general use which might be used with equal truthfulness to describe another system of heating. For this reason it was held that the case falls within the proviso of the registration act of 1905, declaring that no mark consisting merely in words or devices which are descriptive of the goods with which they are used or of the character or quality of such goods shall be registered under the terms of the act. (Act of Feb. 20, 1905, sec. 5, 33 Stat., 725; amended Jan. 8, 1913, 37 Stat., 649.)

No question of patent right or of unfair competition, or that the design of the trade-mark is so simple as to be a mere device or contrivance to evade the law and secure the registration of non-registrable words, is involved. (*Nairn Linoleum Co. v. Ringwalt Linoleum Works*, C. D., 1917, 135; 237 O. G., 919; 46 App. D. C., 64.)

This statement makes it apparent that the question presented for decision is: Whether the applicant may lawfully register the words

"Moistair Heating System" when combined with the words "Round Oak," as a part of its purely fanciful and arbitrary trade-mark design, as shown in the drawing filed, and when claim to exclusive use of the words apart from the mark shown in the drawing is disclaimed on the record?

An account of the process of decision, in the Patent Office and in the court of appeals, by which the result in this case was arrived at, as it appears in the brief of the Commissioner of Patents is suggestive and useful. From this we learn that when a mark has been presented for registration consisting merely (only) of descriptive words or devices, registration has been uniformly refused. When "composite" marks—such as contain both registrable and non-registrable matter—have been presented for registry with features in them which conflicted with earlier marks, registered by other than the applicant, the complete rejection, "eradication," of the conflicting portions has been uniformly required before registry was allowed. But where there was no such conflict, and the only objection was that descriptive words were used, the practice of the Patent Office prior to the decision, in 1909, of *Johnson v. Brandau* (C. D., 1909, 298; 139 O. G., 732; 32 App. D. C., 348) was to permit the registration of marks containing such words, where they were associated with registrable words or were a part of an arbitrary or fanciful design or device, it being considered not necessary to delete the descriptive matter, even when it was an essential part of the composite trade-mark as it had been used by the applicant, provided it was clearly not susceptible of exclusive appropriation under the general rules of law. After the decision of *Johnson v. Brandau* (C. D., 1909, 298; 139 O. G., 732; 32 App. D. C., 348) a practice grew up in the Patent Office, not provided for in the statute, of allowing an applicant to disclaim objectionable descriptive words in cases where to require their actual removal would result in so changing the mark that it would not readily be recognized as that shown in the drawing or specimen filed with the application. The customary form of such disclaimer was a statement filed that no claim was made to the designated words, as for example, "Moistair Heating System," apart from the mark shown in the drawing—this was interpreted as meaning that only when taken in connection with the remaining features of the mark did the applicant make claim to their exclusive use. (*Ex parte The Illinois Seed Co.*, C. D., 1915, 17; 219 O. G., 931.)

Such disclaimer became a part of the applicant's statement in the record and necessarily formed a part of the certificate of registration as it would appear in the copies of it furnished to the applicant and the public, pursuant to section 11 of the act.

Then came the decisions in *Fischbeck Soap Co. v. Kleeno Manufacturing Co.* (C. D., 1915, 158; 216 O. G., 663; 44 App. D. C., 6, and *Nairn Linoleum Co. v. Ringwalt Linoleum Works*, C. D., 1917, 135; 237 O. G., 919; 46 App. D. C., 64) which, says the Commissioner of Patents, were understood as disapproving the practice of disclaimer, and since they were rendered, registration of merely descriptive matter has not been allowed in any form, but its actual deletion from the trade-mark drawing has been required,—with, however, an apparent exception in the case of *Rinsburger*, (8 T. M. Reps., 567; 128 MS. Dec., 141.) The judgment we are considering requiring, as it does, the “elimination” of the descriptive words, shows that the Commissioner correctly interpreted these two decisions of the court of appeals.

It is apparent from this rehearsal that the Commissioner of Patents has promptly and cordially accepted for his guidance the decisions of the court of appeals and, although he avoids a controversial attitude in his brief and gives a colorless history of the practice of his Office, still it is manifest that, in this case and in others, the court has very radically changed that practice with respect to permitting registry of composite trade-marks and that its decisions have turned upon the construction of the second proviso, referred to, in the fifth section of the registration act, which is made the basis of the judgment we are reviewing.

The registration act of 1905, (33 Stat., 724,) amended in 1906 (34 Stat., 168) and in 1909 (35 Stat., 627) and in 1913 (37 Stat., 649,) without changing the substantive law of trade-marks, provided, in the manner prescribed, for the registration of marks, (subject to special exceptions) which, without the statute, would be entitled to legal and equitable protection, and the case before us calls chiefly for the construction of the provisions of section 5 of that act, which, so far as here involved are as follows:

*No mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless, etc. * * **

*Provided, that no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods * * * shall be registered under the terms of this act.*

It was settled long prior to the Trade-Mark Registration Act that the law would not secure to any person the exclusive use of a trade-mark consisting merely of words descriptive of the qualities, ingredients or characteristics of an article of trade. This for the reason that the function of a trade-mark is to point distinctively, either by its own meaning or by association, to the origin or ownership of the wares to which it is applied, and words merely descriptive of

qualities, ingredients or characteristics, when used alone, do not do this. Other like goods, equal to them in all respects, may be manufactured or dealt in by others, who, with equal truth, may use, and must be left free to use, the same language of description in placing their goods before the public. (*Canal Company v. Clark*, 1 O. G., 279; 13 Wall., 311; *Manufacturing Company v. Trainer*, C. D., 1880, 464; 17 O. G., 1217; 101 U. S., 51; *Manhattan Medicine Co. v. Wood*, C. D., 1883, 268; 23 O. G., 1925; 108 U. S., 218; *Goodyear's India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, C. D., 1889, 257; 46 O. G., 122; 128 U. S., 598; *Lawrence Manufacturing Co. v. Tennessee Manufacturing Co.*, C. D., 1891, 415; 55 O. G., 1528; 138 U. S., 537; *Brown Chemical Co. v. Myer*, C. D., 1891, 346; 55 O. G., 287; 139 U. S., 540; *Elgin National Watch Co. v. Illinois Watch Case Co.*, C. D., 1901, 273; 94 O. G., 755; 179 U. S., 665; *Standard Paint Co. v. Trinidad Asphalt Mfg. Co.*, C. D., 1911, 530; 165 O. G., 971; 220 U. S., 446.)

Thus the proviso quoted, being simply an expression in statutory form of the prior general rule of law that words merely descriptive are not a proper subject for exclusive trade-mark appropriation, if the application in this case had been to register only the words "Moistair Heating System" plainly it would have fallen within the terms of the prohibition, for they are merely descriptive of a claimed property or quality of the petitioner's heating system,—that by it moisture is imparted to the air in the process of heating. But the application was not to register these descriptive words "merely," alone and apart from the mark shown is the drawing, but in a described manner of association with other words, "Round Oak," which are not descriptive of any quality of applicant's heating system, and as a definitely positioned part of an entirely fanciful and arbitrary design or seal, to which the Commissioner found the applicant had the exclusive right.

Since the proviso prohibits the registration not of merely descriptive words but of a "trade-mark which consists * * * merely" (only) of such words—the distinction is substantial and plain—we think it sufficiently clear that such a composite mark as we have here does not fall within its terms. In this connection it must be noted that the requirement of the statute that no trade-mark shall be refused registration, except in designated cases, is just as imperative as the prohibition of the proviso against registration in cases specified.

While there is no specific provision for disclaimers in the trade-mark statute, the practice of using them is commended to our judgment by the statement of the Commissioner of Patents that, so far as known, no harm came to the public from the practice of distinguishing, without deleting, non-registrable matter in the drawing of the mark as registered, when a statement, forming a part of the record.

was required that the applicant was not making claim to an exclusive appropriation of such matter except in the precise relation and association in which it appeared in the drawing and description.

It seems obvious that no one could be deceived as to the scope of such a mark, and that the registrant would be precluded by his disclaimer from setting up in the future any exclusive right to the disclaimed part of it. It seems obvious also that to require the deletion of descriptive words must result often in so changing the trade-mark sought to be registered from the form in which it had been used in actual trade that it would not be recognized as the same mark as that shown in the drawing, which the statute requires to be filed with the application, or in the specimens produced as actually used, and therefore registration would lose much, if not all, of its value. The required omission might so change the mark that in an infringement suit it could be successfully urged that the registered mark had not been used,—and user is the foundation of registry (sec. 2). Of this last the case before us furnishes an excellent example. To strike out “Moistair Heating System” from the applicant’s trade-mark would so change its appearance that its value must be largely lost as designating to prior purchasers or users the origin of the heating system to which it was applied.

The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety (*Johnson v. Brandau, supra*) and to strike out any considerable part of it, certainly any conspicuous part of it, would be to greatly affect its value. Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, and this should not be done if it can be avoided by fair, even liberal, construction of the act, designed as it is to promote the domestic and foreign trade of our country.

Thus the case comes to this: that the Commissioner found that the trade-mark presented for registration did not conflict with any theretofore registered and there is no suggestion of unfair practice in the past or contemplated in the future; that it had been used for eighteen months in the form proposed for registry; that the words ordered to be stricken out from the drawing are descriptive but the mark does not consist “merely” in such words, but is a composite of them with others, and with an arbitrary design which, without these words, both the Commissioner and the court found to be registrable; that the language of the statute that no mark not within its prohibitions or provisos shall be denied registration is just as imperative as the prohibitory words of the proviso; and, very certainly, that a disclaimer on the part of applicant that no claim is made to the use of the words “Moistair Heating System”

apart from the mark as shown in the drawing and as described, would preserve to all others the right to use these words in the future to truthfully describe a like property or result of another system, provided only that they be not used in a trade-mark which so nearly resembles that of the petitioner—

as to be likely to cause confusion in the mind of the public or to deceive purchasers—

when applied—

to merchandise of the same descriptive properties (sec. 5).

Such being the ultimate facts of this controversy, we cannot doubt that the court of appeals fell into error in ruling that the words "Moistair Heating System" must be "eliminated" from the trade-mark of the applicant as it had been theretofore used, and that the requirement of the act of Congress for the registration of trade-marks would be fully complied with if registration of it were permitted with an appropriate declaration on the part of the applicant that no claim is made to the right to the exclusive use of the descriptive words except in the setting and relation in which they appear in the drawing, description and samples of the trade-mark filed with the application.

It results that the judgment of the court of appeals must be reversed.

Mr. Justice McREYNOLDS *dissents.*

[Supreme Court of the United States.]

MECCANO LIMITED v. JOHN WANAMAKER, NEW YORK.

Decided May 17, 1920.

275 O. G., 203; 253 U. S., 136.

1. APPEAL AND ERROR—POWER OF SUPREME COURT TO REVIEW DECREES MADE FINAL IN CIRCUIT COURTS OF APPEALS.

Decrees which are declared final under section 128 of the Judicial Code may be taken up on certiorari by the Supreme Court and treated as if on appeal. (Sec. 240, Judicial Code.)

2. SAME—APPEAL TO CIRCUIT COURTS OF APPEALS FROM PRELIMINARY ORDER—POWER TO TERMINATE LITIGATION.

"The power of circuit courts of appeals to review preliminary orders granting injunctions arises from section 129, Judicial Code. * * * This power is not limited to mere consideration of, and action upon, the order appealed from; but, if insuperable objection to maintaining the bill clearly appears, it may be dismissed and the litigation terminated."

3. SAME—APPEAL FROM ORDER GRANTING OR REFUSING INJUNCTION—SCOPE OF REVIEW.

Whether a preliminary injunction shall be awarded rests in the sound discretion of the trial court. Upon appeal an order granting or denying such an injunction will not be disturbed unless contrary to some rule of equity, or the result of improvident exercise of judicial discretion.

4. SAME—REVIEW ON CERTIORARI BY SUPREME COURT OF INTERLOCUTORY DECREE.

Upon certiorari by the Supreme Court to a circuit court of appeals bringing up for consideration a decree upon an appeal from an interlocutory order the judgment of the appellate court, exercised upon a view of all relevant circumstances, is entitled to great weight and, except for strong reasons, will not be interfered with.

5. SAME—APPEAL FROM INTERLOCUTORY ORDER—MOTION FOR FINAL DECISION ON MERITS.

Where plaintiff obtained a decree from a district court of Ohio affirming the validity and restraining infringement of its patent for mechanical toys, also restraining unfair competition in making and selling such toys, and infringement of copyright on its trade catalogue, and, pending appeal by defendant, brought suit against defendant's customer in New York for like infringement, wherein an interlocutory decree was given in plaintiff's favor based upon affidavits, from which defendant in that suit appealed to the Circuit Court of Appeals of the Second Circuit, pending which the Circuit Court of Appeals of the Sixth Circuit reversed the final decree as to infringement of the patent, but otherwise affirmed the decree, whereupon plaintiff withdrew the patent from the New York suit, upon denial of a motion brought after argument but before determination of the appeal from the preliminary order for final decision on the merits on the ground that the decree in the sixth circuit was final and conclusive, *Held* that the denial of the motion was proper, as the defendant was entitled to his day in court with opportunity to set up and establish his defenses.

6. SAME—CONFLICT OF DECISIONS—CERTIORARI BRINGING UP PRELIMINARY ORDER FOR REVIEW—MERITS NOT CONSIDERED.

Where the Circuit Court of Appeals of the Sixth Circuit held a patent for toys invalid, but granted an injunction against unfair competition in the sale of such toys and infringement of copyright on a trade catalogue, and the Circuit Court of Appeals of the Second Circuit, on appeal from an interlocutory order in another suit brought by the same plaintiff against a customer of defendant for like infringements, denied all relief and refused plaintiff's motion for a final decision on the merits, upon certiorari to the Supreme Court from the latter decision, *Held* that the Supreme Court would not declare which of the conflicting views of the two circuit courts of appeals was right or undertake to decide the several issues involved upon their merits, the matter for review being only the action of the courts below upon the preliminary order.

Mr. Reeve Lewis, Mr. C. A. L. Massie, and Mr. W. B. Kerkam and Mr. Ralph L. Scott for the petitioner.

Messrs. Toulmin & Toulmin for the respondent.

Mr. Justice McREYNOLDS delivered the opinion of the Court.

Proceeding against Wagner and others in the United States District Court, Southern District of Ohio, Meccano, Limited, obtained a decree (July 8, 1916) affirming the validity, and restraining infringement, of its patent for mechanical toys, also restraining unfair competition in making and selling such toys and the further infringement of its copyright upon trade catalogue and illustrated manual relating thereto. (234 Fed. Rep., 912.) An appeal was

taken to the Circuit Court of Appeals, Sixth Circuit. The same corporation instituted the present suit in the United States District Court, Southern District of New York (December 9, 1916) seeking like relief against John Wanamaker, a customer of Wagner.

The trial court granted a preliminary injunction, asked upon the bill, supporting affidavits and exhibits—January 12, 1917. It expressed general agreement with the conclusions announced in the Ohio cause and said:

It seems quite apparent that the patent is infringed and that diagrams and directions as to construction have been borrowed by defendant from complainant's copyrighted catalogues, and that the system of construction adopted by the defendant is a direct imitation of complainant's system.

An appeal followed; pending which the Circuit Court of Appeals, Sixth Circuit (November, 1917) reversed the Ohio district court's decree so far as it sustained the patent, approved it otherwise, and remanded the cause for further proceedings. (C. D., 1918, 231; 248 O. G., 233; 246 Fed. Rep., 603.)

January 26, 1918, after argument but before determination of appeal from the preliminary order, petitioner moved for final decision on the merits, claiming that the decree of the Circuit Court of Appeals, Sixth Circuit—

is final and conclusive as to the case at bar, under principles enunciated by the Supreme Court.

Being opposed, the motion was denied—March 24, 1918. The court said of it:

This was a motion for a decision on the merits of this cause by this court under the following circumstances. A suit was brought in the District Court for the Southern District of New York for an injunction for infringement of a copyright, and of a patent, and for unfair competition in the manufacture of a mechanical toy in absolute imitation of the plaintiffs. The plaintiff applied for and got an injunction *pendente lite*, from which the defendant appealed. That appeal is still pending undetermined in this court. Meanwhile the plaintiff had in the district court required the defendant to answer certain interrogatories by which it appeared that the defendant procured from one Wagner, the toys which it sold in alleged unfair competition and in violation of the patent, and also the "manuals" which went with the toys and explained their uses, which are alleged to infringe the copyright. The interrogatories further showed that Wagner had agreed to hold the defendant harmless for any sales of the toys and manuals, and that in pursuance of that undertaking he had taken a share in the defense of this suit. While it did not appear exactly what that share was, it may be assumed for the purposes of the motion only, that Wagner has assumed the chief conduct of the case and that the defendant remains only formally represented.

The plaintiff sued Wagner in Ohio upon the three same causes of equity and obtained a decree upon all. Later an appeal was taken to the Circuit Court of Appeals for the Sixth Circuit and the decree was affirmed except as to the patent, which was declared invalid and which the plaintiff has now

withdrawn from this suit. No final decree has been entered and the Ohio cause now stands for an accounting in the district court. This motion is upon the record in the Ohio suit which is made a part of the moving papers and it presupposes that this court may pass a final decree for the plaintiff upon the appeal from the injunction *pendente lite* upon the assumption that that record is a complete estoppel against the defendant here and leaves open no issues for determination between the parties.

We pass the question of practice whether this court under the doctrine of *Mast, Foos & Co. v. Stover* (C. D. 1900, 285; 91 O. G., 1239; 177 U. S. 488,) may enter a decree for the plaintiff upon such an appeal as that now pending. *Mast, Foos & Co. v. Stover, supra*, was a case where the bill was dismissed and no case has so far held that the plaintiff could obtain an affirmative decree. As we think the motion must be denied upon the merits, we leave open the question whether the plaintiff may in any event so terminate the litigation. * * * It is apparent that some of the issues are different from those litigated in Ohio; they involve not only the defendant's rights to sell Wagner's toys and manuals, but any others which it may procure elsewhere. * * * At best the rule in *Mast, Foos & Co. v. Stover, supra*, is limited to those cases in which the court can see that the whole issues can be disposed of at once without injustice to the parties. Whatever may be the result here, it is apparent that the case involves more than can be so decided.

April 15, 1918, the court below reversed the challenged preliminary order. After stating that the trial court very naturally followed the Ohio district court, it referred to the partial reversal of the decree there announced and expressed entire agreement with the Circuit Court of Appeals, Sixth Circuit, in holding the patent invalid. And, having considered the evidence relating to copywright and unfair competition, it found no adequate ground for an injunction. (250 Fed. Rep., 450.) The cause comes here by certiorari. (See *ex parte Wagner*, C. D., 1919, 481; 267 O. G., 186; 249 U. S. 465.)

Decrees by circuit courts of appeals are declared final by section 128, Judicial Code, in cases like the present one. We, therefore, had authority to bring this cause up by certiorari and may treat it as if here on appeal. (Sec. 240, Judicial Code; *Harriman v. Northern Securities Co.*, 197 U. S., 244; *Denver v. New York Trust Company*, 229 U. S., 123.) The power of circuit courts of appeals to review preliminary orders granting injunctions arises from section 129, Judicial Code, which has been often considered. (*Smith v. Vulcan Iron Works*, 165 U. S., 518; *Mast, Foos & Co. v. Stover Manufacturing Co.*, C. D., 1900, 285; 91 O. G., 1239; 177 U. S., 485; *Harriman v. Northern Securities Co.*, *supra*; *United States Fidelity & Guaranty Co. v. Bray*, 225 U. S., 205; *Denver v. New York Trust Company, supra*.) This power is not limited to mere consideration of, and action upon, the order appealed from; but, if insuperable objection to maintaining the bill clearly appears, it may be dismissed and the litigation terminated.

The correct general doctrine is that whether a preliminary injunction shall be awarded rests in sound discretion of the trial court. Upon appeal, an order granting or denying such an injunction will not be disturbed unless contrary to some rule of equity, or the result of improvident exercise of judicial discretion. (*Rahley v. Columbia Phonograph Company*, 122 Fed. Rep., 823; *Texas Traction Company v. Barron G. Collier, Inc.*, 195 Fed. Rep., 65; *Southern Express Company v. Long et al.*, 202 Fed. Rep., 462; *City of Amarillo et al. v. Southwestern Telegraph & Telephone Co.*, 253 Fed. Rep., 638.) The informed judgment of the circuit court of appeals exercised upon a view of all relevant circumstances is entitled to great weight. And, except for strong reasons, this Court will not interfere with its action. No such reasons are presented by the present record.

Pending the New York appeal the situation underwent a radical change—the Circuit Court of Appeals, Sixth Circuit, reversed the decree upholding petitioner's patent. Evidently the trial court had granted the preliminary injunction in entire reliance upon that decree and after its reversal the court below properly took notice of and considered the changed circumstances. (*Gulf, Colorado & Santa Fe Ry. v. Dennis*, 224 U. S., 503.)

Petitioner maintains that its motion for final decree upon the merits should have been sustained. But the appeal was from an interlocutory order and the court could only exercise powers given by statute. On such an appeal a cause may be dismissed if it clearly appears that no ground exists for equitable relief; but finally to decide a defendant's rights upon the mere statement of his adversary, although apparently supported by *ex parte* affidavits and decrees of other courts, is not within the purview of the act. He is entitled to a day in court with opportunity to set up and establish his defenses. The motion for final judgment was properly overruled. (*Eagle Glass & Manufacturing Co. v. Rowe et al.*, 245 U. S., 275.)

Petitioner's motion to enter a disclaimer must be denied.

If the two circuit courts of appeals have expressed conflicting views we cannot now declare which is right or undertake finally to decide the several issues involved upon their merits. The matter for review here is the action of the courts below upon the preliminary order for injunction and we may go no further. (*Leeds and Catlin Co. v. Victor Talking Machine Co.*, C. D., 1909, 536; 144 O. G., 1089; 213 U. S., 301; *Lutcher & Moore Lumber Co. v. Knight*, 217 U. S., 257.)

The judgment of the circuit court of appeals is affirmed. The cause will be remanded to the district court for further proceedings in conformity with this opinion.

[Supreme Court of the United States.]

BEIDLER v. THE UNITED STATES.

Decided June 7, 1920.

275 O. G., 1026; 253 U. S., 447.

1. PATENTS—VALIDITY—SUFFICIENCY OF DISCLOSURE.

A correct and adequate description or disclosure of a claimed discovery (which in the case of a machine involves particularly the operation of it) is essential to the validity of a patent for the reason that such a disclosure is necessary in order to give the public the benefit of the invention after the patent shall expire.

2. SAME—SAME—APPARATUS INOPERATIVE WITHOUT MATERIAL CHANGES FROM CONSTRUCTION DESCRIBED.

Letters Patent No. 1,057,397, to Beldler, for an improvement in photographing and developing apparatus, *Held* void for lack of sufficient disclosure, since for successful operation it would require a manipulation which could not be performed with the construction disclosed without material changes thereof and which did not accord with the mode of operation set forth in the description.

APPEAL from the Court of Claims.

Mr. Charles J. Williamson (*Mr. Frank S. Appleman* on the brief), for the appellant.

Mr. Daniel L. Morris, Special Assistant to the Attorney General, *Mr. Assistant Attorney General Davis*, and (*Mr. Edward G. Curtis*) on the brief, for the United States.

Mr. Justice CLARKE delivered the opinion of the Court.

This is a suit to recover damages for the infringement of five of the forty-one claims of Letters Patent No. 1,057,397 applied for March 23, 1907, and granted on March 25, 1913.

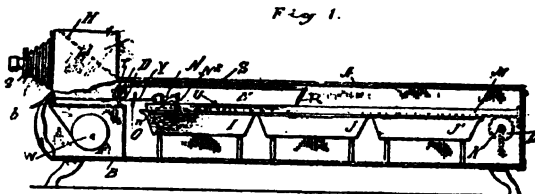
The specification describes the claimed invention as an improvement in photographing and developing apparatus, and as designed primarily for reproducing writings, drawings, pictures or the like—novel means being also provided to convey the sensitized film through a series of receptacles containing suitable developing and fixing fluids or through suitable baths, according to requirements.

The patent is for a machine made up of a combination of elements all of which were old, to produce a result which was old but by a method of coördination and operation which it is claimed is new and useful. The invention is declared in the specification to consist in—

the details of construction and in the arrangement and combination of the parts, as “set forth and claimed” by the inventor.

Figure 1 of the drawings, forming a part of the specification, will aid in explaining the construction and function of the invention as

claimed and in determining the character and extent of the disclosures of the patent.



The described mode of operation is substantially as follows:

W is a roll of sensitized paper or film placed immediately below the exposure-chamber F of a camera, with its sensitized surface uppermost to receive the desired image, reflected from the mirror H. This film is fed into the chamber between the rolls *b*, and thence along the floor thereof to the rollers D where it emerges from the camera and is seized by "clips" or clamps N. These clamps are supported and carried by a rack M, and may be moved to and fro (reciprocated) by turning the pinions L on the shaft K, by means of a crank.

I, J and J' are shallow pans or "tanks" in which suitable "developing," "fixing," and "washing" solutions or fluids are placed and the whole of the construction to the right of the camera, as we face the print, is inclosed in a light-proof case E, referred to in the patent sometimes as a "compartment" and sometimes as a "chamber." The rack M, and the clamps which hold and support the film, move above the tanks and necessarily above the level of the liquid within them. By turning the pinion L, the rack M is moved outwardly away from the camera, and the clamps draw the film after them until the required length is attained, when it is severed from the roll by a manually-operated cutter O. When the film is thus cut to the desired length, obviously only the free end will fall to the surface of the solution in the tank I, and by continuing the outward movement of the rack M, the specification declares, "the film is carried through the several tanks." The "clips" or clamps are set and released automatically and at the limit of the outward movement the film is released and falls into the tank J'. By reversing the turning of the pinions L the rack and clamps are returned inwardly to the camera, so that the operation, just detailed, may be repeated.

The Court of Claims carries into its findings of fact fourteen patents as illustrative of the prior art, and with this exhibit before us we fully agree with that court that the claim of invention of appellant must be restricted to the disclosed construction and operation of the mechanism for carrying the exposed section of film "through the developing and other solutions or liquids" after it leaves the camera.

In the description of the operation of the machine as we have just given it, there is no provision other than gravity for causing the free

end of the film, when it is cut from the roll, to sink into the developing fluid, and the other end of it is held between the clamps, above the surface of the fluid, as it is drawn along from one tank to another. The Court of Claims found that under such conditions of operation all of the film would not be submerged with sufficient rapidity and uniformity to secure a proper and useful development of the image and this conclusion is not seriously disputed. But the applicant contends that the required submergence may be obtained by oscillating the rack and clamps (and thereby the film) back and forth within the range of a few inches when the film is over the first tank I, with the result that the free end of the film, first sinking into the fluid, is turned under and over and the exposed side of it wholly submerged and thereby developed.

In reply to this it is contended by the Government that the disclosures of the patent do not contain any suggestion of a short, reciprocating movement of the rack, such as is thus relied upon, and that the drawings provide for a construction of the machine which would be inoperative if such movement were resorted to.

Upon this subject the finding of the Court of Claims is, that the machine can be rendered operative only—

by resorting to a new oscillating mode of operation evolved by the claimant for submerging and developing the film.

and that such mode of operation is not disclosed in the patent. On the contrary, it is especially found that—

by the method contemplated and disclosed in the patent, the film with the exposed side up, held at one end by the clamps attached to the rack M and moving in a plane above the pans containing the developing and fixing fluids, is intended, by the outward movement of the rack, to be drawn successively through the developing and fixing fluids, the rack moving in one direction only through its entire course, the end of the film next the knife and away from the clamps falling, when severed by the knife, on the surface of the developer in the first pan and submerging by gravity.

Treating this finding by the court as an interpretation of the patent and therefore as a conclusion of law and subject to review, we are brought to the question whether the short, reciprocating movement of the rack, confessedly necessary to successful operation of the machine, is disclosed in the patent, as it must be to render it valid. (Rev. Stats., 4888.)

The only description of the mode of operation of appellant's machine, and the statute requires that this must be the best mode known to the patentee (Rev. Stats., 4888) is found in the specification and is as follows:

In order to draw the film through the several compartments, I provide a mechanism consisting of a shaft K, having toothed wheels L, which mesh with a rack M, the said rack being suitably guided in the compartment E, and being

alternately reciprocated through the rotation of the shaft K, in opposite directions. When the shaft is turned to the right, the said rack will be projected from the compartment until the inner end thereof is nearly above the shaft K. When the shaft is rotated in the opposite direction, the said rack will, of course, be retracted and thrust into the compartment. It is the purpose of this invention that the said rack shall carry clips N, which are designed to clamp on the edges of the film Y and as the said rack is moved outwardly, the film is carried through the several tanks as indicated. The clips are automatically released and set through the contact with trips within the casing in the path of travel of said clips.

We agree with the Court of Claims that this language describes a movement of the rack M, carrying the clamps N, in one direction only—outwardly and progressively away from the camera—until the movement is completed and the film is released, and that the reciprocating movement referred to in the patent is the return of the mechanism for clamping and carrying the film to its initial position for the purpose of repeating the operation.

There is nothing in the disclosure or in the claims to suggest the arresting of the outward movement of the clamps as soon as the film is severed from the roll and the initiating thereupon of a short oscillating movement of the mechanism to and fro, until the film shall have been immersed in the developing liquid sufficiently to bring out the image photographed. It is very clear that no such operation can be derived from the disclosure in the patent, and we agree with the further finding of the Court of Claims that in order to permit "this new oscillating mode of operation evolved by the claimant" material changes would be required in the construction of the machine, from that disclosed in the description and drawings.

The statutes, which are the source of all patent-rights, provided that a valid patent may be granted for a new and useful machine, or for a new and useful improvement thereof (Rev. Stats., 4886,) but they require that every applicant for a patent shall file a written description of the manner and process of making and using his invention "in such full, clear, concise, and exact" terms as to enable any person skilled in the art to which it relates to make and construct it, and in case of a machine the description must disclose the best mode in which the inventor has contemplated the application of his discovery. (Rev. Stats., 4888.)

Ever since *Grant et al v. Raymond* (6 Pet., 218) it has been consistently held that a correct and adequate description or disclosure of a claimed discovery (which, in the case of a machine, involves particularly the operation of it) is essential to the validity of a patent, for the reason that such a disclosure is necessary in order to give the public the benefit of the invention after the patent shall expire. The source of the power to grant patents, and the consideration for granting them, is the advantage which the public will derive

from them, especially after the expiration of the patent monopoly, when the discoveries embodied in them shall become a part of the public stock of knowledge.

The application of these requirements of the law to our conclusion that the only form of construction of the machine and the only method of operation of it which are disclosed in the patent would not produce a sufficiently uniform and rapid development of the film to render it useful, must result in the approval of the judgment of the Court of Claims, that the patent is invalid and void, for the reason that it fails to disclose a practical and useful invention.

This result renders it unnecessary to consider the further conclusion of the court below that the use by the United States of photocopying-machines of a type known as "photostat," manufactured and sold under warrant of Letters Patent issued to D. S. Green, No. 1,001,019, would not have constituted an infringement of appellant's patent had it proved to be valid.

However, for its bearing on future possible controversy we add that the construction and relation of the two appliances, designed to produce the same result or product, have been fully considered and that we agree with the conclusion of the Court of Claims.

Affirmed.

[Supreme Court of the United States.]

NEW YORK SCAFFOLDING COMPANY v. LIEBEL-BINNEY CONSTRUCTION COMPANY. (No. 22.)

Decided November 8, 1920.

280 O. G., 1007; 254 U. S., 24.

PATENTS—VALIDITY—HENDERSON PATENT, No. 959,008, VOID.

The Henderson patent No. 959,008, for scaffold-supporting means, *Held* void for lack of invention in view of the patent to Murray, No. 854,959.

ON WRIT of certiorari to the United States Circuit Court of Appeals for the Third Circuit.

Mr. Frank Chase Somes, Mr. C. P. Goepel, and Mr. Frederick P. Fish for the petitioner.

Mr. Robert H. Parkinson and Mr. Wallace R. Lane for the respondent.

Mr. JUSTICE McKENNA delivered the opinion of the Court.

Suit for infringement by the Construction Company of a patent dated May 10, 1910, and numbered 959,008, for new and useful improvements in "scaffold-supporting means," granted to Elias H. Henderson. Petitioner is assignee of the patent.

An injunction was prayed, accounting of profits and damages.

The patent is in the usual form but a special manner of use of the invention is alleged. It is alleged that since the acquisition of the patent, petitioner has been largely engaged in different cities of the United States in putting the invention into practice, and the manner thereof has been to construct and lease for use to builders and others at a specified royalty or price per week, the scaffolds embodying the invention, petitioner retaining the ownership of and title to the scaffolds, they being returned to petitioner upon the completion by the lessees of the work for which the scaffolds had been required.

The answer of the Construction Company directly puts in issue certain of the allegations of the patent. It admitted, however, the use of scaffolds which it purchased from the Eclipse Scaffolding Company, of Omaha, Nebr., but alleged that such scaffolds did not contain or embody the invention protected by Patent No. 959,008, in any way or manner.

It is also alleged that petitioner, some time prior to February 21, 1914, brought suit in equity in the United States District Court for the District of Nebraska, against one Egbert Whitney, predecessor in title to the Eclipse Scaffolding Company, for the scaffolds sold by the latter company to the Construction Company, in which suit infringement of Patent No. 959,008 was alleged.

In that suit a patent of one William J. Murray (No. 854,959) was pleaded, but the Scaffolding Company withdrew its case as to that patent and relied on claims 1 and 3 of the patent to Henderson, and the court decreed that the claims were void for want of invention, and it is alleged that the Construction Company "is entitled to the protection of said decree."

On the issues thus made by bill and answer proofs were taken and the court decreed against the patent saying in its opinion that—the Henderson patent has not supplanted others, nor has the influence of its owner been exerted to that end. It barely represents a step in the art. It does not disclose invention;
and further—

in view of the conclusion reached by this court that claims 1 and 3 of the patent in said suit are invalid, it is unnecessary to do more than touch upon the matter of infringement. The evidence of infringement is meager and yet if the claims of patent in suit were to be held valid with a range of equivalents, infringement would be found.

The decree was affirmed by the circuit court of appeals. (243 Fed. Rep., 577.)

The Construction Company pleaded in defense as we have said, the decree of the District Court of Nebraska in the suit of petitioner against Egbert Whitney, but that decree was reversed by the circuit court of appeals. (224 Fed. Rep., 452.) The reversal and the opin-

ion of the circuit court of appeals thereon are much relied on in this suit, and we may say constituted the inducement to issue certiorari. It is seemingly antithetical to the opinion and judgment under review and the Circuit Court of Appeals for the Third Circuit felt and expressed the embarrassment of—

disturbing the force of a decision of a court of coördinate jurisdiction, * * * formed upon precisely the same issue and upon substantially the same facts.

The court, however, felt constrained to an “opposite judgment” and decided that Henderson made but “formal changes” in the prior art which involved no invention, and affirmed the decree of the district court.

Necessarily for an estimate of Henderson’s patent we must consider the prior art. It is detailed by witnesses, explained by counsel, and illustrated. Specific descriptions are not necessary. We may refer to our own observation of the first forms of scaffolding. To quote District Judge Orr:

Originally, scaffolding was made to rest upon the ground and was increased in height as the building of the structure demanded.

The first forms of scaffolding which constituted the prior art are described by a witness as—

the thrust out scaffold, the pull scaffold, the timber scaffold; that they were built right up to the front of the building.

In 1900, he testified—

a new device came on the market, or a new structure, and in place of building up from the ground, they hung a rigid iron frame from the upper stories of the building. That could be used on three or four stories sometimes. It was heavy, inconvenient to handle, and did not meet with very great success, although it did seem an improvement over the old poles. Then there came another form of scaffolding which was a suspended wire platform scaffold, suspending the wires from the top of the building. * * * Then there came the Cavanagh overhead scaffolding machine. * * * That machine became fairly well used, after being introduced, and was apparently a great improvement over any other. Then Murray came in the market with his platform machine; a machine operated from the platform, the fastening of the wire that supported the platform being from above, the wire being secured to the out-riggers from the upper part of the building. Then the Henderson machine, supported by cables from the upper part of the building, and similar in a great many respects, except that the machines were placed in the opposite position, enabling you to make a scaffold any width, which would seem to be the latest.

The Murray patent, therefore, is the step in the prior art preceding that made by Henderson and a comparison of the latter’s patent with it, the Murray patent, is immediately indicated.

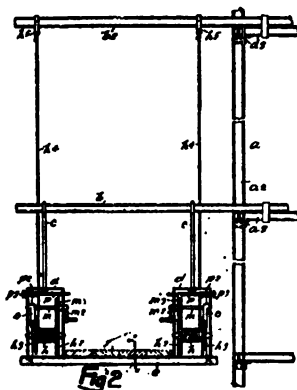
Murray describes his invention to be of “new and useful improvements in adjustable scaffolds.” The object of it, he said, was to provide such a scaffold as would—

permit of adjustment at any height during the construction of a building or the repair thereof.

And he claimed—

the combination with two bars having means for detachably securing them to a building, of a platform, frames on said platform carrying means operable from the platform and having connections adapted to be connected to one of said bars for raising the platform, and supporting means on said frames extending above the said bar when the platform has been fully raised and adapted to detachably engage said bar and rigidly support the platform therefrom, whereby, the platform may be connected to one bar by the raising means and raised to a level to engage the supporting means with said bar and may then remain supported by said bar while the other bar is placed at a higher level and the raising means secured to the latter, the bars thus becoming alternately points of raising support and of rigid support for the platforms.

The following is the illustrative diagram of the claim.



Henderson describes his invention as "certain new and improved scaffold supporting means," and further says it relates—

to an improved means for supporting scaffolds used in connection with the construction of buildings and their repair.

In other words, the patent is, as the Murray patent is, for improvement of scaffold-supporting means. And the details given by Murray, or necessarily implied by him, and the inevitable adjuncts "of cross beam and floor piece" are made elements in the combinations claimed in three claims. There is a change from the Murray hoisting device and it is described to consist—

of a continuous U-shaped metal bar extending around the under side of and upward from the associated beam. * * *

The continuity of metal is the novel element asserted. Counsel emphasize it, not so much for itself as for what it permits. It permits according to counsel, a—

hinged or loose jointed connection between the putlog (called in the claims "cross beams") and the frames that support the putlog and the hoisting mechanism—

and counsel say that this is a—

separate and distinct entity from the elements of the Murray patent, differing in structure, function and result produced.

And of this it is insisted there was no suggestion in the Murray patent, it containing but a single claim and a single idea—

the idea of supporting the scaffold to out-riggers by means of auxillary bars or rods—

so that the platform or scaffold by the lengthening of the cables can be raised to a greater height than before. In other words the assertion is that Murray invented nothing and saw nothing in his device but means of raising the scaffold, and to use counsel's word, all other "functions" were beyond his vision. Or again, and to bring out clearly counsel's contention—

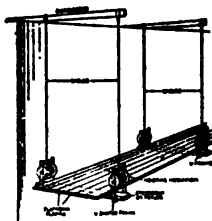
Henderson did not do what Murray did. Murray provided means for supporting a platform temporarily on one set of out-riggers while the cables were being adjusted to a higher set of out-riggers. This is all Murray did, and that was embodied in the one claim of the patent and that is what Henderson did not do. Murray, on the other hand, never suggested the idea of making a hinge or flexible connection between the putlogs and their supporting frames.

The utility of this construction is the final assertion, and that the continuity of metal of the stirrup adds strength, and the loose jointed connection of the putlogs with it gives "flexibility longitudinally and transversely of the platform" and

enables the operator to raise the scaffold machines one at a time, allowing the putlogs to tip or hinge over the support of the U-frame, leaving the machine to stand erect at all times.

The advantage of this is emphasized in various ways and the construction, it is insisted, quoting the patent, "secures the greatest possible amount of security."

Claims 1 and 3 are inserted in the footnote.¹ The following is an illustration of them taken from brief of counsel:



It is further contended that the arrangement of the hoisting device parallel to a building instead of at right angles to it as in the Mur-

¹ 1. A scaffold consisting in the combination of cross beams, floor pieces extending between such beams, and a hoisting device associated with each end of each beam, each hoisting device consisting of a continuous U-shaped metal bar extending around the under side of and upward from the associated beam, and a hoisting drum rotatably supported by the side members of such bar.

3. A scaffold consisting of a plurality of U-shaped bars arranged in pairs, a cross beam laid in and extending between each pair of such U-shaped bars, a floor laid upon said cross beam, a drum rotatably supported between the upwardly extending side members of each of said U-shaped bars, and means of controlling the rotation of said drum.

ray patent, gives more room to the working masons and mechanics, and therefore to their security. This advantage was asserted in the patent, the others were not, nor displayed or counted on. They, however, may be conceded. The fact of non-display in the patent, while it does not militate against his claims for the advantages, causes surprise at least, considering the emphasis that is now put upon them and the assertion that they distinguish and make superior his mechanisms to all that preceded them. However, we may concede to counsel for the sake of the argument, all of the uses and excellencies of the patent even though not discerned by Henderson, but his pretensions, whether at first hand or second, his or those of his counsel, must be subjected to the test and estimate of the prior art and so subjecting them we can discern no exercise of invention. The changes were simply mechanical, easy to discern, and as easy to make, incidental entirely to the main idea of Murray which was, as was declared by him, to provide a scaffold that would—

permit of adjustment at any height during the construction of a building or the repairing thereof—

a scaffold which might—

be readily moved from one position to another by the workmen thereon without interfering materially with the work being performed,

and one “in which different supports are employed,” and—

in which the shifting from one set of supports to another set—

might—

be accomplished without interfering in any degree with the workmen thereon, or their work.

A glance at the diagram which we have given will show that he accomplished his purpose and the way he accomplished it; a glance at the diagram we have given of the Henderson device will show that it is a substantial imitation of Murray's scaffold, the variations being only mechanical. The chief difficulty we have found in the case is the plausibility of the arguments of counsel, and that it secured the assent of the Circuit Court of Appeals for the Eighth Circuit and other courts and strength from such assent.

Decree affirmed.

[Supreme Court of the United States.]

NEW YORK SCAFFOLDING COMPANY *v.* CHAIN BELT COMPANY AND
WHITNEY. (No. 23.)

Decided November 8, 1920.

280 O. G., 1009; 254 U. S., 32.

1. PATENTS—INVENTION—CHANGE READILY MADE.

It may be that the conception of invention cannot be tested by the experience of the inventor in the art or by moments of time and that origi-

nality does not need the aid or delay of drudgery, but one is forced to think that where a change is readily made in any composite instrumentality the change is not the prompting or product of invention.

2. SAME—VALIDITY—HENDERSON PATENT, No. 959,008, Void.

The Henderson patent, No. 959,008, for scaffold-supporting means, *Held* void for lack of invention in view of the patent to Murray, No. 854,959.

ON WRIT of certiorari to the United States Circuit Court of Appeals for the Seventh Circuit.

Mr. Frank Chase Somes, Mr. C. P. Goepel, and Mr. Frederick P. Fish for the petitioner.

Mr. Robert H. Parkinson and Mr. Wallace R. Lane for the respondent.

Mr. Justice McKENNA delivered the opinion of the Court.

Suit by petitioner against Chain Belt Company *et al.*, for infringement of a patent considered in No. 22, *ante*, 487. The bill contains the usual allegations, and prays for an accounting, for damages, and injunctions, preliminary and final.

A copy of the opinion of the Circuit Court of Appeals for the Eighth Circuit in the suit of the Scaffold Company against Egbert Whitney, expressing the judgment of the court sustaining the validity of the patent and adjudging Whitney to be an infringer of it, is attached to the bill.

The answer denied invention and sets forth a number of patents as anticipations, among others, a patent to William Murray. A dismissal of the suit was prayed.

A trial was had upon the issues thus made which resulted in an interlocutory decree awarding an injunction, adjudging infringement, and an accounting.

The injunction decreed is as follows:

That an Injunction be issued under the seal of this court unto the said Chain Belt Company, and the said Egbert Whitney, enjoining them, and each of them, their several agents, officers, employees and all persons in privity with them, and each of them, from making or selling, or causing to be made or sold, the machine known as "Whitney Scaffold Hoist Machines" and "Little Wonder" machines, to be used in the combinations of claims 1 and 3 of said U. S. Patent No. 959,008, or from using or causing said machines to be used in the combinations of said claims, or from infringing upon said claims in any manner whatsoever.

The circuit court of appeals agreed with the district court that the Henderson patent exhibited invention, expressing the view, however, while its advance was slight it was—

not so wholly wanting in invention or novelty as to justify a finding contrary to the presumptive validity of the grant to him.

The court fortified its views by the decision of the Circuit Court of Appeals of the Eighth Circuit in *New York Scaffolding Company v.*

Whitney, (224 Fed. Rep., 452,) citing, however, to the contrary, the decision of the Circuit Court of Appeals of the Third Circuit in *New York Scaffolding Company v. Liebel-Binney Construction Company*, the decision we have just affirmed.

The court, however, decided that the decree was—
erroneous in finding infringement in the manufacture or sale or in any use of the Little Wonder machine.

The decree of the district court was reversed with directions to enter a decree in accordance with the views expressed.

The Henderson patent was made the basis of recovery in *New York Scaffolding Company v. Liebel-Binney Construction Company*, ante, 487, just decided, and there we estimated its inventive quality as tested by the prior art, and as representative of that we took the patent of William Murray, accepting it as an advance upon the prior art.

We need only add to what was there said that our conclusion is confirmed by Henderson's testimony which we insert in the footnote somewhat fully as it cannot be adequately represented in condensation or by paraphrase.¹ From his testimony, it is certain, that his scaffold did not cause him sleepless nights or laborious days. He was not experienced in the art of which it is an example. It may be that the conceptions of invention cannot be tested by such or by moments of time, and that originality does not need the aid or delay of drudgery; but one is forced to think that where a change is readily made in any composite instrumentality the change is not the prompt-

¹ After stating, the schools and colleges he had attended, and that he was admitted to the bar in 1910, he testified as follows:

"3. Q. Will you state when you first acquired any knowledge of the scaffolding business and how it came about?

"A. The first time I had any occasion to consider scaffolding on buildings was about in February 1910—February 1909. I was having dinner with Mr. Merrill, then president of the Noel Construction Company, and I explained to Mr. Merrill a certain gas engine I was designing attempting to get a patent at that time, and Mr. Merrill, whom I had known while I was at the academy at Annapolis, put up to me a proposition of scaffolding on the city hall, which the Noel Construction Company was then building in Chicago, and explained to me the great expense of building up a scaffold from the ground, and stated that it was much more convenient and cheaper to scaffold by swinging the scaffold from an overhead outrigger. He said there was such a scaffold in use and being put up by a New York concern, but that the rental charged by the New York concern was prohibitory of its use on the city hall, and said with my mechanical training I ought to be able to devise a means of swinging a scaffold, and instructed me to go ahead and see what I could do.

"A. This was in February 1909."

He further testified that Mr. Merrill called his attention to devices that were then in use in Chicago at the Blackstone Hotel and that shortly after he went down to the hotel.

He further testified:

"A. On the north side of the building there was a scaffold suspended by overhead outriggers, cables led down to a drum, the cable passed over a little pulley wheel on the top cross member of the scaffold down to a drum, and the drums were in pairs opposite at right angles to the building. These drums were supported above a U-frame which was held in place, bolted, with two angle irons, the bolts passed through the U-frame, and then the planking was laid along the scaffold on top of the angle irons which was

ing or product of invention. Indeed, it is a common experience in patent cases that mere mechanical facility can alter or change the form in which originality and merit expressed themselves and assert for it the claim of invention. This case is an example of such pretension. We may repeat counsel's question and ask what did Henderson do that Murray did not do? He made the U-frame which supported the hoisting device of continuous metal instead of as Murray did of several pieces riveted together and in the stirrup which it formed he rested the putlogs or beams loosely making a hinged joint connection between the stirrup and the hoisting machines with a resulting flexibility. This consequence and its advantage, if it have such,² it is admitted he did not discern, and naturally. His purpose was evasion. To evasion he was prompted. Beyond what was necessary to that he exerted no vision or conception. He had had no experience in the art, and what knowledge of the Murray scaffolding he had was obtained by a thirty minutes' observation of it in operation. We yield to the assertion of counsel

bolted to the U-frames and the drums were operated by means of the ratchet lever, to which the men put a pipe, making an extension, and pumped it up and down.

"18 Q. Just how were the putlogs supported relative to the U-frame concerning which you have testified?

"A. The putlogs were bolted alongside of the U-frame and the bolts passed through the U-frame.

"14 Q. Did you see the machines operate?

"A. Yes, the men were laying brick along the scaffold, a couple of laborers hoisted one end of the scaffold.

"15 Q. So you saw it raised during the time you were there?

"A. Yes, sir.

"16 Q. At that time had you done any work on what later developed into your patent in suit?

"A. I had not."

And further:

"A. I didn't do anything further until about the middle of May. Mr. Merrill called me up and asked me to come down to the office. I went down and he asked me if I had a scaffold ready for him or had any ideas. I told him no, that I had not. He said, 'I have been depending upon you to design something, and I have got to have something.' So he called in Mr. Peterson, the superintendent, took me over to the city hall and showed me the wall he wanted to scaffold in the court there, and I then went over to Carpenter & Company and inspected some winches he had there to see if it was practicable to bolt the winches to wooden putlogs. And owing to the fact that Carpenter & Company wanted more money than Merrill could pay, for scaffold, didn't make a deal with him. Then I went home and made up the design for the scaffold that I subsequently applied for a patent on, and took it down to Brown & Williams' attorneys, and asked them if I could get a patent on it. They thought I could. Mr. Merrill said he would have Parker & Carter investigate if there would be no infringement on the winch and instead of bolting the windlass to the putlog, I found I could utilize pieces of 2 x 10 around the building for putlogs and place them in the U-frame, and would make the scaffolds easier to put into the building and much simpler to dismantle—to take off.

"Q—. Where did you get your knowledge of the U-frame being used in this line of work?

"A. I saw U-frames on the Blackstone Hotel. It was just an ordinary stirrup."

² There is a denial of advantage, and it was admitted at the argument that rigidity of the putlog and frame was sometimes resorted to. Counsel tried to minimize the necessity or practice by saying that it was accomplished by a ten-penny nail. Manifestly it was the effect and its necessity or advantage which were important, not the means of their accomplishment, and the necessity or advantage cannot be estimated by the size of the nail.

that he cannot be deprived of an advantage because he did not discern it, but the same concession must be given to Murray. He was entitled to all of the benefit that he claimed for his device, or that can be given to it by formal changes.

It will be observed that the circuit court of appeals and the district court disagreed in their views of the relation of the Little Wonder machine to the Henderson device, the latter considering it an infringement, the former determining otherwise, and to that extent reversing the decree of the district court. Both courts however concurred in ascribing invention to the Henderson device. In this both courts erred.

The decree of the district court is therefore reversed and the case remanded to that court with directions to dismiss the bill of complaint on the ground that the Henderson patent is invalid, it exhibiting no invention.

So ordered.

[Supreme Court of the United States.]

BERLIN MILLS COMPANY v. PROCTER & GAMBLE COMPANY.

Decided December 6, 1920.

281 O. G., 574; 254 U. S., 156.

PATENTS—VALIDITY—BURCHENAL PATENT FOR LARDLIKE FOOD PRODUCT INVALID.

The Burchenal patent, No. 1,135,351, for a food product, claims 1 and 2, for a homogeneous lardlike food product consisting of an incompletely hydrogenized vegetable oil or cotton-seed oil, *Held* devoid of invention in view of the prior art.

ON WRIT of certiorari to the United States Circuit Court of Appeals for the Second Circuit.

Mr. Charles E. Hughes, Mr. Marcus B. May, Mr. John C. Pennie, and Mr. Melville Church for Berlin Mills Company.

Mr. Livingston Gifford, Mr. Thomas B. Kerr, Mr. John H. Brickenstein, and Mr. Alfred M. Allen for Procter & Gamble Company.

Mr. Justice DAY delivered the opinion of the Court.

This suit was brought by the Procter & Gamble Company against the Berlin Mills Company for the infringement of the patent of John J. Burchenal for a food product, issued on April 13, 1915, No. 1,135,351, and assigned to the Procter & Gamble Company. The district court held the patent void for lack of invention, and also that the claims in suit were not infringed. The circuit court of appeals, one judge dissenting, held the patent valid and infringed. (256 Fed. Rep., 23.)

The patent in controversy relates to a lardlike food product consisting of a vegetable oil partially hydrogenized to a homogeneous whitish, yellowish product. The record discloses that the making of lard substitutes has been accomplished by mixing melted fat with vegetable oils.

These oils contain glycerids—olein, linolin and stearin. The hydrogenation, or hardening process, has the effect to increase the proportion of the solid glycerids of high saturation. Stearin is called a saturated glycerid for the reason—

that there are present in the molecule as many hydrogen atoms as possibly can be joined to the carbon atoms.

Linolin and olein are called unsaturated glycerids and can be converted by the addition of hydrogen into hardened glycerids.

The patentee in the specifications of his patent states the object of his alleged invention, and what he intended to accomplish, as follows:

The special object of the invention is to provide a new food product for a shortening in cooking, in which the liability to become rancid is minimized, and in which the components of such vegetable oils which are inferior and detrimental to use as such a food product have been to a large extent converted into a higher and more wholesome form. All such vegetable oils contain glycerids of unsaturated fatty acids, and among these, notable quantities of fatty glycerids of lower saturation than olein. It is the presence of these glycerids of lower saturation that seriously affects the rancidity of the material. Oxidation is largely the cause of rancidity, which oxidation weakens the fat at the point of absorption at the double bonds, and these glycerids of lesser saturation readily absorb oxygen from the air at ordinary temperatures, while the more highly saturated glycerids, as olein, only absorb oxygen at elevated temperatures. It is evident, therefore, that oils or fats containing notable quantities of glycerids of linolic acid, or of lesser saturation, are distinctly inferior as an edible product to those containing a minimum of these glycerids with a larger per cent. of olein. On the other hand, while it is important to get rid of the readily oxidizable glycerids of lower saturation, it is also important not to supply too large a per cent. of fully saturated glycerids. * * * Oil, liquid at the ordinary temperatures, does not make the best shortening, because the oil remains liquid, keeping the food in a soggy condition, and the oil will even settle to the under part of the cooked product and soil the cloth, paper, or whatever it may come in contact with. Moreover, fats of a melting point above the temperature of the human body, 98° F., are not so digestible as fats which are liquid at this point, or which have a melting point below 98° F. It is, therefore, my object in the preparation of my new lard-like composition and food-product, and in preparing same from cottonseed oil, to change the chemical composition of the oil to obtain a product with a high percentage of olein, a low percentage of linolin and the lesser-saturated fats, and with only sufficient stearin to make the product congeal at ordinary temperatures.

In manufacturing this product, cotton-seed or other vegetable oil is caused to chemically absorb a limited amount of hydrogen by reacting on the oil with hydrogen in the presence of a catalytic agent and at an elevated temperature. The oil is preferably agitated in a closed vessel in the presence of an atmosphere of compressed hydrogen, a catalyzer of finely-divided nickel carried by

kieselguhr being maintained in suspension in the oil and its temperature being raised to about 155° C.

According to the present invention, the amount of hydrogen absorbed is carefully regulated and limited. In practice, the operation is stopped when the oil has been converted into a product which cools to a white or yellowish semi-solid more closely resembling lard than do the commercial mixtures of cottonseed oil and animal oleo-stearin, while in many respects the product is superior to the best leaf lard as a shortening. It is not so liable to become rancid and the product can be heated to a considerably higher temperature than lard without smoking or burning. * * * The high temperature to which my product can be raised without smoking or burning makes the product ideal for frying, inasmuch as a crust forms almost instantly on the food fried, which prevents any absorption of the shortening. A lard-like product thus prepared from cottonseed oil has a saponification value of about 195; and an iodine value ranging from about 55 to about 80. The product having an iodine value of 55 has a titre of about 42° and a melting-point of about 40° C.; that having an iodine value of 80 has a titre of about 35^m and a melting-point of about 33° C. While but partially hydrogenized, containing from about 1.5% to 2.5% of additional hydrogen more than in the nonhydrogenized material, it shows no free cottonseed oil when subjected to the Halphen test, thereby differing from all commercial lard substitutes containing this oil. It contains from twenty to twenty-five per cent. of fully saturated glycerids, from five to ten per cent. of linolin and from sixty-five to seventy-five per cent. olein, and an average of a number of samples gives twenty-three per cent. of saturated fats, seven and five-tenths per cent. linolin and sixty-nine and five-tenths per cent. olein, while the cottonseed oil before treatment contained seventeen per cent. saturated fats, thirty-seven per cent. linolin and forty-six per cent. olein. It will thus be seen that I have produced an ideal food product, which is high in olein, low in linolin and lesser-saturated fats, and with only enough stearin to make the product congeal at ordinary temperatures.

The patent has seven claims; two broad claims, which are the ones here involved:

1. A homogeneous lard-like food product consisting of an incompletely hydrogenized vegetable oil.
2. A homogeneous lard-like food product consisting of incompletely hydrogenized cottonseed oil.

The five additional claims, more specific and limited, are not involved in this suit. Two of the four judges who considered this patent and the validity of the claims in suit reached the conclusion that they were void for want of invention; two judges of the circuit court of appeals held the patent valid, and infringed.

In deciding between these conflicting views we must consider the genesis of the alleged invention, and what was theretofore known and disclosed in the art. Burchenal, the patentee, was not a chemist, and was the general manager of the Procter & Gamble Company, whose principal business had been the manufacture of soap. One Edwin C. Kayser, who had been in the employ of Crossfield & Son, an English firm, and familiar with the Normann process, to be hereinafter con-

sidered, came to this country in 1907, and saw Mr. Burchenal at the Procter & Gamble factory. A contract was made with Kayser, and an experimental plant was erected at the Procter & Gamble works for hydrogenating oil.

It is the contention of the respondent that the merit of Burchenal's alleged invention arises from the fact that he was the first to originate and develop the process involved so as to make a food product of the character described.

The district court found that Burchenal in fact invented nothing, and that all that was real invention, as established by the testimony, came from Kayser. But considering, for the purposes of this discussion, that the thought occurred to Burchenal, which he developed in the production of a food product, the subject-matter of this patent, the primary question is presented whether what Burchenal accomplished amounted to invention within the meaning and protection of the patent law.

In considering the patentability of this alleged invention, it is to be remembered that this is not claimed to be a process patent. While the process is described in the specifications, Burchenal makes no claim that it is his invention, indeed, he concedes in the testimony that the process is not his, and counsel frankly say that the patent must stand or fall upon its validity as a product patent of a new and useful thing within the meaning of the patent law. If this product were the result of mechanical improvement only, when viewed in the light of that which was previously disclosed and open to public use, the step in advance being only that which one skilled in the art might well make, without the exercise of the originating or inventing faculty, then the achievement is not within the protection of the patent law.

The English patent to Normann of October, 1903, disclosed to the world the process of converting unsaturated fatty acids, or their glycerids, into saturated compounds. After referring to other discoveries he says:

By causing acetylene, ethylene, or benzene vapor in mixture with hydrogen gas to pass over one of the said metals, the said investigators obtained from the unsaturated hydrocarbons saturated hydrocarbons, partly with simultaneous condensation.

I have found, that it is easy to convert by this catalytic method unsaturated fatty acids into saturated acids. This may be effected by causing vapors of fatty acid together with hydrogen to pass over the catalytic metal, which is preferably distributed over a suitable support, such as pumice stone. It is sufficient, however, to expose the fat or the fatty acid in a liquid condition to the action of hydrogen and the catalytic substance.

For instance, if fine nickel powder obtained by reduction in a current of hydrogen, is added to chemically pure oleic acid, then the latter heated over an

oil bath, and a strong current of hydrogen is caused to pass through it for a sufficient length of time, the oleic acid may be completely converted into stearic acid.

The quantity of the nickel thus added and the temperature are immaterial and will only affect the duration of the process. Apart from the formation of small quantities of nickel soap, which may be easily decomposed by dilute mineral acids, the reaction passes off without any secondary reaction taking place. The same nickel may be used repeatedly. Instead of pure oleic acid, commercial fatty acids may be treated in the same manner. The yellowish fatty acids of tallow, which melt between 44 and 48° C. and whose iodine number is 35.1, will, after hydrogenation, melt between 56.5 and 59° C., while their iodine number will be 9.8 and their color slightly lighter than before, and they will be very hard.

The same method is applicable not only to free fatty acids, but also to their glycerids occurring in nature, that is to say, to fats and oils. Olive oil will yield a hard tallow-like mass; linseed oil and fish oil will give similar results.

By the new method, all kinds of unsaturated fatty acids and their glycerids may be easily hydrogenized.

An expert witness, called by petitioner, gives in his testimony certain views of this process which commend themselves to our judgment as entirely reasonable and accurate, and so well stated that we quote them in part:

Dr. Normann discovered, and sets forth in the patent, that unsaturated acids or unsaturated oils by the action of hydrogen in the presence of finely divided nickel may be converted into corresponding saturated compounds. He defines the reaction rather carefully in some regards. He says, for instance, if fine nickel powder obtained by reduction in the current of hydrogen is added to chemically pure oleic acid, then the latter heated over an oil bath and a strong current of hydrogen is caused to pass through it for a sufficient length of time, the oleic acid may be completely converted into stearic acid.

Further on he says:

"Apart from the formation of small quantities of nickel soap, which may be easily decomposed by dilute mineral acids, the reaction passes off without any secondary reaction taking place."

I think that those two sentences which I have read very well define the product which is obtained by such reduction especially the second sentence, where he says that the reaction goes on in a quantitative way, we will say; that is he says that there is no side reaction takes place. A chemist would know from this first paragraph where he says that oleic acid goes to stearic acid, and from the second one where he says that no side reaction takes place, the chemist would know exactly what the product is which is formed by this reaction. * * *

I would call attention particularly to the fact that he hardened olive oil to a hard, tallow-like mass. Tallow is a substance that is obtained from the fat of either cattle or of sheep and is a substance of somewhat semi-solid character; that is, its lower limit of melting point is within a lard range and its upper limit is just slightly beyond the lard range so that if Normann hardened olive oil to a tallow-like mass that means that he hardened it to a product of a semi-solid character.

Q. 63. Does Normann specify anywhere in his patent any of the purposes for which his patents are intended?

A. He does not. He says nothing in the patent as to what these products should be used for. The presumption is that they might be used for any purpose for which fats of that general character could be utilized. They might be used for making candles; they might be used for soaps; they might be used for edible purposes.

By the passages I have read he has very carefully specified what the product is so that any chemist would know for what particular purposes it might be useful.

Q. 64. In the process of hydrogenation as described in the Normann patent from which you made citations; that is, the British Patent No. 1515 of 1903. what would your conclusion be as to the edibility of the resultant product when the material hydrogenated was among those suggested by him, olive oil?

A. If an edible olive oil was started with one would certainly obtain an edible hydrogenated product.

It is in evidence that this method, shown by Normann, is a practicable one, and may be used for the making of edible food products of the kind here involved.

With the knowledge disclosed in the Normann patent conclusively presumed to be known by the patentee, was it invention to apply the known process to vegetable oils? In this connection the history of the application for the patent in suit in the Patent Office is interesting and instructive. It is true that claims 1 and 2 were finally allowed, and the patentee is entitled to the presumption which arises from the granting of them. But it appears in the history of the application for the Burchenal patent, found in the record, that as originally presented it contained two claims not so broad as the ones now in suit, and a third claim for "a semi-solid hydrogenized oil," was added by amendment. All of the claims were rejected, the Examiner saying:

The composition of lard and of cottonseed oil as to the glycerids olein and stearin that they contain is well known. To make a product from cottonseed oil that shall simulate lard the content of stearin should be increased. [Referring to patents.] It is thought therefore that if the problem of simulating lard from cottonseed oil were presented to an oil chemist, an incomplete hydrogenization of the cottonseed oil would at once suggest itself to him as a solution of the problem. All the claims are accordingly rejected on the above ground of lack of invention. Claim 3 is further rejected on the product formed by the above cited patents.

Replying to the communication of the Examiner amendment was made canceling claim 3. Further consideration was requested on claims 1 and 2, upon arguments which were presented. The claims were afterward rejected upon reference to patents to Kayser of September 26, 1911, and November 14, 1911, the Examiner stating that these patents were adapted to hydrogenize glycerids, the latter one specifically mentioning its adaptability for cottonseed oil, and that the process could be arrested at any time during its progress and thus an incompletely hydrogenized article be produced.

Subsequently the specifications were amended, giving more definitely the percentages of olein, linolin, and stearin. The patentee concludes the amended specifications, stating:

It will thus be seen that I have produced an ideal food product, which is high in olein, low in linolin and lesser-saturated fats, and with only enough stearin to make the product congeal at ordinary temperatures;

additional and more limited claims were added, but ultimately the patent, containing the broad claims here involved, was granted.

It is true, as the circuit court of appeals states in its opinion, that the applicant never did acquiesce in the Examiner's action rejecting his claims, and finally obtained what he had in the first place asked for.

This record establishes that it was known before Burchenal took up the subject that a vegetable oil could be changed into a semisolid, homogeneous, substance by a process of hydrogenation arrested before completion and that it might be edible. This much of the art was public property and open to general use. The product of this process was known and open to public use. To supply such products as the patentee has described in the broad claims in suit may have been new and useful, but does not in our opinion arise to the dignity of invention, and is an advance step which would occur to one skilled in the art when investigating and considering the subject.

It follows that the decree of the circuit court of appeals must be reversed and the cause remanded to the district court with directions to dismiss the bill on the ground that claims 1 and 2 are void for the reasons stated in this opinion.

Reversed.

DIGEST OF DECISIONS.

[Opinions of the Solicitor of the Department of the Interior are indicated by a degree mark (*); of the Attorney General by a double dagger (‡); decisions of the Supreme Court of the District of Columbia by the letter (°); of the Court of Appeals of the District of Columbia by one star (*); of the United States Circuit Court of Appeals by the letter (°); and of the Supreme Court of the United States by two stars (**).]

ABANDONED EXPERIMENTS. See *Priority of Invention*, 7.

1. **SUBSEQUENT CHANGE OF CONSTRUCTION ALONE DOES NOT ESTABLISH.**—The making of improved machines after an alleged reduction to practice and after commercial production of such machines is not alone sufficient to discredit the claim of successful operation and warrant a holding that the earlier construction was merely an abandoned experiment. *Antoine and Travis v. Grover and Barber*, 18.
2. **INTERFERENCE—PRIORITY.**—Where G. built a plow-tractor in the summer of 1914, took it to a farm and tested it, brought it back, and laid it aside until the spring of 1916, where it was observed by licensees of the opposing party, H., who induced G. to file an application, while H. filed his application on July 21, 1915, and promptly perfected his machine and placed it on the market, *Held* that what G. did in 1914 must be regarded as an abandoned experiment in view of his failure to act except under the stimulus of the knowledge of H.'s activity and of the further circumstances that, although the tractor was in the same condition at the time of taking testimony and the sufficiency of the test in 1914 was challenged, no attempt was made to prove its operativeness, and that after said test G. directed his attention to the construction of another machine, which was completed in 1916, and for which he immediately applied for a patent. * *Hartsough v. Gile*, 187.
3. **INTERFERENCE—DELAY.**—A party must be judged by his conduct rather than by what he says afterward were his intentions. Where G. alleges that he constructed a device in March, 1913, and tested it shortly thereafter by placing it in a car for a week, after which it was removed and taken to a party for the purpose of having dies made, where it remained until 1917, and that this test was so satisfactory that he did not think it necessary to test two other devices made in August, 1914, and August, 1915, respectively, but he further testifies that three other devices were made in 1916, and that several thousand devices constructed in accordance with these models were made and sold, but no application for the invention was filed until June, 1916, although three other applications were filed which were not within the issue, *Held* that the evidence indicates that what was done in 1913 amounted only to an abandoned experiment. *Grus, Jr., v. Eynon*, 49.
4. **SAME—REDUCTION TO PRACTICE.**—In an interference relating to an oil flotation apparatus and process where a party made laboratory experiments in 1912 in which he employed a glass funnel, a wash-bottle from which to supply water, and a spoon with which to feed ore, by which he could treat about four hundred pounds of ore per day, but did little or nothing thereafter to commercialize his machine and never made any salable commercial article, did not file his application until 1915, but

ABANDONED EXPERIMENTS—Continued.

took out another patent in October, 1915, for a different device, *Held* that what was done in 1912 must be considered as merely experimental. *Haley v. Du Rell*, 53.

ABANDONMENT OF APPLICATIONS. See *Continuation of Applications*, 2. *Delay in filing applications for reissues*, 3.

1. **SUFFICIENCY OF RESPONSE.**—Where amendments to the specification and drawings were filed on November 13, 1918, at the expiration of the year allowed for taking action, and on November 18, 1918, the Examiner notified the attorney that the amendments to the drawings had not been entered because all necessary corrections had not been made, made other criticisms, and stated that the claims were allowable, in response to which the attorney filed another amendment on November 22, 1918, whereupon the Examiner held the case abandoned, *Held* that the Examiner's action was wrong. If the amendment filed at the expiration of the year, taken with prior amendments, in the opinion of the Examiner were not responsive, he should have then held the application abandoned; but having objected to the sufficiency of the amendments and acted on the merits applicant was entitled to a year from that action in which to reply. *Ex parte Humphrys*, 70.
2. **BY SUCCESSFUL INTERFERENT—RIGHT OF LOSING PARTY TO A PATENT.**—Where the winning party to an interference has abandoned his application, the losing party is not entitled to a patent if the winning party has otherwise given the invention to the public before that abandonment took place, and certainly is not entitled to it if it was first reduced to practice by the winning party or if the prior conception of the latter was coupled by diligence with an actual reduction to practice, so that his work would constitute a valid defense under section 4920, Revised Statutes. *Nash v. Reeder v. Ryan*, 72.
3. **EVIDENCE OF COMPLETION AND PUBLIC USE OF INVENTION BY WINNING PARTY.**—Where in an interference proceeding there is no evidence of the completion of the invention by the winning party, upon abandonment of such application the refusal of a patent to the losing party can not properly be based upon an affidavit averring that the winning party had reduced the invention to practice and put it into public use; but such facts must be proved by evidence showing that the device was actually put into use and was satisfactory. *Id.*

ABANDONMENT OF CLAIMS. See *Disclaimers*.

ABANDONMENT OF INVENTION. See *Delay in Filing Applications for Reissue; Priority of Invention*, 14; *Renewal of Forfeited Applications*.

1. **ALLEGED BURDEN OF PROOF.**—In an interference proceeding one asserting the abandonment of the invention by another party has the burden of proving it, and where the only evidence relied upon is a delay of ten months after reduction to practice in filing the application for patent the burden is not sustained where the delay is explained by evidence of financial embarrassment. * *Hoenig v. Parker*, 234.
2. **QUESTION OF FACT.**—The failure of an applicant to renew a forfeited application for twenty-three months after allowance of the original does not of itself effect an abandonment of the invention even in favor of one who takes out a patent for the same invention during the period of forfeiture, the question of abandonment being one of fact, which must affirmatively appear and cannot be presumed from mere delay. * *Wells and Hunter v. Hontgmann*, 242.

ABUSE OF DISCRETION. See *Discretion of the Commissioner of Patents*.
ACQUIESCENCE. See *Claims*, 10; *Infringement*, 6; *Interference*, 2; *Laches*.
ACQUISITION. See *Trade-Marks*, 11, 12.
ACT OF MARCH 3. 1883. See *Construction of Statutes*, 1.
ADAPTATION. See *Construction of Specifications and Patents*, 13.
ADOPTION AND USE. See *Trade-Marks*, 47, 51.
ADVERSE DECISIONS IN INTERFERENCE. See *Interference*, 7.
AFFIDAVITS. See *Abandonment of Applications*, 3; *Anticipation*, 2; *Final Fees*; *Interference*, 17; *Patentability*, 1; *Priority of Invention* 3, 4; *Suits for Infringement*, 4.
AFFIDAVITS UNDER RULE 75.

ACCESS TO.—Where claims forming the issue of an interference had been rejected in view of a prior patent and the rejection withdrawn by the Examiner in view of affidavits filed under Rule 75, which were then sealed up, upon motion to dissolve, alleging non-patentability in view of such patent, it was not error for the Patent Office to refuse access by the moving party to such affidavits, since the issue raised by the affidavits—patentability—was one in which the moving party had no interest in the interference proceeding. * *Erben v. Yardley*, 220.

AGENTS. See *Delay in Filing Application for Retissue*, 4; *Infringement*, 6, 7.
AGGREGATION. See *Construction of Claims*, 6, 7; *Construction of Specifications and Patents*, 21; *Patentability*, 6.
AMENDMENT OF CLAIMS.

DOUBLE PATENTING.—An amendment of a patent claim to meet the Commissioner's objection of double patenting is as binding on the patentee as an amendment to avoid rejection on the prior art, especially as the limitation, if intentionally made, would be binding, though voluntary. * *Higgin Mfg. Co. v. Watson et al.*, 408.

AMENDMENT TO PRELIMINARY STATEMENT.

1. **INTERFERENCE.**—A party to an interference will not be allowed, in order to correct an alleged error in his preliminary statement, to amend such statement to carry his date of conception and disclosure back of the dates proved by his rival, after such proofs are in, unless the utmost care would apparently have failed to avoid the alleged error. *Caps v. Kennicott*, 6.

2. **SAME—EXCUSE INSUFFICIENT.**—Where a preliminary statement is made upon one understanding of the issue, an amendment thereof which would result in distinct injury to a rival will not be permitted because of another understanding of the issue suggested by other parties. *Id.*

AMENDMENTS. See *Abandonment of Applications*, 1; *Amendments to Drawings*; *Construction of Claims*, 5; *Construction of Statutes*, 4; *Joint Application, One Applicant not Inventor*, 2.

APPLICATION—NEW MATTER.—Amendments attempting to cover up practical devices brought into use after the filing of the application. *Held* to be without foundation in the original disclosure. *Ex parte Smith*, 2.

AMENDMENTS TO DRAWINGS. See *Abandonment of Applications*, 1.

ENTRY.—Proposed amendments to drawings should not be refused entry merely because they do not make all the changes which the Examiner regards as necessary, but they should be refused entry if the work would probably have to be undone. *Ex parte Humphrys*, 70.

ANALOGOUS USE. See *Construction of Specifications and Patents*, 16; *Invention*, 23, 26, 27, *Patentability*, 3, 4.

ANTICIPATION. See *Construction of Specifications and Patents*, 1, 6, 7, 10, 16; *Construction of Statutes*, 4; *Infringement*, 8; *Invention*, 6, 11, 12, 28; *Particular Patents*, 2, 7, 9, 12, 15, 22, 28, 34, 36, 43, 45, 48; *Patentability*, 2; *Suits for Infringement*, 2, 7, 9; *Trade-Marks*, 5; *Validity of Patents*, 2, 3.

1. **DISCLOSURE.**—A patent for an explosive which specifically states that the product formed is free from compounds containing nitroglycerin does not anticipate claims to an explosive limited to a mixture consisting of nitrated sugar and nitroglycerin. *Ex parte Comey*, 65.
2. **AFFIDAVITS SHOWING DISTINCTION BETWEEN APPLICANT'S CLAIMS AND PRIOR PATENT.**—A prior patent for a process for producing an explosive, *Held* to be not an anticipation in view of affidavits of experiments performed which sufficiently showed that the process described would not produce an explosive such as set out in the claims alleged to be anticipated. *Id.*
3. **BRITISH AND FRENCH PATENTS—ENROLLMENT.**—British and French patents do not become "patents," or "printed publications," within the meaning of the patent statutes, until the enrollment or sealing of the complete specifications, so that they cannot defeat a United States patent, unless enrolled before the invention or two years before the application. *Barber v. Otis Motor Sales Co.*, 106.
4. **DATE OF ENROLLMENT—FOREIGN PATENTS.**—Evidence by the inventor and others, showing drawings, patterns, and an experimental machine involving the invention, *Held* to show invention before the date of enrollment of foreign patents, which were enrolled less than two years before the application for United States patent. *Id.*
5. **INVENTOR MAY SHOW DATE OF INVENTION BY COMPETENT PROOF.**—Where defendant makes no rival claim to priority of invention, but relies on the statutory defense of anticipation, the patentee may show, if he can, the fact of his prior invention by drawings, sketches, models, or any other competent proofs. *Id.*

APPARATUS. See *Construction of Specifications and Patents*, 8, 9, 11; *Diligence*, 2; *Particular Patents*, 4, 9, 23, 24, 39; *Patentability*, 4, 6; *Priority of Invention*, 3, 4; *Reduction to Practice*, 3, 9.

APPEAL. See *Interference*, 7, 8, 22; *Rights of Holder of Legal Title of Patent*; *Trade-Marks*, 13, 14, 53; *Suits under Section 4915 Revised Statutes*, 2; *Validity of Patents*, 3.

APPEAL TO THE COMMISSIONER OF PATENTS. See *Claims*, 4; *Interference*, 17; *Trade-Marks*, 14.

REVIEW NOT RESTRICTED TO QUESTIONS PUT IN ASSIGNMENT OF ERRORS.—On appeal to the Commissioner he is not bound to decide merely the specific questions put to him by the assignments of error, because it is his duty to refuse a patent whenever he has an opinion that the patent ought not to be granted, and it is immaterial how he gets the information upon which he bases his opinion. *Ex parte Duncan*, 36.

APPEAL TO THE CIRCUIT COURT OF APPEALS. See *Certiorari*; *Suits for Infringement*, 4; *Trade-Marks*, 18.

1. **PRELIMINARY ORDER—POWER TO TERMINATE LITIGATION.**—"The power of circuit courts of appeals to review preliminary orders granting injunctions arises from section 129, Judicial Code. * * * This power is not limited to mere consideration of, and action upon, the order appealed from; but, if insuperable objection to maintaining the bill

APPEAL TO THE CIRCUIT COURT OF APPEALS—Continued.

clearly appears, it may be dismissed and the litigation terminated."

**** Meccano Limited v. John Wanamaker, New York, 478.**

2. **SAME—SCOPE OF REVIEW.**—Whether a preliminary injunction shall be awarded rests in the sound discretion of the trial court. Upon appeal an order granting or denying such an injunction will not be disturbed unless contrary to some rule of equity, or the result of improvident exercise of judicial discretion. **** Id.**

APPEAL TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA. See *Court of Appeals of the District of Columbia; Discretion of the Commissioner of Patents; Interference*, 16; *Jurisdiction of the Commissioner of Patents; Trade-Marks*, 13.

1. **DISMISSED FOR FAILURE TO FILE BRIEF.**—Motion to dismiss an appeal for failure to file a brief within the time specified granted under Rule 8 (sec. 4b) of the Rules of the Court of Appeals of the District of Columbia. *** Wegner v. Bobbitt, 164.**

2. **MATTERS RENEWED—CLAIMS NOT CONSIDERED BY COMMISSIONER.**—Where, after an appeal to the court of appeals from a refusal to allow certain claims is perfected, an applicant presented for consideration certain other claims as substitutes in a petition for rehearing, which was denied, and such claims are presented to the court on the appeals, *Held* that the court will not consider them, as appeal lies only from a final decision. *** In re Smith, 140.**

APPEAL TO THE EXAMINERS-IN-CHIEF. See *Interference*, 7.APPEAL TO THE SUPREME COURT OF THE UNITED STATES. See *Certiorari*.APPLICATIONS. See *Claims*, 4; *Copending Applications; Delay in filing Applications for Reissue; Earlier and Later Applications; Final Fees; Joint Application, one applicant not Inventor; Priority of Invention*, 2, 3; *Public Use Proceedings*, 2.ASSIGNEES. See *Interference*, 1, 22, 23; *Licenses; Priority of Invention*, 2.ASSIGNMENTS OF ERROR. See *Appeal to the Commissioner of Patents*.ATTORNEYS. See *Abandonment of Applications*, 1; *Delay in Filing Applications for Reissue*, 4; *Interference*, 14; *Suits for Infringement*, 5.AUTHORITY OF COMMISSIONER OF PATENTS. See *Final Fees*.AUTHORITY OF THE PATENT OFFICE. See *Divisional Applications*, 8.BAR TO PATENTS. See *Double Patenting*, 1, 2; *Interference*, 16; *Priority of Invention*, 11.BILL IN EQUITY. See *Suits Under Section 4915, Revised Statutes*.BRIEFS. See *Appeal to the Court of Appeals of the District of Columbia; Public Use Proceedings*, 2.BROAD CLAIMS. See *Claims*, 10; *Delay in Filing Applications for Reissue; Particular Patents*, 10, 20.BURDEN OF PROOF. See *Abandonment of Invention*, 1; *Interference*, 2, 6, 12, 20; *Priority of Invention*, 1.CANCELATION OF ELEMENT. See *Trade-Marks*, 8.CANCELATION OF TRADE-MARK REGISTRATION. See *Trade-Marks*, 14, 41.CERTIORARI. See *Suits for Infringement*, 4.

1. **APPEAL AND ERROR—POWER OF SUPREME COURT TO REVIEW DECREES MADE FINAL IN CIRCUIT COURTS OF APPEALS.**—Decrees which are declared final under section 128 of the Judicial Code may be taken upon cer-

CERTIORARI—Continued.

tiorari by the Supreme Court and treated as if on appeal. (Sec. 240, Judicial Code.) **** *Meccano Limited v. John Wanamaker, New York, 478.***

2. **SAME—REVIEW BY SUPREME COURT OF INTERLOCUTORY DECREE.**—Upon certiorari by the Supreme Court to a circuit court of appeals bringing up for consideration a decree upon an appeal from an interlocutory order the judgment of the appellate court, exercised upon a view of all relevant circumstances, is entitled to great weight and, except for strong reasons, will not be interfered with. **** *Id.***
3. **SAME—CONFLICT OF DECISIONS—BRINGING UP PRELIMINARY ORDER FOR REVIEW—MERITS NOT CONSIDERED.**—Where the Circuit Court of Appeals of the Sixth Circuit held a patent for toys invalid, but granted an injunction against unfair competition in the sale of such toys and infringement of copyright on a trade catalogue, and the Circuit Court of Appeals of the Second Circuit, on appeal from an interlocutory order in another suit brought by the same plaintiff against a customer of defendant for like infringements, denied all relief and refused plaintiff's motion for a final decision on the merits, upon certiorari to the Supreme Court from the latter decision, *Held* that the Supreme Court would not declare which of the conflicting views of the two circuit courts of appeals was right or undertake to decide the several issues involved upon their merits, the matter for review being only the action of the courts below upon the preliminary order. **** *Id.***

CITIZENSHIP. See *Trade-Marks*, 21.

CLAIMS. See *Appeal to the Court of Appeals of the District of Columbia*, 2; *Abandonment of Applications*, 1; *Affidavits under Rule 75*; *Anticipation*, 1, 2; *Construction of Claims*; *Construction of Specifications and Patents*, 1, 4, 5, 6, 9, 10, 11, 15, 18, 19, 20, 21; *Continuation of Applications*, 1; *Delay in Filing Applications for Reissue*; *Designs*; *Disclaimers*; *Divisional Applications*, 3; *Double Patenting*, 2, 8; *Interference*, 1, 3, 4, 7, 8, 9, 11, 12, 13, 24; *Invention*, 7, 8, 9, 12, 13, 19; *Jurisdiction of the Commissioner of Patents*; *Jurisdiction of the Court of Appeals of the District of Columbia*; *Particular Patents*, 2, 3, 4, 6, 9, 11, 12, 14, 22, 23, 24, 29, 31, 34, 36, 37, 40, 42, 44, 45, 47, 51, 52; *Priority of Invention*, 8, 11, 12; *Suits for Infringement*, 9; *Terminology*.

1. **LIMITATION.**—Where a claim defines an element in terms of its form, material, location, or function, thereby apparently creating an express limitation, and the limitation pertains to the inventive step rather than to its environment and imports a substantial function which the patentee considered of importance, forms excluded can not be considered covered by the patent under the doctrine of equivalency. ***d* *D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.*, 246.**
2. **MEASURE OF INVENTION.**—A patent is sustained not for what the inventor may have done, in effect, but for what is pointed out clearly and distinctly in his claims. As much as is not so claimed belongs to the public. ***d* *Knight Soda Fountain Co. v. Walrus Mfg. Co.*, 254.**
3. **SAME.**—A patent claim may be limited by reference to the specifications. ***d* *Blisght Co. et al. v. Onepiece Bifocal Lens Co.*, 257.**
4. **PRACTICE—PRESENTED ON APPEAL INDEFINITE.**—Where on appeal to the Commissioner it is found that the appealed claims are so indefinite that it is impossible to determine what they cover, the application will be

CLAIMS—Continued.

remanded to the Primary Examiner for immediate action, indicating the objections thereto. *Ex parte Schneider*, 25.

5. **DUPLICATE OR REDUNDANT.**—Where an applicant defines the same invention in numerous ways, he not only fails to secure his invention, but he fails to comply with the provision of the law that "he shall particularly point out and distinctly claim the part, improvement * * * which is his invention," and the claims are therefore indefinite. If an applicant writes two claims which define the same invention, then by that very fact he fails to point out his invention. *Ex parte Duncan*, 36.

6. **REJECTION FOR DUPLICATION.**—Duplication of claims invariably leads to indefiniteness, and an entire set of claims should be rejected as indistinct whenever by reason of duplication it is made uncertain what the invention is. The different claims must be on their face obviously different in substance. *Id.*

7. **INDEFINITENESS.**—Claims which are confused by reciting numerous unnecessary limitations and using indefinite terms, making things appear of essence which are not of essence, are indefinite. *Id.*

8. **DISTINCTIONS.**—Where an applicant presents a multiplicity of claims to define a simple invention and many are substantial duplicates of others, it is applicant's duty rather than that of the Examiner to point out how each claim patentably differs from every other one. *Id.*

9. **REJECTION FOR INDEFINITENESS AND REDUNDANCY.**—The statute requires an applicant to so formulate his claims that the experts of the Patent Office may understand definitely what they mean, and the invention must be so distinctly described as to be understood by one ordinarily skilled in the art to which the invention belongs, and where a multiplicity of claims was presented on a simple invention, some of which were inherently indefinite, all of the claims were properly rejected for failure to point out the invention, as required by the law. * *In re Duncan*, 197.

10. **ACQUIESCENCE IN REJECTION—IMMATERIAL UNLESS CLAIM ISSUED INCLUDES DEFENDANT'S DEVICE.**—Under usual conditions acquiescence in the rejection of a claim by the Patent Office is of no importance unless the court is called on to determine whether the claim as issued has a scope sufficiently broad to include defendant's somewhat variant device. *Jennison-Wright Co. v. Hempy*, 444.

CLASS OF MERCHANDISE. See *Trade-Marks* 7, 31, 41, 47.

COMBINATION. See *Construction of Specifications and Patents*, 6, 18, 21; *Double Patenting*, 2; *Equivalents*, 2; *Invention*, 14, 19; *Particular Patents*, 7, 37.

COMMERCIAL SUCCESS. See *Abandoned Experiments*, 1; *Construction of Specifications and Patents*, 3; *Infringement*, 4; *Interference*, 6; *Reduction to Practice*, 9.

COMMISSIONER OF PATENTS. See *Amendment of Claims; appeal to the Court of Appeals of the District of Columbia*, 2; *Construction of Statutes*, 1; *Discretion of the Commissioner of Patents; Interference*, 7, 11, 12; *Jurisdiction of the Commissioner of Patents. Jurisdiction of the Court of Appeals of the District of Columbia; Suits under Section 4015, Revised Statutes*, 2; *Trade-Marks*, 8, 14, 21, 24, 35.

COMMON LAW. See *Trade-Marks*, 12.

COMPOSITE TRADE-MARKS. See *Trade-Marks*, 33, 34, 37.

CONCEPTION OF INVENTION. See *Amendment to Preliminary Statement*, 1; *Diligence; Earlier and Later Patents; Interference*, 6; *Invention*, 28; *Priority of Invention*, 2, 5, 7, 14, 15, 19, 20; *Suits for Infringement*, 7.

CONCURRENT DECISIONS OF THE TRIBUNALS OF THE PATENT OFFICE. See *Court of Appeals of the District of Columbia; Interference*, 12.

INTERFERENCE—ERROR.—Where the line which separates the respective contentions of the parties to an interference is quite attenuated and not easily perceived and the just consideration of the case calls for expert knowledge, the concurring decisions of the Patent Office tribunals will not be disturbed by the court except where error very clearly appears. * *Blaine v. White*, 222.

CONFLICTING DECISIONS. See *Certiorari*, 3.

CONFUSION OF THE PUBLIC. See *Trade-Marks*, 18, 19, 40, 47, 54.

CONSTRUCTION OF CLAIMS. See *Claims*, 1, 3, 7, 9, 10; *Designs; Double Patenting*, 2; *Interference*, 3, 4, 9, 11, 12, 13; *Invention; Particular Patents*, 6, 9, 10, 11, 12, 21, 22, 23, 24, 29, 36, 37, 40, 44, 45, 47, 51, 52; *Priority of Invention*, 8, 11.

1. LANGUAGE CONSTRUED IN THE LIGHT OF THE SPECIFICATION.—Where the language of a claim includes elements described in general terms, the court may look to the specification for the purpose of construing the language and ascertaining its meaning. "Concave" and "convex" may be used in a restricted and technical sense or may be used loosely. In view of the specification in this case *Held* that they refer to surfaces which are spherical throughout their areas. *I. T. S. Rubber Co. v. Panther Rubber Mfg. Co.*, 283.

2. ISSUE—CONSTRUED IN LIGHT OF SPECIFICATION WHERE FIRST MADE.—"While * * * a party will not be permitted to narrow his claims to suit the exigencies of a given situation, it is equally well settled that the meaning given to the counts of an interference must be that disclosed in the specification of the party first to make the claim. (*Funk v. Whitely*, C. D., 1905, 670; 25 App. D. C., 313; *Podlesak v. McInnerney*, C. D., 1906, 558; 120 O. G., 2127; 26 App. D. C., 399; *Viele v. Cummings*, C. D., 1908, 362; 134 O. G., 777; 30 App. D. C., 455.)" * *Seymour v. Molyneux*, 133.

3. INVENTION—DUPLICATION OF PARTS.—Claims for a locomotive stoker covering mechanism for transferring coal from a tender to a locomotive having a plurality of devices for independently elevating the coal from the transfer mechanism to the fire-box of the locomotive *Held* unpatentable as involving only a duplication of the conveyers of the prior art. * *In re Lower*, 149.

4. INTERFERENCE—ISSUE CONSTRUED.—Counts of an interference issue must be given the broadest interpretation they reasonably will support and in the light of the specification where they originated, and this rule is not varied by the fact that the applicant in whose application the claims originated dropped out of the interference after the decision of the Examiner of Interferences. * *Cox v. Headley and Thompson*, 183.

5. PRIORITY AWARDED—SUBSEQUENT AMENDMENT.—A count of the interference *Held* indefinite in language, but construed to have a certain meaning. Priority thereon awarded to K., but the Primary Examiner directed to require, after the final adjudication, that such claim be made more definite. *Reid, Reid, and Kelley v. Kittelman*, 29.

6. AGGREGATION—RECORD-TAPE.—Claims for a record-tape for guidance in running a train provided with a standard-speed line and a maximum-

CONSTRUCTION OF CLAIMS—Continued.

allowable-speed line and perforations *Held* not objectionable as aggregations, as they enable the engineer to so regulate his speed as to keep an indicator between the two lines and so indicate at a glance that his instant speed is between the normal and maximum. *Ex parte Duncan*, 36.

7. SAME—DIFFERENT REGISTERS MOUNTED IN THE SAME CASING.—Two manually-operated registers adapted to keep a record of the quantity of gas and oil used in an automobile, mounted in the same casing with the ordinary speedometer and odometer, constitute but an aggregation of features, the registers being independent units. * *In re Smithey*, 198.
8. INVENTION—PROCESS OF ROASTING ORES.—Claims for a process of roasting ores which distinguish from the prior art only in stating that the material is exposed in a confined space to heat arising from the combustion of unrefined gas as distinguished from heat otherwise applied disclosed in the prior art are devoid of invention. *Ex parte Foss*, 61.
9. MISDESCRIPTIVE CLAIMS REFUSED.—In an application disclosing a process of roasting ores in which the crushed ore is passed through a confined space and subjected to the heat of a flame of gas, claims which specify that the material is exposed to the "heat arising from a heated body in said space" declared to be intended to refer to the fact that the walls of the rotary drier are heated, *Held* to be objectionable in form and not allowable, since the walls of the driers cannot be said to be a heated body in the drier. *Id.*
10. DUPLICATION—OMISSION OF FEATURE WHICH MUST BE IMPLIED.—Claims of an application for an explosive mixture which differ only in that one omits a statement in the other that the mixture is stabilized are duplicates, since stabilization must be implied in the claim omitting it or the claim must be considered to cover a useless thing. *Ex parte Comey*, 65.

CONSTRUCTION OF SPECIFICATIONS AND PATENTS. See *Invention*, 3, 8, 9, 10, 11, 14, 26, 27, 28; *Particular Patents*.

1. DESCRIPTION—SUFFICIENCY.—Though the patentee did not anticipate the use to which the patented article could be and was put, he is entitled to protection for such use where the adaptability was inherent in the structure shown and described in claims and specifications. *D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.*, 248.
2. INSTRUCTION—LIMITATIONS.—The Marshall patent, No. 685,160, for a mattress comprising a cover and a plurality of transversely-extending strips of material stitched at intervals to form pockets, the pocket of one strip alternating with those of adjacent strip, and spiral springs arranged in such pockets, *Held* limited therein to that form of arrangement and not to be infringed by a mattress similarly constructed where the pockets were arranged with centers equidistant in right-angled directions, so that there was no nesting of the springs. *Id.*
3. PRESUMPTION OF INVENTIVE NOVELTY FROM USE—ATTRIBUTION TO PRODUCT.—Though brick of a certain type, which have gone on the market and had a large sale, are the product of the patentee's patented machine, which has been manufactured by him and sold to brickmakers, such credit and such presumption of inventive novelty as arise from public use should be given to the product—the bricks—and not to the machine. *Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.*, 259.

CONSTRUCTION OF SPECIFICATIONS AND PATENTS—Continued.

4. SAME INVENTION—NEW CLAIMS ADDED—ADDITION TO DESCRIPTION AND SLIGHT CHANGES IN DRAWINGS.—The Tufford reissue patent, No. 14,049, *Held* to be for the same invention as the original patent, since the features specified in the new claims were all set out with reasonable clearness in the original specification, and the changes made in the drawing are slight and immaterial, and the additions to the specification merely bring out the idea disclosed in the original patent with greater clearness, and certain statements in the reissue application, while not strictly correct, were approximately so, and the departure from the exact truth being without any material importance. *4 Fetzcr & Spies Leather Co. v. I. T. S. Rubber Co.*, 274.
5. CLAIM OMITTING REFERENCE TO ESSENTIAL ELEMENT.—Claim 10 of the Rodman patent, No. 1,076,453, for "the method of adapting finely divided material for dry packing for use as carbonizing material, which consists in mixing the material with a binding agent and separating the resulting mass into relatively small masses of appreciable size," which omits the element whereby the product will retain its identity under heat, found in the other claims, *Held* void, as being incomplete and vague. *4 Rodman Chemical Co. v. Deeds Commercial Laboratories*, 202.
6. BONE—No. 705,732—RETAINING-WALL—NOT INFRINGED.—Patent No. 705,732, (claims 1, 3, 5, 16, and 17,) to Frank A. Bone, for the combination, with a retaining-wall having a heel, of a metal structure embedded vertically in the wall and obliquely in the heel, so that the weight of the retained material upon the heel of the metal structure will operate to retain the wall in vertical position, or of such a structure having also a toe opposite to the heel, was anticipated in its broad aspects by other patents and publications as to its specific form. *Held* not infringed. *** Bone v. Commissioners of Marion County*, 457.
7. ANTICIPATION—PRIOR UNSUCCESSFUL DEVICE NOT AN ANTICIPATION.—Patents for a machine and process for drawing glass for windows mechanically are not anticipated by patents for earlier and abortive devices and methods where the patents in suit were the first that were successful, and such patents must be given a broad and liberal construction, the inventors being pioneers in the art. *4 Consolidated Window Glass Co. v. Window Glass Mach. Co. et al.*, 313.
8. MECHANICAL DRAWING OF GLASS—PATENT VALID AND INFRINGED.—The Lubbers divisional patent, No. 702,015, which showed the use, in connection with his shield in the forehearth, of floating rings, all of which apparatus was used for the mechanical drawing of glass, *Held* valid and infringed. *4 Id.*
9. EVIDENCE OF INVENTION—SIMPLICITY OF DEVICE.—The Lubbers patent, No. 886,618, for an air-vent hole in an apparatus for mechanically drawing glass, claims 20, 21, 23, 24, and 26 *Held* to involve an invention of a high order. "The simplicity of the use of an open vent which simplicity is cited as evidence of lack of invention, to our minds shows the high order of novelty and invention, in thus making use of a simple opening, instead of complicated mechanical appliances, in order to accomplish a really remarkable result." *4 Id.*
10. ANTICIPATION—METHOD OF BLOWING GLASS BY MECHANICAL MEANS NOT ANTICIPATED BY HAND-BLOWING METHODS.—Claim 5 of the Lubbers patent, No. 702,014, for a method of forming hollow glass articles, *Held*

CONSTRUCTION OF SPECIFICATIONS AND PATENTS—Continued.

to be physically and functionally different from the hand-blowing method of the prior art, in which the hand-blower took advantage of a swinging motion imparted to the article and of gravity, while according to the method of the claim an increased air-supply was relied upon. *Id.*

11. IMPROVEMENT OF APPARATUS FOR DRAWING GLASS—VALID AND INFRINGED.—The Lubbers patent, No. 886,618, for an air-vent hole in the apparatus for mechanically drawing glass, the application for which was filed May 21, 1908, and which was granted May 5, 1908, after the patentee, at the suggestion of the Patent Office, later made a divisional application of that patent, applying for Patent No. 1,020,920, and filing nearly three years later additional claims for his original patent, *Held* valid, it appearing that the whole art was in a state of flux and experiment and it being impossible to say with definiteness that Lubbers had satisfactorily worked out the open-vent solution more than two years in advance of his application. *Id.*
12. PIONEER PATENTEE CANNOT PROLONG MONOPOLY BY PATENTING ONE FEATURE OF THE DEVICE.—Where an inventor of an automatically-collapsible revolving door was granted a pioneer patent and insisted upon and obtained a construction so broad that any form of double-acting hinge or of a releasing device was an infringement, he could not prolong his patent monopoly by subsequently obtaining a patent for some one form of double-acting hinge or self-releasing or collapsible device. *b Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 99.
13. INVENTION—ADAPTATION OF IMPROVEMENT IN CHILD'S WAIST TO INFANT'S BAND.—The adaptation of the inelastic reinforcing-tape with tabs of a child's knitted waist, to which buttons are sewed for the purpose of supporting lower garments, to an infant's band designed to support the napkin, the lower garment appropriate to the infant, *Held* devoid of invention. The Owenshire patent, No. 800,237, *Held* void. *c Minneapolis Knitting Works v. Marshall Field & Co.*, 360.
14. PATENTABILITY—USE IN NEW DEVICE OF CONSTRUCTION PREVIOUSLY USED IN REPAIR JOBS.—Where in the use of steel cars having longitudinal sills it was found that the sill was often broken between the end of the car and the body-bolster by reason of collision or buffing and it was the practice to repair such breaks by removing the end of the sill beyond the break and splicing an end section to the main body of the sill, claims of the Bellows patent, No. 693,218, covering a car provided with a sill with a sectional end spliced to the body at a point between the body-bolster and the end, *Held* invalid because devoid of invention, as it involves only the idea of using for new cars a construction theretofore used in repair jobs. (*National Harrow Co. v. Quick*, C. 1896, 501; 78 O. G., 1574; 74 Fed. Rep., 236.) *d Bellows and Slack v. New York Central Railroad Company; Same v. Pressed Steel Car Company*, 362.
15. CONSTRUCTION—"ADJUSTABLE."—The Callahan patent, No. 948,719, for an apparatus for elevating and distributing wet concrete to the floors of buildings under construction, claim 5, the phrase "said boom being adjustably connected with the tower and adapted to be arranged at various points in the height thereof" construed in accordance with the apparent intention of the draftsman to refer to the vertical change of the boom on the tower, which was effected by tak-

CONSTRUCTION OF SPECIFICATIONS AND PATENTS—Continued.

ing out bolts and bolting it again to a new position, although such is not adjustability in the most precise definition. *Concrete Appliances Co. et al. v. Meinken et al.*, 878.

16. INVENTION—ANALOGOUS USE—VACUUM SUCTION DEVICE FOR AUTOMOBILES ANTICIPATED BY WATER-LIFTING DEVICES.—The Higginson and Arundel patent, No. 1,067,814, and the Jay patents, Nos. 1,132,273 and 1,134,457, for vacuum suction devices for raising gasoline in an automobile from a main tank below the level of the carburetor to a secondary tank, *Held* anticipated by prior devices for lifting water from a lower to a higher level, which is not an analogous but the same art. *Jay et al. v. Weinberg et al.*, 402.
17. INVENTION—SLIGHT CHANGES.—A frame for a rewirable screen construction, (Watson patent, No. 836,475,) each side and end being constructed from a metal sheet having an edge bent around in the form of a tube rectangular in cross-section, the free edges being brought against a flat portion of the metal and welded or brazed thereto, *Held* devoid of invention over a prior structure of a similar nature, except that the free edge did not quite contact with the flat metal part, as it did not involve invention to extend the edge a little to make a complete tube and secure the parts together by brazing or welding, even though a structure of greater rigidity was produced. *Higgin Mfg. Co. v. Watson et al.*, 403.
18. CLAIM TO COMBINATION LIMITED.—The Dickinson patent, No. 831,501, for a candy-pulling machine, claim 1 for "a candy-pulling machine comprising a plurality of oppositely disposed candy hooks or supports, a candy-puller and means for producing a specified relative in-and-out motion of these parts for the purpose set forth," *Held* limited to the in-and-out motion described in the specification (as a claim cannot cover a mode of operation) and not infringed by the device of the Langer patent, No. 1,232,697, although it has means for producing a relative in-and-out motion. *Mastoras v. Hildreth*, 414.
19. AUTOMOBILE-RADIATOR MADE OF "CONTINUOUS STRIP."—The Brinkman patent, No. 843,864, for a cooler or radiator for motor-cars, claims of which specify the refrigerator-section as constructed of a "continuous strip of metal," the specification stating how it may be bent upon itself, *Held* not restricted to the literal terms employed, but to cover a radiator made up of a plurality of separate sections. *Whitlock Coil Pipe Co. v. Mayo Radiator Co.*, 447.
20. "CONTINUOUS STRIP" MAY CONSIST OF SEPARATE STRIPS SOLDERED TOGETHER.—In the Brinkman patent, No. 843,864, for a radiator for motor-cars, in a claim for a "continuous strip" of metal, "continuous" should be taken in a mechanical sense, and two pieces of metal contiguously placed and soldered together may be considered as a continuous strip when together they function like one strip. *Id.*
21. VALIDITY OF REISSUE—FOUR-GANG DISK HARROW.—The Niesz reissue patent, No. 13,163, for a four-gang disk harrow consisting of a set of inthrow-disks connected by a flexible reach-bar behind a set of outthrow-disks, so that the whole harrow may be turned without tearing up the earth, *Held* to cover a new and patentable combination, although inthrow and outthrow disk machines were old, four-gang plows were old, and cultivators of other types had been previously arranged in tandem fashion and connected by a flexible reach-bar, the

CONSTRUCTION OF SPECIFICATIONS AND PATENTS—Continued.

combination of the flexible reach-bar with the other elements being novel and possessing utility. ^d*Ohio Rake Co. v. Bucher & Gibbs Plow Co.*, 451.

CONSTRUCTION OF STATUTES. See *Abandonment of Applications*, 2; *Anticipation* 3; *Estoppel*; *Final Fees*; *Patentability*, 2; *Particular Patents*, 35; *Suits under section 4915, Revised Statutes*.

1. **PATENTS—STATUTES—ACT OF MARCH 3, 1883, CONSTRUED.**—When a patent issues under the provisions of the act of March 3, 1883, (22 Stat., 603,) authorizing the Secretary of the Interior and the Commissioner of Patents to grant patents without the payment of any fee to officers of the Government, except officers and employees of the Patent Office, no dedication to the public results, but any person in the United States, including governmental officers and employees, may use the invention disclosed in the patent without the payment of royalty, provided the use be in the prosecution of work for the Federal Government. [†]*Opinion of the Attorney-General*, 92.
2. **NECESSITY OF CLEARLY DISCLOSING INVENTION.**—Revised Statutes, section 4888 (Comp. St., sec. 9432), and the purpose of the patent laws require a full disclosure of the invention before the patent is granted in order that the public may, at the expiration of the patent, have full use of the invention. ^d*Rohm et al. v. Martin Dennis Co.*, 349.
3. **SECTION 4920, REVISED STATUTES—"SURREPTITIOUSLY OR UNJUSTLY."**—As far back as *Reed v. Cutter* (Fed. Cas., 11,645; 1 Story, 590) it was pointed out that the words of section 4920, Revised Statutes, "surreptitiously or unjustly" did not mean fraudulently, but related to a case where it appeared that another had conceived the invention prior to the patentee and while the last to reduce the invention to practice was diligent in so doing. *Nash v. Reeder v. Ryan*, 72.
4. **ANTICIPATIONS—FOREIGN PATENTS.**—Under Revised Statutes, section 4886, as amended (Comp. St., sec. 9430), foreign patents to be available to defeat a United States patent for the same invention must have become patents or printed publications in foreign countries before the date of the United States invention, or more than two years before the application for the United States patent was filed. ^b*Barber v. Otis Motor Sales Co.*, 106.

CONSTRUCTION OF TRADE-MARK STATUTES. See *Trade-Marks*, 12, 22, 23, 24, 25, 27, 30, 31, 32, 33, 35, 39, 45, 46, 47, 48.**CONTINUATION OF APPLICATIONS.**

1. **CONTINUING—DEFINED.**—A continuing application is one filed subsequently to another, while the prior application is pending, disclosing all or a substantial part of the subject matter of the prior application and containing claims to subject matter common to both applications, both being filed by the same inventor or his legal representative. *Ex parte Hall*, 56.
2. **SUBSTITUTE APPLICATION FILED AFTER ABANDONMENT OF ORIGINAL.**—Where H. filed an application which was allowed, forfeited, renewed, and again allowed and where after the time within which a second renewal could have been filed he filed a second application for the same subject matter, *Held* that the second application could not be regarded as a continuation of the first. *Id.*

COPENDING APPLICATIONS.

EARLIER AND LATER PATENTS.—The rule that where two patents are granted on copending applications of the same inventor, neither of which claims any invention claimed in the other, the one later granted, but earlier applied for, can not, in determining invention, be considered prior art as against the later-applied-for but earlier-issued patent, is not changed by the fact that the later application purports to cover an improvement on the invention embraced in the earlier application. *Higgin Mfg. Co. v. Watson et al.*, 404.

COPYING CLAIMS. See *Divisional Applications*, 1; *Estoppel*, 1.

COPYRIGHTS. See *Certiorari*, 3; *Suits for Infringement*, 4.

CORPORATIONS. See *Infringement*, 1, 6; *Suits for Infringement*, 1, 5, 8; *Trade-Marks*, 55.

COURT OF APPEALS OF THE DISTRICT OF COLUMBIA. See *Appeal to the Court of Appeals of the District of Columbia*; *Estoppel*; *Priority of Invention*, 11; *Suits under Section 4915, Revised Statutes*.

1. **INTERFERENCE—PRIORITY.**—Where the tribunals of the Patent Office concur with respect to the proper solution of a question of fact, the Court of Appeals of the District of Columbia will not disturb their action if there is competent evidence to sustain it. * *Kennicott v. Caps*, 120.

2. **SAME—QUESTION OF FACT INVOLVED—CONCURRENCE OF TRIBUNALS OF PATENT OFFICE.**—Where the question between two contestants in an interference proceeding is one of originality and the three tribunals of the Patent Office concur on this question of fact, the court of appeals will follow the prior decisions unless they be manifestly wrong. * *Hopkins v. Riegger*, 126.

DAMAGES AND PROFITS. See *Infringement*, 1, 7; *Laches*; *Trade-Marks*, 19.

DATE OF CONCEPTION OF INVENTION. See *Amendment to Preliminary Statement*; *Anticipation*, 5; *Construction of Statutes*, 4; *Suits for Infringement*, 7.

DATE OF ENROLLMENT OF FOREIGN PATENTS. See *Anticipation*, 3, 4, 5; *Construction of Statutes*, 4.

DATE OF FILING APPLICATIONS. See *Anticipation*, 5; *Construction of Statutes*, 4; *Diligence, Divisional Applications*, 2; *Earlier and Later Patents*; *Joint Applications, One Applicant Not Inventor*, 1; *Priority of Invention*, 3, 7; *Reduction to Practice*; *Renewal of Forfeited Applications*; *Suits for Infringement*, 7.

DECISIONS OF THE COMMISSIONER OF PATENTS. See *Appeal to the Court of Appeals of the District of Columbia*, 2; *Discretion of the Commissioner of Patents*; *Interference*, 7, 11, 12; *Priority of Invention*, 10, 12, 13, 16.

DECISIONS OF THE EXAMINERS-IN-CHIEF. See *Interference*, 17; *Priority of Invention*, 11.

DECISIONS OF THE EXAMINER OF INTERFERENCES. See *Construction of Claims*, 4; *Reduction to Practice*, 1.

DECREE OF COURTS. See *Certiorari*, 1; *Disclaimers*; *Suits for Infringement*, 4.

DEDICATED TO THE PUBLIC. See *Construction of Statutes*, 1.

DELAY IN BRINGING SUITS FOR INFRINGEMENT. See *Suits for Infringement*, 3.

DELAY IN FILING APPLICATIONS. See *Abandonment of Invention*, 1, 2; *Interference*, 6; *Priority of Invention*, 7, 14; *Renewal of Forfeited Applications*.

DELAY IN FILING APPLICATIONS FOR REISSUE. See *Reissues*.

1. **BROADENED CLAIMS—UNREASONABLE DELAY.**—Broadened claims in a reissue application *Held* properly refused where the application was filed two years and eight months after the issuance of the patent and the only explanation given by the patentee was that he had no occasion to review the patent from its date of issue until shortly before the application for reissue was filed and that the insufficiencies of the original specification and claims came to his attention through others and that he did not delay after he had knowledge of those insufficiencies. *Ex parte Schneider*, 9.
2. **SAME—SAME.**—A delay of two years and eight months in filing an application for reissue to secure broader protection *Held* to be unreasonable where applicant's only excuse is "that he had no occasion to review his patent from the date of its issue until the present time, and that the insufficiencies in his original specifications and claims only came to his attention through others." *In re Schneider*, 121.
3. **SAME—SAME—EVIDENCE OF ABANDONMENT.**—A lapse of more than two years in the filing of an application for reissue to secure broader claims applies not only to the *prima facie* presumption of intervening rights, but it is evidence of abandonment. ** Id.*
4. **SAME—SAME—FAILURE TO SECURE ADEQUATE PROTECTION—INVENTOR BOUND BY ACTS OF SOLICITORS.**—An unreasonable delay in the filing of a reissue application which seeks to broaden the claims can not be excused on the ground that the failure to secure adequate protection was due to the fault of the solicitors. They were the agents of the inventor, and he is bound by their acts. ** Id.*

DELAY IN FILING EVIDENCE. See *Suits for Infringement*, 2.DELAY IN PROSECUTION OF APPLICATIONS. See *Abandonment of Applications*, 1; *Abandoned Experiments*, 2, 3, 4; *Priority of Invention*, 14.DESCRIPTION. See *Anticipation*, 2; *Construction of Specifications and Patents*, 1, 2, 4, 18; *Interference*, 14; *Particular Patents*, 1; *Suits for Infringement*, 7.DESCRIPTIVE TERMS. See *Trade-Marks* 3, 4, 8, 9, 15, 23, 28, 29, 30, 33, 34, 36, 37.DESCRIPTIVE MARKS. See *Trade-Marks*, 3, 22, 23, 24, 25, 27, 42, 43, 44.DESIGNS. See *Infringement*, 9, 10; *Particular Patents*, 30, 38, 49; *Trade-Marks*, 46.

ENTITLED TO EQUIVALENTS RESPECTING NON-ESSENTIAL DETAILS.—A design patent for a doll entitles the holder to the usual range of equivalents with respect to known prior unessential details, and though the patent drawings show a doll with a cap the figure shown is included within the claim of the patent, whether the doll is provided with painted hair, real hair, bathing-cap, or military or naval cap or any other standard form of head-dress. *4 Geo. Borgfeldt & Co. et al. v. Weiss*, 389.

DILIGENCE. See *Abandonment of Applications*, 2; *Construction of Statutes*, 3; *Priority of Invention*, 5, 7, 14, 17, 18, 20; *Public-Use Proceedings*, 1.

1. **INTERFERENCE.**—The diligence required of one first to conceive and last to reduce to practice need not be extraordinary. "It needs to be only reasonable under the circumstances of the case, nor does it 'involve uninterrupted effort nor the concentration' of all the applicant's energies upon the single enterprise." ** Dickinson v. Swinehart*, 151.
2. **SAME.**—D. conceived the invention in August, 1912, disclosed it in November, 1912, and immediately after the disclosure caused a draftsman to

DILIGENCE—Continued.

commence work on drawings for a machine. D. was obliged to be away from his home for a considerable period from March, 1913, to February, 1914, but during this time draftsmen were working on drawings under his directions, and a model apparatus for producing the process of the invention was completed in June, 1914. D.'s application was filed on February 26, 1915. S. alleges conception and disclosure in February, 1913, and filed his application on December 16, 1914. *Held* that D. was not lacking in diligence. * *Id.*

DISCLAIMERS. See *Trade-Marks*, 35, 37, 42, 43.

TIME FOR FILING AFTER DECISION OF APPELLATE COURT.—Decree of the district court holding claims of the Watson patent, No. 836,475, valid and infringed reversed as to claims 1 and 2 and an injunction and accounting granted as to claim 3, conditioned upon abandonment of the claims found to be invalid; plaintiffs given thirty days after filing of the mandate below or such further time as the district court may allow, in which to show that claims 1 and 2 have been abandoned. (*Herman v. Youngstown*, 191 Fed. Rep., 579.) * *Higgin Mfg. Co. v. Watson et al.*, 403.

DISCLOSURE OF INVENTION. See *Amendment to Preliminary Statement*, 1; *Amendments*; *Anticipation*, 1; *Claims*, 2, 4, 5, 8, 9; *Construction of Claims*, 1, 2, 8, 9, 10; *Construction of Specifications and Patents*, 1, 4; *Construction of Statutes*, 1, 2; *Continuation of Applications*, 1; *Diligence*, 2; *Divisional Applications*, 1, 2; *Invention*, 1; *Interference*, 9, 15, 17, 19; *Particular Patents*, 1, 5, 29, 35, 41, 43; *Priority of Invention*, 8; *Reduction to Practice*, 3, 8; *Suits for Infringement*, 9.

1. **INTERFERENCE—SUFFICIENCY OF TO OTHERS.**—Where the specification of an application does not describe all the parts of a complete machine, but refers to an earlier application, and the disclosures taken together are sufficient to enable one skilled in the art to construct a complete machine, *Held* that the objection that the specification of the later application is insufficient is not sustained. *Kittelman v. Reid, Reid, and Kelley*, 26.

2. **PATENTS—VALIDITY.**—A correct and adequate description or disclosure of a claimed discovery (which in the case of a machine involves particularly the operation of it) is essential to the validity of a patent, for the reason that such a disclosure is necessary in order to give the public the benefit of the invention after the patent shall expire. ** *Beidler v. The United States*, 483.

DISCRETION OF THE COMMISSIONER OF PATENTS.

APPEAL—REVIEW BY COURT OF APPEALS—QUESTIONS DISCRETIONARY WITH COMMISSIONER.—Where a motion brought before the Commissioner of Patents is directed to his discretion, his decision thereon must be sustained unless there was an abuse of discretion. * *In re Dement*, 170.

DISCRETION OF THE COURT. See *Appeal to the Circuit Courts of Appeal*, 2; *Suits for Infringement*, 6.

DISMISSAL OF BILL. See *Appeal to the Circuit Courts of Appeal*, 1.

DISSOLUTION OF INTERFERENCE. See *Interference*, 7.

DIVISIONAL APPLICATIONS. See *Construction of Specifications and Patents*, 8, 11; *Double Patenting*, 2; *Estoppel*, 1; *Priority of Invention*, 3.

1. **COPYING CLAIMS OF PATENT.**—An applicant who has pending in the Patent Office an application disclosing but not claiming an invention claimed in a patent granted on an application filed during such pen-

DIVISIONAL APPLICATIONS—Continued.

dency is within his rights in filing a divisional application for such invention within two years after the granting of said patent and copying claims therefrom for the purpose of interference. ** *Chapman and Chapman v. Wintroath*, 465.

2. ENTITLED TO BENEFIT OF DATE OF ORIGINAL APPLICATION DISCLOSING THE INVENTION.—Divisional applications have not been dealt with "in a hostile spirit by the courts, but, on the contrary, designed as they are to secure the patent to the first discoverer, they have been favored to the extent that where an invention clearly disclosed in an application, as in this case, is not claimed therein but is subsequently claimed in another application, the original will be deemed a constructive reduction of the invention to practice and the later one will be given the filing date of the earlier, with all of its priority of right. (*Smith & Griggs Manufacturing Co. v. Sprague*, C. D. 1887, 616; 41 O. G., 1087; 123 U. S., 249; *Von Recklinghausen v. Dempster*, C. D. 1910, 365; 154 O. G., 252; 34 D. C. App., 474.)" ** *Id.*
3. CLAIMS WHICH ARE NOT PATENTABLY DIFFERENT.—An Examiner should not require division between two groups of claims which he regards as not patentably different without indicating his opinion in the matter; but the issuance of a patent on matter required to be divided out affords no basis for waiving consideration of patentable identity between the claims of the patent and any claims remaining in the parent case, even though the Examiner failed to state his opinion, as the Office has no authority to grant two patents to the same inventor for the same indivisible invention. *Ex parte Wigginton*, 87.

DOUBLE PATENTING. See *Amendment of Claims*; *Divisional Applications*, 3.

1. PATENTS—PROCESS AND PRODUCT.—A patent for a commutator comprising metal commutator-bars and a body of heat-hardened resinous condensation product holding said bars in place is not a bar to the allowance to the same inventor of a patent for the process of producing the article, involving the conception of softening the moldable material, positioning the bars radially and longitudinally, and forming a complete insulating-body simultaneously under heat and pressure, which was foreign to the processes of the prior art. * *In re Zenk*, 215.
2. CLAIMS BARRED BY PATENT GRANTED ON DIVISIONAL APPLICATION.—Claims for the combination of a loose-sheet holder and the sheets held thereby which do not in any way specify the character of the sheets or how they coact with the holder, *Held* unpatentable in view of a patent granted on a divisional application for the holder alone (citing *Underwood v. Gerber*, C. D., 1898, 340; 63 O. G., 1068; 149 U. S., 224). *Ex parte Wigginton*, 87.
3. QUESTION RAISED NOT ONE OF PRIORITY.—The question whether claims in an application are patentable over a patent granted to the same inventor does not involve priority of invention, but patentable identity of the subject-matter claimed. *Id.*

DOUBTS. See *Interference*, 6; *Trade-Marks*, 20.

DRAWINGS. See *Abandonment of Applications*, 1; *Amendments to Drawings*; *Anticipation*, 4, 5; *Construction of Specifications and Patents*, 4; *Designs*; *Diligence*, 2; *Trade-Marks*, 35.

DUPLICATION OF CLAIMS. See *Claims*, 5, 6, 7; *Construction of Claims*, 3, 10.

DUTY OF APPLICANTS. See *Claims*, 8.

EARLIER AND LATER APPLICATIONS. See *Divisional Applications*, 1, 2; *Disclosure of Invention*, 1; *Interference*, 7; *Priority of Invention*, 3, 4; *Validity of Patents*, 2.

EARLIER AND LATER PATENTS. See *Copending Applications, Infringements*, 2; *Invention*, 26; *Particular Patents*, 44.

PRIOR ART.—A patent actually issued before plaintiff's patent was applied for was a part of the prior art as to plaintiff, though plaintiff carried his invention back of the issue date of the earlier patent but subsequent to the filing date thereof. *Higgin Mfg. Co. v. Watson et al.*, 403.

ELEMENTS. See *Claims*, 1; *Construction of Specifications and Patents*, 5; *Invention*, 19.

EMPLOYEE OF THE GOVERNMENT. See *Construction of Statutes*, 1.

ENGLISH LANGUAGE. See *Specifications*.

EQUITY JURISDICTION. See *Suits Under Section 4915, Revised Statutes*.

EQUITY RULES. See *Appeal to the Circuit Courts of Appeal*, 2; *Expert Testimony*, 1.

EQUIVALENTS. See *Claims*, 1; *Designs; Invention*, 15; *Particular Patents*, 5, 29, 31, 42; *Terminology*.

1. **SPOT-WELDING AND RIVETING—BRAZING.**—Spot-welding and riveting are each the equivalent of brazing. *Higgin Mfg. Co. v. Watson et al.*, 403.

2. **RANGE—INFRINGEMENT.**—Protection against the use of mechanical equivalents in a combination is governed by the same rules as in case of other patents, and where a combination patent marks a distinct advance in the art the term "mechanical equivalent" should have a reasonably broad and generous interpretation. *Smith Cannery Machines Co. v. Seattle-Astoria Iron Works et al.*, 296.

ERRORS. See *Amendment to Preliminary Statement; Affidavits under Rule 75; Certiorari; Concurrent Decisions of the Tribunals of the Patent Office; Certiorari*, 1; *Interference*, 17; *Suits for Infringement*, 6; *Trade-Marks*, 8, 13, 14, 53; *Validity of Patents*, 8.

ESTOPPEL. See *Infringement*, 3, 7; *Interference*, 7, 8; *Licenses*.

1. **COPYING CLAIMS OF A PATENT.**—The time for filing a divisional application for matter claimed in a patent taken out by another fixed by the Court of Appeals of the District of Columbia in *Rowntree v. Sloan* (C. D., 1916, 192; 227 O. G., 744; 45 App. D. C., 207), and *Wintroath v. Chapman* (C. D., 1918, 154; 248 O. G., 1004; 47 App. D. C., 428) at one year from the date of the patent, in analogy to the provisions of Revised Statutes, 4894, was extended by the Supreme Court to two years, by analogy to other statutes which were regarded as more pertinent. * *Wells and Hunter v. Honigsmann*, 242.

2. **SAME.**—The ruling of *Rowntree v. Sloan* (C. D., 1916, 192; 227 O. G., 744; 45 App. D. C., 207) could not properly be applied to the case of a renewal application, since the statute (sec. 4897, Rev. Stats.) expressly gives two years within which a renewal application may be filed. * *Id.*

EVIDENCE. See *Abandoned Experiments*, 3; *Abandonment of Applications*, 3; *Abandonment of Invention*, 1; *Anticipation*, 4; *Construction of Specifications and Patents*, 9; *Court of Appeals of the District of Columbia; Delay in Filing Applications for Reissue*, 3; *Interference*, 1, 2, 5, 14, 15, 19, 21; *Invention*, 7, 18; *Patentability*, 1; *Priority of Invention*, 1, 2, 5, 6, 9, 10, 17, 18; *Public-Use-Proceedings*, 1; *Reduction to Practice*, 6; *Suits for Infringement*, 2; *Trade-Marks*, 10, 44, 53.

EXCLUSIVE USE OF TRADE-MARKS. See *Trade-Marks*, 25, 26, 30, 35.

EXPERIMENTS. See *Abandoned Experiments*; *Anticipation*, 2; *Construction of Specifications and Patents*, 11; *Priority of Invention*, 17, 18.

EXPERIMENTAL DEVICE. See *Anticipation*, 4; *Priority of Invention*, 7; *Reduction to Practice*, 9.

EXPERT TESTIMONY.

1. NOT REQUIRED IN PATENT CASES, IF COURT UNDERSTANDS SPECIFICATIONS.—Expert testimony as to the meaning of patent specifications is only permissible to enable the judge to understand the specifications, and when the judge understands the specifications without such testimony it is not necessary since the adoption of the new equity rules. 108 Fed. Rep., xix; 115 C. C. A., xix.) *6 Kohn v. Eimer et al.*, 431.

2. DETERMINATION OF NECESSITY—NOT REVIEWABLE, EXCEPT IN CLEAR CASES.—It is for the judge trying a patent infringement suit to decide whether he needs the assistance of experts to understand specifications of patents relied on as prior art, and his decision will not be disturbed, except in the clearest case. *6 Id.*

EXPERTS. See *Claims*, 9; *Concurrent decisions of the Tribunal of the Patent Office*; *Expert Testimony*; *Infringement*, 10.

EXPIRATION OF PATENT. See *Construction of Statutes*, 2; *Disclosure of Invention*, 2; *Infringement*, 8; *Particular Patents*, 45; *Rights of Holder of Legal Title of Patent*.

EXTENSION OF TIME. See *Disclaimers*; *Interference*, 22; *Suits Under Section 4915 Revised Statutes*, 1.

FAILURE TO FILE APPLICATION. See *Reduction to Practice*, 3.

FINAL FEES. See *Construction of Statutes*, 1; *Trade-Marks*, 48.

PAID MORE THAN SIX MONTHS AFTER NOTICE OF ALLOWANCE OF APPLICATION.—Where the Office records indicate that a notice of allowance of an application was mailed on a certain date, the Commissioner has no authority to receive a final fee paid more than six months thereafter, upon affidavits that such notice was not received. The law (sec. 4885, Rev. Stats.) does not require that the notice shall have been received by the applicant, but merely that it should be sent to him. *Ex parte Lacey*, 83.

FIRST AND ORIGINAL INVENTOR. See *Court of Appeals of the District of Columbia*, 2; *Construction of Statutes*, 3; *Diligence*; *Interference*, 5, 6, 19; *Patentability*, 2; *Priority of Invention*, 1, 2, 5, 9, 10, 15, 19, 20.

FOREIGN LANGUAGE. See *Trade-Marks*, 6.

FOREIGN PATENTS. See *Anticipation*, 3, 4; *Construction of Statutes*, 4; *Patentability*, 2; *Suits for Infringement*, 2.

FORMER DECISIONS CITED. See *Construction of Claims*, 2; *Construction of Specifications and Patents*, 14; *Construction of Statutes*, 3; *Disclaimers*; *Divisional Application*, 2; *Double Patenting*, 2; *Estoppel*; *Interference*, 8; *Invention*, 3, 12; *Particular Patents*, 9; *Patentability*, 2; *Priority of Invention*, 11, 14, 18; *Public Use Proceedings*, 2; *Trade-Marks*, 8, 12, 15, 26, 56.

FORMER DECISION DISTINGUISHED. See *Trade-Marks*, 23.

FUNCTION. See *Claims*, 1; *Construction of Specification and Patents*, 20; *Infringement*, 4, 5; *Particular Patents*, 1, 48.

GEOGRAPHICAL TERMS. See *Trade-Marks*, 24, 25.

GOODS OF THE SAME DESCRIPTIVE PROPERTIES. See *Trade-Marks*, 16, 38, 41, 47, 56.

GRANT OF PATENTS. See *Appeal to the Commissioner of Patents; Construction of Statutes*, 2; *Divisional Applications*, 1, 3; *Double Patenting*, 2, 3; *Patentability*, 1.

IDENTITY OF DESIGNS. See *Infringement*, 10.

IDENTITY OF TRADE-MARKS. See *Trade-Marks*, 17, 18, 55.

IMPEACHMENT TESTIMONY. See *Testimony*.

IMPROVEMENT PATENTS. See *Infringement*, 3, 4, 5; *Laches*.

INADVERTENTLY-GRANTED PATENT. See *Interference*, 20, 21.

INDEFINITENESS. See *Claims*, 3, 4, 5, 6, 7, 8, 9; *Construction of Claims*, 5; *Particular Patents*, 14.

INFRINGEMENT. See *Certiorari*, 3; *Construction of Specifications and Patents*, 2, 6, 8, 11, 12, 18; *Equivalents*; *Laches*; *Particular Patents*, 2, 5, 8, 11, 14, 15, 18, 23, 24, 25, 26, 29, 30, 31, 33, 40, 48, 44, 46, 50, 51, 52; *Rights of Holder of Legal Title of Patent*; *Suits for Infringement*, 1, 2, 4, 5, 6, 7.

1. **DAMAGES.**—The president and general manager of a corporation which infringed a patent is not individually liable for damages and profits on infringement unless he inflicted the damages or received the profits otherwise than through the usual relations between officer and corporation. *4 D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.*, 246.

2. **WHAT CONSTITUTES.**—As between plaintiff's earlier and defendant's later patent a finding that the earlier device, if later, would not have infringed the later patent is not helpful in deciding whether defendant's device infringes plaintiff's patent. *4 Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.*, 259.

3. **IMPROVEMENT, THOUGH PATENTED, MAY INFRINGE PRIOR PATENT.**—An improver can not appropriate the invention of his predecessor, who has obtained a patent, as a base for his improvement without infringement, even though the improvement has been patented. *4 Reed v. Hughes Tool Co.*, 288.

4. **MERE ADDITION OR IMPROVEMENT DOES NOT AVOID.**—That an infringing machine is superior, more useful, and more acceptable to the public than that of a patent does not avoid infringement where the essential features of the patented machine are used, unless its superiority is due to a difference in function or mode of operation or some essential change in character. *4 Smith Cannery Machines Co. v. Seattle-Astoria Iron Works et al.*, 296.

5. **SAME—ADDITIONAL FUNCTION.**—That a part of defendants' device performs a function additional to a corresponding part of plaintiff's device does not avoid infringement. *4 Id.*

6. **CORPORATIONS—RATIFICATION OF ACTS OF UNINCORPORATED PREDECESSOR.**—Complainant corporation, which was the owner of patents, *Held* to have ratified the acts and statements of a representative of its unincorporated predecessor with reference to suit for infringement of improvement patents, which amounted to acquiescence in infringement of original patents. *4 Wolf, Sayer & Heller, Inc. v. United States Slicing Mach. Co.*, 301.

7. **KNOWLEDGE AND CONSENT MERE PAROLE LICENSE—REVOCABLE.**—Where a representative of the owner of a patent notified an infringer that if improvement patents were infringed suit would be brought and the infringer continued to make and vend the infringing machines for a

INFRINGEMENT—Continued.

number of years, *Held* that the statement amounted to no more than a parole license to the infringer, which was revoked when infringement suit was begun. Hence, though the owner was barred by laches from recovering damages for the past infringement, he might recover damages for infringement occurring after the suit, the conduct of the owner and statement of its representative not amounting to an estoppel. *Id.*

8. EXPIRATION OF PATENT.—A construction which was anticipated by a patent and condemned as an infringement of it may be freely made and sold after such patent has expired. *b Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 99.
9. DESIGN PATENT DEPENDS ON IMPRESSION PRODUCED ON PURCHASERS.—The question of infringement of a design patent for a doll is a question as to the impression produced on would-be purchasers. *d Geo. Borgefeldt & Co. et al. v. Weiss*, 389.
10. TEST OF DESIGN.—Infringement of a design patent for a doll turns upon whether there is identity of appearance, whether the effect produced upon the eye is the same, and whether there is substantial identity of design, and the persons to be deceived are not experts, but ordinary observers, giving such attention to the matter as purchasers usually give. ** Id.*
11. INOPERATIVE MACHINE NOT INFRINGED BY OPERATIVE MACHINE.—That under a patent no machine has ever been made and shown to work successfully does not prevent the owner from restraining infringement; but if the patented device is not operative it cannot be infringed by one that is. *d Mastoras v. Hildreth*, 414.

INJUNCTION. See *Appeal to the Circuit Court of Appeals; Certiorari*, 3; *Disclaimers; Rights of Holder of Legal Title of Patent; Suits for Infringement*, 4, 6.

INJURY. See *Amendment to Preliminary Statement*, 2.

INTERFERENCE. See *Abandoned Experiments; Abandonment of Applications*, 2, 3; *Abandonment of Invention*, 1; *Affidavits under Rule 75; Amendment to Preliminary Statement; Concurrent Decisions of the Tribunals of the Patent Office; Construction of Claims*, 1, 2, 4, 5; *Court of Appeals of the District of Columbia; Diligence; Disclosure of Invention*, 1; *Discretion of the Commissioner of Patents; Divisional Applications*, 1; *Jurisdiction of the Court of Appeals of the District of Columbia; Preliminary Statement; Priority of Invention; Public Use Proceedings*, 2; *Reduction to Practice; Testimony; Trade-Marks*, 13, 14, 53.

1. EVIDENCE—INFERENCE ARISING FROM FAILURE TO CALL INVENTOR.—Where the inventor refused to sign the preliminary statement made on his behalf and the assignee of the application, who conducted the interference, failed to call him as a witness, although he was available, the inference is warranted that, in the judgment of counsel for the assignee, he would not support the claims made in his name. ** Marie E. Scheuerle, administratrix, v. Conner*, 123.
2. ORIGINALITY—EVIDENCE—ACQUIESCENCE.—On the question of originality as between E. and S. and M. evidence considered and *Held* that it tended to show acquiescence by S. and M. in E.'s claim to inventorship and that the evidence on behalf of S. and M. failed to overcome the burden of proof imposed on junior applicants. ** Engle v. Manchester and Spooner*, 130.

INTERFERENCE—Continued.

3. **RIGHT TO MAKE CLAIM—DEVICES DESIGNED TO MEET DIFFERENT PROBLEMS.**—Where the count in controversy in an interference included guideways susceptible of being "adjusted angularly about their respective pivots" and was first made in the application of S., wherein precise adjustment was not only necessary but provided, and the other party M. provided adjustment for a different purpose and precise adjustment was unnecessary and unprovided, the two devices being constructed to meet different problems, *Held* that M. had no right to make the claim. * *Seymour v. Molyneux*, 133.
4. **SAME.**—In an interference between S. and M., relating to a feeding mechanism for sewing-machines, where certain counts called for feed-dogs to engage the fabric "in advance of the stitch-forming mechanism," *Held* that M. had no right to make these claims in view of the fact that in his device the feed-dogs operated almost, if not entirely, in the rear of the needles, only a limited number of feed-dog teeth engaging the fabric in advance of the stitch-forming mechanism, while in S.'s case the dogs necessarily operated in advance of the stitch-forming mechanism. * *Seymour v. Molyneux*, 137.
5. **ORIGINALITY—EVIDENCE CONFLICTING—CIRCUMSTANCES.**—Where evidence on the question of originality is very conflicting, nearly every material statement made by one side being denied by the other, the accuracy of the evidence must be tested by the circumstances surrounding the parties, as well as by things done or omitted to be done by them and about which there is no controversy. * *Braun v. Wiegand*, 141.
6. **SAME—APPLICATION AND PATENT—BURDEN OF PROOF NOT SUSTAINED.**—Where in an interference involving the application of B. and a patent to W. it appeared that the question was one of originality, that both parties were employed by the same company, that B. did not file his application until long after the invention patented by W. had gone into commercial use and more than nine months after the grant of W.'s patent, though prior to the time that the device of W. was adopted the devices manufactured by the company were unsatisfactory and the company was anxious to discover a device that would meet with approval, and that B. was working on a less satisfactory device, *Held* that the testimony on behalf of B. was insufficient to establish beyond a reasonable doubt that he was the first to conceive the invention. * *Id.*
7. **PRIORITY—ESTOPPEL BY JUDGMENT IN PRIOR INTERFERENCE INVOLVING ANOTHER APPLICATION OF SAME PARTY.**—Where in a tri-party interference between P., H., and D. the interference was dissolved as to one claim because D. had no right to make it, and no appeal was taken from that decision, and at the time D. had an earlier application pending in which he could make it, but did not attempt to include the earlier application in the interference until after testimony had been taken by the other parties and the interference was before the Examiners-in-Chief on appeal from an adverse decision, *Held* that the Commissioner was right in refusing to reopen the interference at that time to include the earlier application and that D. was barred by the doctrine of *res judicata* from making the claim in his earlier application after final adverse adjudication in the interference and four years after the decision denying his right to make the claims in his later application. * *In re Dement*, 170.

INTERFERENCE—Continued.

8. REOPENING—CHANGE IN PRACTICE.—Where in an interference involving an applicant and a patentee priority was awarded to the patentee on the ground that under ruling in *Winthroath v. Chapman*, C. D., 1918, 154; 248 O. G., 1004; 46 App. D. C., 428), the applicant was estopped to make the claims and no appeal was taken from that decision, *Held* that the fact that the decision in the case cited was subsequently reversed by the Supreme Court does not warrant the reopening of the interference. *Ex parte Wright*, 14.
9. PATENTS—RIGHT TO MAKE CLAIM.—The disclosure of Clark considered and *Held* that he has a right to make the count in issue, which was directed to a refractive screen for headlights having a reflector comprising surfaces of variant vertical distributive dispersion and surfaces of variant lateral distributive dispersion. *Shenk and Holman v. Clark*, 16.
10. SAME—ISSUE CONSTRUED—VEHICLE-GOVERNING MEANS.—In traffic-controlling systems danger-signals operated on a vehicle considered as "vehicle-governing means" in view of the admissions of the opposing party. * *Day v. Bower*, 174.
11. SAME—RIGHT TO MAKE CLAIM.—The Commissioner's ruling that Clark has a right to make the claim in issue reviewed and affirmed. * *Shenk and Holman v. Clark*, 178.
12. SAME—SAME—SAME.—Record reviewed and *Held* that appellee, Brown, has failed to overcome the burden imposed by concurrent decisions of the Patent Office tribunals holding that Tomlinson had a right to make the claims in issue, and the decision of the Commissioner of Patents therefore affirmed. * *Brown v. Tomlinson*, 178.
13. PRIOR ADJUDICATION.—A contention that a count of an interference is not patentably different from the issue in a prior interference between the same parties which had been finally determined does not form a proper basis for invoking the principle of *res adjudicata*, as it is, in effect, merely a denial of the patentability of the count. *Reid, Reid, and Kelley v. Kitzelman*, 28.
14. EVIDENCE.—Where three patents were granted to a party whose name is the same as that of an applicant involved in interference, and the name of the attorneys in each is the same, and the applicant in the interference testifies that one of these patents was taken out by him, and the description thereof contains a reference to another of these patents, *Held* that it may properly be concluded that the applications were all filed by the same person, although the patents were not introduced into evidence. *Grus, Jr., v. Eynon*, 49.
15. DISCLOSURE BY ONE CONTESTANT TO THE OTHER.—In an interference between S. and P. relating to a process of making stencil-paper for use with a sensitized photographic film and to the article made by such process, *Held* the evidence of disclosure by S. to P. only proved disclosure of the result to be accomplished rather than the specific article of the issue and the process of producing the same. * *Pembroke v. Sulzer*, 218.
16. ISSUE THAT OF PRIORITY ONLY.—In an interference contest the only question involved on appeal to the Court of Appeals of the District of Columbia is that of priority of invention between the parties, the losing party having no standing to contend that the issue is not patentable,

INTERFERENCE—Continued.

- that a third party was the prior inventor, or that there is a statutory bar to the issuance of a patent. * *Erben v. Yardley*, 220.
17. REOPENING AFTER APPEAL TO COMMISSIONER TO TAKE FURTHER PROOFS.—In an interference between B. and M., in which the question was one of originality where after hearing on appeal to the Commissioner from a decision of the Examiners-in-Chief awarding priority to M., B. filed a motion to reopen the interference to take the testimony of M., supporting the motion by affidavits executed by M. to the effect that B. disclosed the invention to him, it was error to refuse the motion to reopen. * *Bruckman v. Miller*, 224.
18. SAME—POWER OF COMMISSIONER TO REOPEN INTERFERENCE TO TAKE ADDITIONAL TESTIMONY.—Interference proceedings are of an equitable nature, and so long as a case is pending in the Patent Office it is within the supervision of the Commissioner, who is charged with the duty of seeing that full justice is done, and he may, under his supervisory power, order a case reopened for the taking of additional testimony. * *Id.*
19. SAME—ORIGINALITY.—In an interference between B. and M., involving the question of originality, evidence considered and *Held* that B. disclosed the invention in issue to M. * *Id.*
20. BURDEN OF PROOF—INADVERTENTLY-GRANTED PATENT.—In an interference between an inadvertently-granted patent and an application filed jointly by the patentee and another prior to the filing of the application on which the patent was granted the burden of proof is heavily upon the patentee. * *Lambert v. Hope and Lambert*, 237.
21. EVIDENCE OF JOINT OR SOLE INVENTORSHIP.—In an interference between Lambert, whose patent was inadvertently granted during the pendency of an application filed jointly by him and Hope, evidence considered and *Held* that it failed to sustain Lambert's contention that he was the sole inventor. * *Id.*
22. REOPENING TO PERMIT FILING OF PRELIMINARY STATEMENT.—Where a junior party to an interference fails to file a preliminary statement within the time set and makes no reply to an order to show cause why judgment on the record should not be rendered against him, but within the limit of appeal from such a judgment moves to reopen and to be permitted to file a preliminary statement executed by an official of the assignee company, *Held* that the motion should be denied on the ground of negligence where it appeared that a statement had been prepared for the signature of said official, who was traveling for his health, and was sent to him, with directions to sign it immediately and acknowledge it before a notary, that it was signed and returned without being sworn to and was not properly executed until after judgment on the record, no request having been made in the meantime for an extension of time for filing the statement. *Collins v. Owens*, 76.
23. ADMISSION OF TESTIMONY OF PARTY TO PROCEEDINGS TAKEN AT FORMER TRIAL.—Where a party to an interference is not called upon to testify, his testimony taken in a prior interference between the same parties may be admitted as an admission on his part, and it is not material that the application is assigned, since the assignee stands upon the same footing as the assignor. *Moyer v. Anglada*, 88.
24. RIGHT TO MAKE CLAIMS.—Record reviewed and *Held* that Tomlinson has a right to make the claims of the issue. * *Doyle and Hedley v. Tomlinson*, 179.

INTERLOCUTORY DECREE. See *Certiorari*, 2, 3; *Suits for infringement*, 2, 4.

INTERSTATE COMMERCE. See *Trade-Marks*, 47, 52, 53.

INTERVENING RIGHTS. See *Delay in Filing Application for Reissue*, 3; *Reissues*.

INVENTION. See *Abandonment of Applications*, 2, 3; *Anticipation*, 3, 4, 5; *Claims*, 2, 5, 6, 8, 9; *Construction of Claims*, 3, 8; *Construction of Specifications and Patents*, 3, 4, 8, 9, 11, 13, 14, 16, 17, 21; *Construction of Statutes*; *Copending Applications*; *Interference*, 2, 6; *Method and Product*, 2; *Particular Patents*, 2, 5, 6, 7, 13, 16, 17, 20, 21, 22, 27, 28, 34, 35, 38, 39, 41, 43, 50, 51, 52; *Patentability*; *Priority of Invention*; *Reduction to Practice*; *Validity of Patents*, 2.

1. FLYING-MACHINE—APPLICATION OF OLD IDEA TO NEW TYPE OF MACHINE.—Where the prior art taught the necessity of maintaining lateral and longitudinal stability in a flying-machine adapted to fly from the land and showed means for doing it and the prior art also showed flying-machines intended to be launched from the water, it did not involve invention to substitute the means found in the former in a machine of the latter type. *Ex parte Smith*, 2.
2. PATENTABILITY—MAKING PARTS SYMMETRICAL FOR REVERSAL.—The modification of a fluid-motor piston shown in one patent, which consisted in making certain parts symmetrical, so that it could be reversed, *Held* to be without invention in view of another patent which showed this feature. *Ex parte Smith*, 5.
3. SAME—BRINGING OLD DEVICES INTO JUXTAPOSITION.—Merely bringing old devices into juxtaposition and there allowing each to work out its own effect without the production of something novel is not invention. (*Hailes v. Van Wormer*, 5 O. G., 89; 20 Wall. 353, 368.) * *In re Smith*, 125.
4. PATENTS—PATENTABILITY—ASSOCIATION OF OLD MEANS.—Where one prior-art patent disclosed a portable cleaning-machine of the vacuum type in which the vacuum-creating means is mounted on the device and another patent disclosed such a machine having two compartments in the casing, one connected with the machine-nozzle and the other containing a rotary brush, but in which the vacuum-creating means was separately mounted and connected to the device by a pipe, *Held* that it involved no invention to make a separate compartment in the casing of the former and place a rotary brush therein in view of the latter. *Ex parte Moore and Pack*, 21.
5. INCORPORATION OF ONE OLD DEVICE INTO ANOTHER NOT INVENTION.—The application of a rotary brush and its coöperative parts to an old carpet-cleaning device where the parts so associated operated in the old way to effect the same results does not constitute invention. * *In re Moore and Pack*, 182.
6. PATENTABILITY—ALLEGED NEW RELATION OF PRINTING-PRESS AND PAPER-WEB.—No invention is involved in leading the web through a printing-press in a specified way where no change in the construction is necessary to accomplish it. *Ex parte Barber*, 23.
7. EVIDENCE OF.—The argument that applicant has converted an unsuccessful machine into a successful one is not always convincing, since success may have resulted from reasons other than in the changes over the prior art specified in the claims. *Ex parte Schneider*, 25.
8. PATENTABILITY—CHANGE OF MATERIAL.—“A filler form comprising a body of felt compressed * * * and saturated by a water soluble

INVENTION—Continued.

stiffening agent (starch) maintaining it in compressed condition," designed to be used as a filling beneath embroidery-threads, *Held* devoid of invention, it appearing that starched felt was old and that it was old to use other filling material beneath embroidery-threads and the evidence showing that the capacity claimed for the felt in this situation—namely, its expansibility after being freed of starch during washing and so maintaining the "plumpness" of the embroidery—did not exist in any useful degree. *G. Reis & Bro., Inc., v. Reform Initial Company, Inc., and Gottschalk and Brasch*, 351.

9. **SAME—SAME.**—The use of starched compressed felt, which was old, for a filler-form to be placed beneath embroidery-threads, claimed by the patentee to have the capacity of expanding after being freed of the starch during washing, *Held* devoid of invention as involving only a substitution of an old material for material formerly used for the same purpose, the capacity of the material to so expand being only trifling and having been long known. *Id.*
10. **SAME—SUBSTITUTION OF STEEL FOR WOOD.**—"The idea of making a car sill of rolled steel straight channel bars which could be purchased in the open market was not the subject of patentable invention." *Bel-lows and Slack v. The New York Central Railroad Company*, 356.
11. **SAME—REINFORCING METAL CAR-SILLS—WOODEN SILLS.**—Where it was old to reinforce wooden car-sills by the employment of a reinforcing member extending along the sill between bolsters and to reinforce metal car-sills of the fish-belly type and also to reinforce straight metal channel-bars in other arts, it involved no invention to substitute a straight rolled-steel channel bar for the wooden sill and reinforce it in an analogous way. *Id.*
12. **SAME—HANDLE MADE OF METAL ROD HAVING SERIES OF LATERAL BENDS.**—Claims for a windshield-wiper in which the feature relied upon for patentability is a handle to be grasped in the palm of the hand, consisting of a wire or rod provided with a series of lateral bends extending from side to side in zigzag manner to form a wide flat vertical handle arranged in a plane parallel to the wind-shield, *Held* devoid of invention in view of a patent for a similar device which disclosed but a single bend, it appearing that the idea of forming a rod in a series of bends was a well-known mechanical expedient (citing *Towne Steering Wheel Co. v. Lee*, 199 Fed. Rep., 777.) *Ex parte Staderker*, 34.
13. **SAME—WINDSHIELD-CLEANER.**—Claims for windshield-cleaner in which the feature relied upon for patentability is a handle consisting of a wire or rod bent in zigzag form, *Held* devoid of invention. *In re Staderker*, 190.
14. **SAME—COMBINATION.**—Although the prior art disclosed in one patent the combination of an adding-machine and an ejecting mechanism which would eject the smallest number of coins necessary to be dispensed to pay each item of a pay-roll and in another a machine for automatically recording the different denominations of coins and paper money necessary to make up any given amount, *Held* that it was invention to combine an adding-machine with a denominationalizer, whereby it could be determined in advance the number of bills and coins which it would be necessary to obtain at the bank to pay each item of a pay-roll, which was a new result. *In re Sorum*, 193.

INVENTION—Continued.

15. **PATENTABILITY — SUBSTITUTION OF EQUIVALENTS.**—Where a prior-art patent disclosed a device to produce a shower of tobacco and direct it onto a separating means and another patent disclosed a separator to act on granulated tobacco having elements of different specific gravities in which the tobacco was fed from a hopper onto a rapidly-moving belt, which propelled the tobacco against opposing air-currents, the heavier particles being thrown through the current and the lighter ones being deflected by the current, *Held* that it involved no invention to substitute the shower-producing means of the former for the hopper of the latter combination. *Ex parte Teale*, 45.
16. **PATENTABILITY—ELECTRICAL HEATING UNIT.**—Where the prior art disclosed in one patent an electrical heating unit consisting of a series of separate resistance-coils formed of a double spiral wound in conical form, each coil being joined to the next by a binding-post, another patent disclosed a heater having a series of coils of a continuous piece of wire, and others disclosed heating-coils of a single spiral, the wire being led back through the coil, *Held* that no invention was involved in modifying the first-named construction by making the wire continuous and winding the coils in a single instead of a double spiral in view of the other references. *Ex parte Kuhn and Shailor*, 58.
17. **TEST OF.**—Whether a patented structure involves invention is a question of fact, and the determining factor is not whether the achievement was difficult or easy, but whether it has in point of fact given the world something of value that it did not have. *H. D. Smith & Co. v. Peck, Stow & Wilcox Co.*, 373.
18. **EVIDENCE OF.**—The willingness of the public to pay more for a patented device than for other articles of that class is a demonstration of its substantial value, and the fact that defendant copied the structure and shape of the article shows that it, too, appreciated the value of the advance made. *Id.*
19. **TEST—"NEW RESULT."**—"The test of the presence of invention in a new assembly of old elements is sometimes said to be whether a new result is accomplished. This is often not a helpful rule, because its application involves definition of the phrase 'new result,' and this opens the original difficulty. Within a narrow definition, every new combination of old elements gets a new result; but this is not the sense in which the phrase is rightly used as indicative of invention." *Concrete Appliances Co. et al. v. Meinken et al.*, 378.
20. **ATTRIBUTES STATED.**—While patentable "invention" is not a term of legal art or capable of judicial definition, yet it is a means only, or the embodiment of the inventive idea, and merits the title, even if the want it meets is not apparent until some previous invention, imperfectly satisfying the more universal want, discloses the subordinate and narrower need. *A. Kimball Co. v. Noesting Pin Ticket Co.*, 394.
21. **MECHANICAL SKILL—STATED.**—As a mechanic is one who applies his trade by rule or rote and only uses what he learned yesterday to do the work of to-day, it may become invention where a mechanic uses insight or foresight to comprehend a problem and uses even the learning of yesterday to do new things in a new way. *Id.*
22. **PATENTABILITY.**—No invention is involved in extending the operating-rod of an electric switch shown in a prior patent through the cover of

INVENTION—Continued.

- the inclosing casing, so that the operating-magnets would be outside the casing, particularly in view of another patent of the prior art which disclosed an operating mechanism on the outside of the casing. *Ex parte Simon*, 59.
23. ANALOGOUS USE.—Where it was old to provide a dental tool with a removable metal shield having absorbent disks, which shield with the disks could be removed and cleansed, and it was old in general to use protective shields of paper which could be thrown away when once used (exemplified in clinical thermometers,) it involved no invention to provide a dental handpiece with a removable paper shield for the same purpose. *Ex parte Moolten*, 63.
24. PATENTABILITY—SCREENING INLET-VALVE.—In view of the common practice of screening the inlet of a pump, so as to prevent undesirable objects from clogging it, there would be no invention in so screening valves leading to the bellows of a domestic suction cleaning-machine if the dust-bag adjacent thereto were of such light material that there would be danger of its being sucked into the opening. *Ex parte Moore and Pack*, 69.
25. SAME—MOUNTING OLD CLEANING DEVICE ON WHEELS.—No invention is involved in mounting an old suction cleaning device on wheels. *Id.*
26. SUBSTITUTION OF MEANS.—Where an earlier patent disclosed means for effecting unison of movement between biscuit-cutting machinery and the material to be cut, the substitution therefor of means already employed in the brick-making art in connection with the cutting of plastic clay was not invention, there being a substantial analogy between the two arts. *J. H. Day Co. v. Mountain City Mill Co. et al.*, 421.
27. ANALOGOUS USE.—The employment of a rotary fan for withdrawing heated air from a moving-picture cabinet is not an improvement in the moving-picture art. The alleged improvement relates only to ventilation, and the use of ventilating-fans being common no invention is involved in the specific application; otherwise anyone could obtain a monopoly of the use of a ventilating-fan in every cabinet or box or room into which he put a different apparatus or in which existed a different condition on account of which he desired ventilation for a different purpose. Lockwood patent, No. 929,678, *Held* void on motion to dismiss bill. *De Vry Corporation v. Acme Motion Picture Projector Co.*, 440.
28. CHANGE READILY MADE.—It may be that the conception of invention cannot be tested by the experience of the inventor in the art or by moments of time and that originality does not need the aid or delay of drudgery, but one is forced to think that where a change is readily made in any composite instrumentality the change is not the prompting or product of invention. *New York Scaffolding Company v. Chain Belt Company and Whitney*, 492.

INVENTION BY THIRD PARTY. See *Interference*, 18.

JOINT AND SOLE APPLICATIONS. See *Interference*, 20, 21; *Joint Application, One Applicant Not Inventor*.

JOINT APPLICATION, ONE APPLICANT NOT INVENTOR.

1. APPLICATION—SOLE APPLICATION MAY TAKE BENEFIT OF FILING DATE OF PRIOR JOINT APPLICATION.—Where an application is filed by two parties as joint inventors, but during its pendency one of the joint applicants admitted that he had no part in the act of invention and it appears

JOINT APPLICATION, ONE APPLICANT NOT INVENTOR—Continued.

that he was joined as a coinventor through inadvertence and mistake and without fraudulent intent, a sole application afterward filed by the other joint applicant for the same subject-matter is entitled to the benefit of the filing date of the joint application. **In re Roberts*, 158.

2. SAME—SAME—CHANGING JOINT TO SOLE APPLICATION.—Where during the pendency of a joint application it is admitted by one of the joint applicants that he had no part in the act of invention and it appears that he was joined as a coinventor through inadvertence and mistake and without fraudulent intent, "it is difficult to perceive any reason for not permitting the rectification of such a mistake, by an amendment eliminating the superfluous applicant." **Id.*

JUDGMENT ON THE RECORD. See *Certiorari*, 2; *Interference*, 22; *Priority of Invention*, 4; *Suits for Infringement*, 5.

JUDICIAL CODE. See *Appeal to the Circuit Courts of Appeal*, 1; *Certiorari*, 1.

JURISDICTION. See *Trade-Marks*, 21.

JURISDICTION OF THE COMMISSIONER OF PATENTS. See *Interference*, 18.

COMMISSIONER OF PATENTS—APPEAL TO COURT PERFECTED.—The Commissioner of Patents has no jurisdiction to consider claims presented to him after an appeal to the court of appeals has been perfected as to other claims. **In re Smith*, 140.

JURISDICTION OF THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

INTERFERENCE PROCEEDING.—The Court of Appeals of the District of Columbia is without authority in an interference proceeding to review the Commissioner's ruling that the claims of one of the parties are not patentable because barred by the statute of public use (or printed publication). **Cowles v. Rody*, 117.

LACHES. See *Infringement*, 7; *Priority of Invention*, 14; *Suits for Infringement*, 8.

RECOVERY FOR INFRINGEMENT BARRED.—Where the owner of patents notified one who was already infringing that suit would be brought if improvement patents controlled by the owner were infringed and no suit was brought for seven years, during which the infringers continued to make and vend the infringing machines, no recovery for that period of infringement of the original patents can be allowed, the owner being barred by laches. While such acquiescence in infringement amounted to a parole license, it was revoked by the bringing of the suit, and damages were recoverable for infringement accruing after suit was brought. *Wolf, Sayer & Heller, Inc., v. United States Slicing Mach. Co.*, 301.

LEGAL QUESTION. See *Trade-Marks*, 23, 24.

LIABILITY. See *Infringement*, 1; *Suits for Infringement*, 1.

LICENSES. See *Abandoned Experiment*, 2; *Infringement*, 7; *Laches*; *Rights of Holder of Legal Title of Patent*.

NOT ESTOPPED TO DENY VALIDITY.—Under an assignment of a patent providing for reversion to the patentee in case of dissolution or termination of the assignee, if, as claimed by the patentee, the sale by the corporate assignee of all its assets caused the patent to revert, a license subsequently granted by the assignee did not estop the licensee to dispute the validity of the patent. *Kohn v. Eimer et al.*, 431.

LIMIT OF TIME. See *Abandonment of Applications*, 1; *Abandonment of Inventions*, 2; *Anticipation*, 3; *Appeal to the Court of Appeals of the District of Columbia*; *Delay in Filing Applications for Reissue*; *Divisional Applications*, 1; *Estoppel*; *Final Fees*; *Interference*, 6, 22; *Reissue*; *Renewal of Forfeited Applications*; *Suits under Section 4915, Revised Statutes*.

LIMITATION OF CLAIMS. See *Amendment of Claims*; *Anticipation*, 1; *Claims* 1, 2, 3, 7; *Construction of Claims*, 2; *Construction of Specifications and Patents*, 2, 18; *Particular Patents*, 10, 29.

LIMITATION OF PATENTS. See *Particular Patents*, 10, 39, 46.

MACHINES. See *Construction of Specifications and Patents*, 8, 7, 18; *Disclosure of Invention*; *Infringement*, 4, 11; *Invention*, 1; *Patentability*, 7; *Particular Patents*, 10, 12, 31, 40, 50; *Reduction to Practice*, 6, 7; *Suits for Infringement*, 9.

MECHANICAL SKILL. See *Disclosure of Invention*, 1; *Invention*, 12, 21; *Particular Patents*, 12, 13, 51; *Priority of Invention*, 3.

MERITS. See *Abandonment of Applications*, 1; *Certiorari*, 3; *Priority of Invention*, 4; *Scope of Patents*; *Suits for Infringement*, 4.

METHOD. See *Particular Patents*, 4, 9, 23, 25, 32.

METHOD AND PRODUCT. See *Construction of Specifications and Patents*, 5, 10.

1. **NEW PRODUCT—VARIATIONS IN METHOD OF MAKING.**—The inventor of a new and useful product or article of manufacture may have a patent covering it and giving a monopoly upon it regardless of great variations in the method of making. ⁴ *Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.*, 259.

2. **SEPARATE PATENTS.**—In the ordinary and typical case the method of manufacture and the product manufactured are separable inventions supporting separate patents, one of which may be valid and the other not, ⁴ *Id.*

MISTAKE. See *Joint Application, One Applicant Not Inventor*.

MODE OF OPERATION. See *Construction of Specifications and Patents*, 18; *Patentability*, 7; *Scope of Patent*.

MONOPOLY. See *Construction of Specifications and Patents*, 12; *Invention*, 27; *Method and Product*, 1.

MOTION FOR FINAL DECISION ON MERITS. See *Suits for Infringement*, 4.

MOTION FOR REHEARING. See *Suits Under Section 4915, Revised Statutes*, 1.

MOTION TO DISMISS APPEAL. See *Appeal to the Court of Appeals of the District of Columbia*.

MOTION TO DISSOLVE INTERFERENCE. See *Affidavits Under Rule 75*.

MOTION TO REOPEN INTERFERENCE. See *Discretion of the Commissioner of Patents*; *Interference*, 7, 8, 17, 18, 22.

MOTION TO REOPEN PUBLIC-USE PROCEEDINGS. See *Public-Use Proceedings*, 1.

MULTIPLICITY OF CLAIMS. See *Claims*, 5, 6, 7, 8, 9.

NEW CLAIMS. See *Construction of Specifications and Patents*, 4.

NEW FUNCTION. See *Particular Patents*, 48.

NEW RESULTS. See *Invention*, 14, 19, 21; *Patentability*, 5; *Scope of Patent*.

NEW USE. See *Construction of Specifications and Patents*, 1.

NON-USER. See *Validity of Patents*, 1.

NOTICE OF ALLOWANCE. See *Final Fees*.

NOVELTY. See *Construction of Specifications and Patents*, 3, 9, 21; *Invention*, 3; *Patentability*, 2.

OFFICER OF CORPORATION. See *Infringement*, 1; *Suits for Infringement*, 1.

OFFICERS OF THE GOVERNMENT. See *Construction of Statutes*, 1; *Reduction to Practice*, 2.

OLD DEVICES. See *Invention*, 3, 5, 8, 9, 11, 12, 15, 23, 25, 26; *Particular Patents*, 48.

OMISSION IN CLAIMS. See *Construction of Claims*, 10.

OMISSION OF INVENTOR'S ADDRESS. See *Suits for Infringement*, 8.

OPERATIVENESS. See *Abandoned Experiments*, 2; *Infringement*, 11; *Particular Patents*, 1; *Patentability*, 1; *Priority of Invention*, 3, 4; *Reduction to Practice*, 7, 8; *Scope of Patent*; *Validity of Patents*, 1.

OPPOSITION TO REGISTRATION OF TRADE-MARKS. See *Trade-Marks*, 19, 38, 50, 51.

ORAL INTER PARTIES HEARING. See *Public-Use Proceedings*, 2.

ORIGINAL PATENT. See *Construction of Specifications and Patents*, 4, 11; *Delay in Filing Application for Reissue*; *Particular Patents*, 47.

PARTICULAR PATENTS. See *Construction of Specifications and Patents*; *Invention*, 27.

1. BEIDLER—No. 1,057,397—PHOTOGRAPHING AND DEVELOPING APPARATUS—INVENTION.—Letters Patent No. 1,057,397, to Beidler, for an improvement in photographing and developing apparatus, *Held* void for lack of sufficient disclosure, since for successful operation it would require a manipulation which could not be performed with the construction disclosed without material changes thereof and which did not accord with the mode of operation set forth in the description. ** *Beidler v. The United States*, 488.
2. BELLOWS—No. 762,796—METAL CAR-SILLS—INVENTION.—The Bellows patent, No. 762,796, claims 1, 7, and 10 to 17, and the Bellows patent, No. 762,858, claims 1 to 9, for metal car-sills, *Held* invalid, being devoid of invention in view of the prior art. ⁴ *Bellows and Slack v. The New York Central Railroad Company*, 356.
3. SAME—No. 693,218—STEEL CAR.—The Bellows patent, No. 693,218, for a steel car, claims 2 and 3, *Held* void in view of prior uses. ⁴ *Bellows and Slack v. New York Central Railroad Company*; *Same v. Pressed Steel Car Company*, 362.
4. BRIDGE—No. 1,006,995—HOLDING GLASS CYLINDERS—VALID AS TO CERTAIN CLAIMS.—The Bridge patent, No. 1,006,995, for an apparatus for holding the large mechanically-drawn glass cylinders, which was fit for use when the cylinders were divided into segments, *Held* valid as to claims 1, 2, and 4. ⁴ *Consolidated Window Glass Co. v. Window Glass Mach. Co. et al.*, 314.
5. BRINKMAN—No. 843,864—MOTOR-CAR RADIATOR—VALIDITY AND INFRINGEMENT.—The Brinkman patent, No. 843,864, for a cooler or radiator for motor-cars, *Held* valid, and, as disclosing the first honeycomb construction of an automobile-radiator, is entitled to a liberal range of equivalents; also *Held* infringed. ⁴ *Whitlock Coll Pipe Co. v. Mayo Radiator Co.*, 447.
6. BURCHENAL—No. 1,135,351—LARDLIKE FOOD PRODUCT—VALIDITY.—The Burchenal patent, No. 1,135,351, for a food product, claims 1 and 2, for a homogeneous lardlike food product consisting of an incompletely-hydrogenized vegetable oil or cottonseed oil, *Held* devoid of invention in view of the prior art. ** *Berlin Mills Company v. Procter & Gamble*, 496.

PARTICULAR PATENTS—Continued.

7. CALLAHAN—No. 948,719—DEVICE FOR DISTRIBUTING WET CONCRETE—VALID—NOT ANTICIPATED.—The Callahan patent, No. 948,719, for an apparatus for distributing wet concrete, consisting of an elevating-tower and devices for spreading same over structure, though a combination, *Held* to show invention and not to have been anticipated. *Concrete Appliances Co. et al. v. Meinken et al.*, 378.
8. CHAMBERS—No. 782,880—METHOD OF DRAWING GLASS—VALID AND INFRINGED.—The Chambers patent, No. 782,880, for a method for gradually increasing the speed of the drawing operation for the mechanical drawing of glass, *Held* valid and infringed. *Consolidated Window Glass Co. v. Window Glass Mach. Co. et al.*, 313.
9. COLLIS—No. 1,204,905—PROCESS FOR DRYING AND SHAPING HOSIERY ARTICLES—VOID.—The claim of the Collis patent, No. 1,204,945, reading as follows: "A method of treating hosiery articles, consisting in heating, from within, and to a predetermined fabric-drying temperature, a metallic form having its sides relatively narrow in cross-section and converging into substantially reduced, crease-producing edges; then superposing upon said form a hosiery article and subjecting the same to the action of heat imparted internally thereto by the form for producing a substantially flattened and creased article," *Held* void as covering nothing more than the function of an apparatus which was the subject of a separate patent which had been held invalid because of prior invention and use. "The process in this case is as clearly the whole value, the sole purpose of the apparatus," as in the case of *Busch v. Jones* (184 U. S., 598), "the process was the whole value, the sole purpose of the press." *Paramount Hosiery Form Drying Co. v. Moorhead Knitting Co.*, 268.
10. CONNOR—No. 836,486—BIFOCAL LENS—LIMITATION.—The Connor machine patent, No. 836,486, claim 1, for making bifocal lenses, as limited by its reference to the specifications, is not invalid because too broad. *Bisight Co. et al. v. Onepiece Bifocal Lens Co.*, 257.
11. SAME—INFRINGEMENT.—No. 836,486, claim 1, for making bifocal lenses, *Held* infringed. *Id.*
12. SAME—ANTICIPATION.—No. 836,486, claim 1, for producing bifocal lenses, is not anticipated by grinding-machines in remote arts, such as grinding buttons, since more than mechanical skill was required to apply the grinding process to lenses. *Id.*
13. DUNN—No. 918,980—WIRE-CUT PAVING-BRICK—VALIDITY.—Dunn's patent, No. 918,980, for wire-cut paving-brick having wire-cut ribs on the side, *Held* valid because the concept had inventive character, as distinguished from mere skill. *Dunn Wire-Cut Lug Brick Co. v. Toronto Fire Clay Co. et al.*, 259.
14. FARIERS—No. 779,271—JAR AND DIPPER—VALIDITY—INDEFINITENESS.—The Faries patent, No. 779,271, for a jar and dipper for serving crushed fruit, etc., claim 3 *Held* not infringed. Claims 4 and 5 *Held* invalid for indefiniteness in view of the prior art. *Knight Soda Fountain Co. v. Walrus Mfg. Co.*, 254.
15. GRIFFIN—No. 1,195,209—HUGHES—No. 1,124,241—ROTARY WELL-BORING DRILL—VALID AND INFRINGED.—The Griffin patent, No. 1,195,209, and the Hughes patent, No. 1,124,241, each for a rotary well-boring drill, *Held* not anticipated, valid, and infringed. *Reed v. Hughes Tool Co.*, 288.

PARTICULAR PATENTS—Continued.

16. HENDERSON—No. 959,008—SCAFFOLDING MEANS—VOID.—The Henderson patent No. 959,008, for scaffold-supporting means, *Held* void for lack of invention in view of the patent to Murray, No. 854,959. ** *New York Scaffolding Company v. Liebel-Binney Construction Company*, 487.
17. SAME—SAME—SAME.—The Henderson patent, No. 959,008, for scaffold-supporting means, *Held* void for lack of invention in view of the patent to Murray, No. 854,959. ** *New York Scaffolding Company v. Chain Belt Company and Whitney*, 492.
18. HITNER—No. 821,361—CAPPING GLASS CYLINDERS—VALID AND INFRINGED.—The Hitner patent, No. 821,361, for a device for capping off glass cylinders, *Held* valid despite the contention that it had been placed on sale more than two years before application, and also *Held* infringed. *Consolidated Window Glass Co. v. Window Glass Mach. Co. et al.*, 313.
19. SAME—No. 822,452—HOISTING DEVICE—PATENT VALID AND INFRINGED.—The Hitner patent, No. 822,452, for a hoisting device to move large cylinders of glass mechanically drawn, *Held* valid and infringed. *Id.*
20. JENNISON—No. 1,061,296—WOODEN PAVEMENT—VALIDITY.—The Jennison patent, No. 1,061,296, for a wooden pavement consisting of wood paving-blocks with a spacing projection extending in the direction of the grain along the vertical side of the block, *Held* void for want of invention, such spacing projection having been used on clay and brick paving-blocks and the only specific advantages of the patentee's pavement being those inherent in the material selected. *Jennison-Wright Co. v. Hemy*, 444.
21. KNUDSEN—No. 1,221,190—BRACE TO STRENGTHEN RADIUS RODS—VOID.—Claims of the Knudsen patent, No. 1,221,190, for a brace supporting the V-shaped radius rods of the Ford automobile, *Held* void for lack of invention. When the patentee "found that the radius rods were insufficient to support the strain which hard usage entailed, he sought to strengthen them. Not only was the strengthening of the radius rods the obvious remedy, but a brace was the means which even a layman would have adopted to accomplish the end. To fasten one end of the brace to the lower side of the axle and to attach the other end to the radius rod was not only the obvious way, but it was practically the only way." *Walker Mfg. Co. et al. v. Illinois Brass Mfg. Co.*, 442.
22. KOHN—No. 983,291—ELECTRIC FURNACE—VALIDITY—ANTICIPATION.—Claims 1, 3, 8, and 11 of the Kohn patent, No. 983,291, for an electric furnace consisting of separate heating units, each form being removable and the coil being removable from each form, *Held* invalid for anticipation and want of invention. *Kohn v. Eimer et al.*, 431.
23. LUBBERS—Nos. 702,013 and 702,014—DRAWING WINDOW GLASS—VALID AND INFRINGED.—The Lubbers patent, No. 702,013, claims 1, 2, 3, 5, 8, 9, 10, 12, 13, 15, 16, 17, and 18, as well as Patent No. 702,014, claims 2, 3, 4, 5, 8, 9, 11, and 13, the first of which was for an apparatus for mechanically drawing window glass and the latter being a method patent, *Held* valid and infringed. *Consolidated Window Glass Co. v. Window Glass Mach. Co. et al.*, 313.
24. SAME—No. 886,618—DRAWING GLASS—PATENT VALID AND INFRINGED.—The Lubbers patent, No. 886,618, for an air-vent hole in the apparatus for mechanically drawing glass, claims 20, 21, 23, 24, and 26, *Held* valid and infringed. *Id.*

PARTICULAR PATENTS—Continued.

25. SAME—No. 822,678—REGULATING SPEED OF DRAWING GLASS—VALID AND INFRINGED.—The Lubbers patent, No. 822,678, for a method of regulating the speed for the mechanical drawing of glass, *Held* valid and infringed. *Id.*
26. SAME—No. 914,586—REGULATING DRAWING OF GLASS—VALID AND INFRINGED.—The Lubbers patent, No. 914,586, for an appliance to regulate the mechanical drawing of glass, so that the surface tension on the bait would be equalized, *Held* valid and infringed. *Id.*
27. MARSHALL—No. 685,160—MATTRESS—INVENTION.—The Marshall patent, No. 685,160, for a mattress comprising a cover and a plurality of transversely-extending strips of material stitched at intervals to form pockets, etc., and spiral springs arranged in such pockets, *Held* valid, showing invention. *Id.* *D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.*, 246.
28. NATHAN—No. 873,775—INNERSOLE FOR SHOES—VOID.—The Nathan patent, No. 873,775, for an innersole for shoes having variously located pockets for the insertion of filling to correct abnormal tendencies of the foot, *Held* void for lack of invention and anticipation in the prior art, as it involved only duplication of the pocket of a prior device and the provision of an insert at other locations. *Id.* *Nathan Ankle Support Co., Inc., et al. v. Cammeyer, Inc.*, 427.
29. NIESZ—No. 13,163—REISSUE—FOUR-GANG DISK HARROW—VALIDITY AND INFRINGEMENT.—Claims of the Niesz reissue patent, No. 13,163, for a four-gang disk harrow, which include a "central" reach bar, *Held* not limited to a reach bar "on the median line" or to a reach bar made of a single piece, as disclosed in the patent, the word "central" being taken to mean a central location generally and "reach bar" being broad enough to include, at least as equivalent, two draft bars. *Id.* *Ohio Rake Co. v. Bucher & Gibbs Plow Co.*, 451.
30. PFEFFER—No. 51,559—DOLL—VALID—INFRINGED.—The Pfeffer design patent, No. 51,559, for a doll, *Held* valid and infringed. *Id.* *Geo. Borgfeldt & Co. et al. v. Weiss*, 389.
31. ROBINSON—No. 809,582—VEGETABLE-PREELING MACHINE—INFRINGED.—Claims of the Robinson patent, No. 809,582, for a vegetable-peeling machine, including a rotary disk having a horizontal striated portion. *Held*, infringed by a peeling machine having an abrading disk of concrete or cement, the latter being considered as having striations set irregularly. *Id.* *Imperial Machine & Foundry Corporation v. G. S. Blake-slee & Co.*, 868.
32. RODMAN—No. 1,076,453—METHOD OF MAKING CASE-HARDENING MATERIAL—PRIOR USE.—Rodman patent, No. 1,076,453, for a method for making case-hardening material, *Held* not invalid on the ground of prior use. *Id.* *Rodman Chemical Co. v. Deeds Commercial Laboratories*, 292.
33. SAME—INFRINGEMENT.—The Rodman patent, No. 1,076,453, for a case-hardening material, which material was composed of carbonaceous pellets, *Held* infringed. *Id.*
34. SAME—ANTICIPATION.—The Rodman patent, No. 1,076,453, for a case-hardening material, claims 1, 7, 17, 22, and 25, consisting of pellets of carbon, etc., *Held* not anticipated and to show invention. *Id.*
35. ROHM—No. 886,411—PROCESS FOR BATING HIDES—INVENTION.—Rohm patent, No. 886,411, for a process for bating hides, *Held* invalid because

PARTICULAR PATENTS—Continued.

of the application's failure to fully and clearly disclose the invention, as required by Revised Statutes, section 4888 (Comp. St., sec. 9432).

^a *Rohm et al. v. Martin Dennis Co.*, 849.

36. SCHEMMEI—No. 1,226,600—FINISHING-WELT—ANTICIPATED.—The Schemmel patent, No. 1,226,600, claims 1, 2, 5, and 6, of May 15, 1915, for a finishing-welt, *Held* invalid because anticipated. ^a *Backstay Machine & Leather Co. v. Hamilton*, 397.

37. SAME—SAME—FINISHING-WELT—INVALID.—The Schemmel patent, No. 1,226,600, claims 3 and 4, of May 15, 1917, for a finishing-welt, is invalid because for a combination of the article claimed to have been invented with some other article which the inventor does not describe. ^a *Id.*

38. SAME—DESIGN—No. 51,804—MOLDING OR WELT—VOID FOR LACK OF INVENTION.—The Schemmel design patent, No. 51,804, for a design for a molding or welt, *Held* void for lack of invention. ^a *Id.*

39. SMITH—No. 948,746—APPARATUS FOR DISTRIBUTING WET CONCRETE—INVALID FOR LACK OF INVENTION.—The Smith patent, No. 948,746, for an apparatus for distributing wet concrete, as limited by the prior Callahan patent, No. 948,719, *Held* not to show invention. ^a *Concrete Appliances Co. et al. v. Meinken et al.*, 378.

40. SAME—No. 979,103—FISH-DRESSING MACHINE—INFRINGEMENT.—The Smith patent, No. 979,103, for a fish-dressing machine, claims 38, 39, 40, and 41, *Held* valid and infringed. ^a *Smith Cannery Machines Co. v. Seattle-Astoria Iron Works et al.*, 296.

41. THOMPSON—No. 1,252,862—PIN-TICKET DEVICE—VALID.—The Thompson patent, No. 1,252,862, for an improved pin-ticket device to be attached to textile and other articles offered for sale, *Held* valid against the contention that it did not disclose invention. ^a *A. Kindall Co. v. Noesting Pin Ticket Co.*, 394.

42. THOMSON—No. 841,356—MUSIC-SHEET GUIDE—VALID AND INFRINGED.—The Thomson patent, No. 841,356, for a music-sheet-guiding device for mechanical piano and organ players, *Held*, to cover a patentable improvement on prior devices and entitled to a fair construction and a reasonable range of equivalents; also *Held* infringed. ^a *Æolian Co. v. Schubert Piano Co.*, 304.

43. TUFFORD—No. 1,177,833—MOLD FOR MAKING RUBBER HEELS.—The Tufford patent, No. 1,177,833, for a mold for making rubber heels, *Held* not anticipated and to disclose patentable invention; also infringed. ^a *I. T. S. Rubber Co. v. Panther Rubber Mfg. Co.*, 233.

44. VAN BERKLE—Nos. 806,603 AND 895,213—MEAT-SLICING MACHINES—VALID AND INFRINGED.—The Van Berkel patents, Nos. 806,603 and 895,213 for meat-slicing machines with removable meat-plates, *Held* valid and infringed as to claim 2 of the earlier patent and claims 8, 9, and 10 of the later. ^a *Wolf, Sayer & Heller, Inc., v. United States Slicing Mach. Co.*, 801.

45. VAN KANNEL—REISSUE No. 14,255—REVOLVING DOOR—ANTICIPATION.—Claims 1, 2, 3, 13, 22, 23, and 24 of the Van Kannel Reissue Patent No. 14,255, for an automatically-collapsible revolving door, *Held* invalid, as anticipated by Patent No. 656,062, issued to the same inventor and now expired. ^b *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 99.

PARTICULAR PATENTS—Continued.

46. VANDENBURGH—No. 841,741—REINFORCING - BAR LIMITED—NOT INFRINGED.—The Vandeburgh patent, No. 841,741, for a reinforcing-bar for use in concrete work, *Held* limited by the prior art to a bar with kerfs or cuts, in which the attached coil is placed, and a tongue or spur overlapping the kerf and holding the coil in place, and, as so limited, not infringed. ^d *Vandeburgh v. Electric Welding Co.*, 353.
47. SAME—REISSUE No. 14,182—REINFORCING-BAR—HELD INVALID AS NOT WARRANTED BY ORIGINAL PATENT.—Claims 1 and 2 of the Vandeburgh reissue patent, No. 14,182, for reinforcing-bars for use in concrete work, *Held* invalid, as not warranted by the original patent. ^d *Id.*
48. WARD—No. 737,179—SCREW-DRIVER—NOT ANTICIPATED.—The Ward patent, No. 737,179, for a screw-driver, is not anticipated by a horse-shoer's hoof-parer, by a carriage-trimmer's tool, by an ice pick and meat maul, or by a wrench, as none of them suggest the idea in their construction of being at all adapted to a tool utility by turning on its longitudinal axis. To adapt the old devices to the new function requires modification or changes. ^d *H. D. Smith & Co. v. Peck, Stow & Wilcox Co.*, 373.
49. SAME—DESIGN—No. 37213—SCREW-DRIVER—INVALID.—The Ward design patent, No. 37,213, for a design for a screw-driver, *Held* invalid, as it does not impart such a pleasing effect to the eye as to create beauty or attractiveness or to make it ornamental. ^d *Id.*
50. SAME—No. 865,461—IMPROVEMENT IN CRACKER-CUTTING MACHINES, INVALID AND NOT INFRINGED.—The Ward patent, No. 865,461, for means for moving the cutting mechanism of cracker-cutting machines during the cutting operation in line with and at the same rate of speed as the moving sheet of dough to be cut and for means for removing the scrap from the cut sheet, *Held* void for want of invention over the prior art and not infringed, even if valid, as to the specific mechanical means devised. ^d *J. H. Day Co. v. Mountain City Mill Co. et al.*, 421.
51. WATSON—No. 836,475—REWIRABLE SCREEN-FRAMES—INVALID IN PART AND VALID AND INFRINGED IN PART.—Claims 1 and 2 of the Watson patent, No. 836,475, for an improvement on the tubular construction of rewirable screen-frames, *Held* invalid as involving no more than the skill of a mechanic trained in the sheet-metal art, but claim 3 valid and infringed by a structure manufactured under the Higgin patent, No. 1,171,952. ^d *Higgin Mfg. Co. v. Watson et al.*, 403.
52. SAME—No. 956,239—REWIRABLE SCREEN CONSTRUCTION VALID, BUT NOT INFRINGED.—The Watson patent, No. 956,239, for rewirable screen construction, *Held* valid as involving a degree of invention over the prior art, but claims Nos. 3, 10, 11, 12, and 13 not infringed by a structure manufactured under the Higgin patent, No. 1,171,952. ^d *Id.*

PARTIES TO SUIT. See *Suits for Infringement*.

PATENT LAW. See *Construction of Statutes 2*.

PATENTEE AND APPLICANT. See *Interference*, 6, 8; *Priority of Invention*, 1.

PATENTS WITHOUT FEE. See *Construction of Statutes*, 1.

PATENTABILITY. See *Affidavits under Rule*, 75; *Claims*; *Construction of Claims*, 3; *Construction of Specifications and Patents*, 13, 14, 21; *Divisional Applications*, 3; *Double Patenting*, 2, 3; *Interference*, 13, 16; *Invention*; *Particular Patents*, 42, 43; *Reduction to Practice*, 1, 2.

PATENTABILITY—Continued.

1. **EVIDENCE—PRACTICAL RESULTS.**—A patent should not be granted on a flying-machine on the ground that it was the first device built on correct principles where admittedly it was never successfully operated and the only basis for the claim rests upon assumption and an affidavit of one who attempted a flight that it was put out of commission only through lack of skill on his part and not through any inherent defect. *Ex parte Smith*, 2.
2. **ANTICIPATION—FOREIGN PATENTS AND PUBLICATIONS.**—Patentable novelty or originality can not be asserted of a device which has previously been described in printed publications in foreign countries, although unknown to the patentee or to others in this country. (Rev. Stat., sec. 4886, ch. 391; 29 Stat., 692, p. 144; 249 Fed. Rep., 211, affirmed.) *** Bone v. Commissioners of Marion County*, 457.
3. **ANALOGOUS USE.**—The use of a device for separating parts of ground ore is so remote from that of separating the heavier and lighter parts of ground tobacco that the latter might not be suggested by the former. *Ex parte Teal*, 45.
4. **SAME.**—Apparatus for elevating and distributing wet concrete, *Held* not a mere double use of earlier apparatus for loading coal. *Concrete Appliances Co. et al. v. Meinken et al.*, 378.
5. **NEW RESULT.**—The elevation and gravity distribution of wet concrete to and around the successive floors of a building being constructed and all in a semiautomatic way is a new result in a patentable sense. *Id.*
6. **AGGREGATION.**—Apparatus for elevating and distributing wet concrete to the floors of buildings under construction, which is in a fair sense a unitary work, does not become an aggregation merely because it involves successive steps under manual control. *Id.*
7. **MODE OF OPERATION.**—A specified movement of a machine irrespective of the mechanism which causes it is not patentable. A patent can not cover the mode of operation. *Mastoras v. Hildreth*, 414.
8. **CHANGE OF MATERIAL.**—A mere change of material is not patentable. *Jennison-Wright Co. v. Hempy*, 444.

PIONEER PATENTS. See *Construction of Specifications and Patents*, 7, 12.

PLEADING. See *Preliminary Statement; Suits for Infringement*, 1.

POVERTY. See *Reduction to Practice*, 5.

POWER OF COURT. See *Appeal to the Circuit Court of Appeals*, 1; *Certiorari*, 1.

PRACTICE IN THE PATENT OFFICE. See *Interference*, 8; *Priority of Invention*, 11; *Trade-Marks*, 35.

PRELIMINARY STATEMENT. See *Amendment to Preliminary Statement; Interference*, 1, 22; *Priority of Invention*, 2.

NATURE OF.—A preliminary statement is not a mere pleading. It is the basis for taking proofs upon which opposing parties have a right to rely. *Caps v. Kennicott*, 6.

PRESUMPTION. See *Construction of Specifications and Patents*, 3; *Delay in Filing Application for Reissue*, 3.

PRIOR ADJUDICATION. See *Interference*, 13; *Suits for Infringement*, 6.

PRIOR APPLICATIONS. See *Continuation of Applications, Validity of Patents*, 2.

PRIOR INTERFERENCE. See *Interference*, 13, 23; *Testimony*.

PRIOR PATENTS. See *Affidavits under Rule 75*; *Anticipation*, 2; *Construction of Specifications and Patents*, 16; *Infringement*, 3; *Invention*, 1, 2, 4, 15, 22; *Particular Patents*, 3, 16, 17, 32, 45; *Suits for Infringement*, 7.

PRIORITY OF ADOPTION AND USE. See *Trade-Marks*, 7, 10, 12, 13, 14, 20, 41, 49, 50, 51.

PRIORITY OF INVENTION. See *Abandoned Experiments*; *Abandonment of Applications*, 2; *Anticipation*, 5; *Copending Applications*; *Construction of Claims*, 5; *Construction of Statutes*, 3; *Court of Appeals of the District of Columbia*; *Double Patenting*, 3; *Interference*, 8, 16, 17; *Particular Patents*, 9; *Reduction to Practice*, 7; *Suits for Infringement*, 8, 9.

1. **AWARD—EVIDENCE.**—Evidence reviewed and *Held* insufficient to establish that the junior party, on whom the burden of proof rested heavily as an applicant against a patentee, was the first inventor. **Bader v. Burroughs*, 114.
2. **EVIDENCE.**—Evidence considered and *Held* that S. reduced the invention to practice prior to the date of conception alleged in the preliminary statement filed by the assignee of C.'s application. **Marie E. Scheuerle, Administratrix, v. Conner*, 123.
3. **RIGHT TO TAKE TESTIMONY ON OPERATIVENESS.**—An affidavit filed by L. and H. alleging that an apparatus like that shown in V.'s earlier application, of which the application in interference is a division, had been constructed by them and had been found to be inoperative, *Held* sufficient to overcome the *prima facie* showing of V. where it appeared that V.'s earlier application was filed more than five years prior to the filing of the application of L. and H., that the subject-matter is highly technical and very decided advances in the art had been made since the filing of V.'s earlier application, and that V. did not seriously contend that his early device was operative for practical purposes, but only that it could be made so by a skilled mechanic. **Lee and Hogan v. Vreeland*, 145.
4. **SAME.**—Where it appeared that an affidavit made out a *prima facie* showing of inoperativeness of the apparatus of the early application of the senior party, in view of which judgment had been rendered in favor of him, the judgment reversed and the case remanded for trial on its merits. **Id.*
5. **EVIDENCE—DILIGENCE—REDUCTION.**—Evidence considered and *Held* that B. was the first to conceive the invention in issue and the first to reduce it to practice; also, that he was diligent just prior to S.'s entry into the field and up to the time when he constructively reduced it to practice. *Bethke v. Scannell*, 11.
6. **INTERFERENCE—EVIDENCE—AWARD.**—Evidence considered and *Held* that priority of invention was properly awarded by the lower tribunals to Bethke. **Scannell v. Bethke*, 150.
7. **ABANDONMENT OF FIRST EXPERIMENTAL DEVICE.**—Where S. constructed an experimental device relating to phonograph-stops in May, 1914, and tested it, but dismantled it and admitted that he had no intention of using it again, and soon thereafter caused an application to be prepared, but did not file it, although he was able to do so, and did nothing further until February, 1916, when he built a second device, which was submitted to a company interested in such attachments,

PRIORITY OF INVENTION—Continued.

which purchased the invention in March, 1916, after they had experimented with the invention of D., the other party to the interference, and caused S.'s application to be filed on April 5, 1916. *Held*, without determining whether S.'s device of 1914 was a reduction to practice, that S. is not entitled to prevail over D., who conceived in May and reduced to practice in June, 1914, and filed his application on April 21, 1915, since he lost his right to assert priority over D. by his long delay and conduct in abandoning his experimental device. **Duncan v. Shelly*, 155.

8. RIGHT TO MAKE CLAIMS.—Where in an interference between B. and D., relating to traffic-controlling systems, certain counts called for vehicle-controlling means having a retarding condition, B. disclosed only signals, *Held* that he had no right to make such claims, and priority awarded to D. **Day v. Bower*, 174.
9. PATENTS—ORIGINALITY.—Evidence considered and *Held* that Richards derived the invention from De Forest. **De Forest v. Richards*, 175.
10. SAME—DECISION AFFIRMED.—Evidence reviewed and the decision of the Commissioner of Patents awarding priority to Antoine and Travis on the ground that they were the first to conceive and reduce to practice affirmed. **Grover and Barber v. Antoine and Travis*, 180.
11. COUNTS BARRED TO ONE OF THE PARTIES.—Decision of the Examiners-in-Chief awarding priority to R., R., and K. as to certain counts, but recommending that the counts were barred by a prior patent to them, affirmed, following the practice authorized by the Court of Appeals of the District of Columbia in *Norling v. Hayes* (C. D., 1911, 847; 186 O. G., 1282; 37 App. D. C., 169.) *Reid, Reid, and Kelley v. Kittelman*, 28.
12. INTERFERENCE.—The decision of the Commissioner awarding certain counts to K. and others to R., R., and K. affirmed. **Reid, Reid, and Kelley v. Kittelman*, 192.
13. SAME.—Decision of the Commissioner of Patents awarding priority to R., R., and K. affirmed. **Kittelman v. Reid, Reid, and Kelley*, 191.
14. DELAY AFTER ALLEGED REDUCTION TO PRACTICE.—Delay to file an application or practice an invention for more than two years after a doubtful reduction to practice, while not a deliberate abandonment under *Mason v. Hepburn* (C. D., 1898, 510; 84 O. G., 147; 18 App. D. C., 86), indicates such laches as to avoid any advantage flowing from an earlier conception. *Maremont v. Olson*, 44.
15. INTERFERENCE.—In an interference between Brown and McIntosh priority awarded to McIntosh as being the first to conceive and constructively reduce to practice. **Brown v. McIntosh*, 199.
16. SAME.—Decision of the Assistant Commissioner of Patents awarding priority of invention to Olson affirmed. **Maremont v. Olson*, 200.
17. SAME—DILIGENCE LACKING.—Evidence considered and *Held* that Du Rell's early experiments did not amount to a reduction to practice and that as he did nothing thereafter for almost two years, while in the meantime Haley reduced the invention to practice, Haley is entitled to an award of priority. **Du Rell v. Haley*, 208.
18. SAME—DILIGENCE.—In considering the bearing of experiments made to perfect an invention on the question of diligence the test is not whether such experiments led to anything as far as benefiting the public is concerned, but whether such tests were so unnecessary as to constitute

PRIORITY OF INVENTION—Continued.

evidence of bad faith. An inventor is to be commended rather than condemned for taking reasonable time to perfect his invention. (*Griffin v. Swenson*, C. D., 1899, 440; 89 O. G., 919; 15 App. D. C., 135.) * *Gammeter v. Backdahl*, 209.

19. AWARDED TO FIRST TO CONCEIVE AND REDUCE TO PRACTICE.—In an interference contest a finding that one of the parties was prior to the other in conception and reduction to practice is a sufficient basis for an award of priority to him. In this proceeding it is unnecessary to determine what right either party ultimately might have to a patent, the only question involved being that of priority between the parties to the interference. * *Erben v. Yardley*, 220.

20. INTERFERENCE.—In an interference between H. and K. priority of invention awarded to H. on the ground that he was the first to conceive and was diligent up to the time of his reduction to practice. * *Hoenig v. Kendig*, 241.

PROCESS. See *Anticipation*, 2; *Construction of Claims*, 8, 9; *Construction of Specifications and Patents*, 7; *Diligence*, 2; *Interference*, 15; *Particular Patents*, 9, 12, 35; *Reduction to Practice* 1, 2, 3, 4, 5, 9.

PROCESS AND APPARATUS. See *Abandoned Experiments*, 4; *Particular Patents*, 9; *Reduction to Practice*, 3, 9.

PROCESS AND PRODUCT. See *Double Patenting*, 1; *Reduction to Practice*, 1, 2, 4, 8.

PRODUCT. See *Construction of Specifications and Patents*, 3; *Method and Product*; *Reduction to Practice*, 2, 8; *Suits for Infringement*, 2.

PROHIBITION LAWS. See *Trade-Marks*, 56.

PROOFS. See *Abandonment of Applications*, 3; *Amendment to Preliminary Statement*, 1; *Anticipation*, 4, 5; *Interference*, 17; *Preliminary Statement*; *Reduction to Practice*, 6; *Renewal of Forfeited Application*.

PROPERTY RIGHTS. See *Trade-Marks*, 11, 25, 26.

PUBLIC INSIGNIA. See *Trade-Marks*, 39.

PUBLIC PROPERTY. See *Claims*, 2.

PUBLIC USE AND SALE. See *Abandonment of Applications*, 2, 3; *Construction of Specifications and Patents*, 3; *Construction of Statutes*, 2; *Interference*, 6; *Jurisdiction of the Court of Appeals of the District of Columbia*; *Particular Patents*, 18; *Reduction to Practice*, 6; *Reissues*.

PUBLIC-USE PROCEEDINGS.

1. REOPENING TO TAKE FURTHER TESTIMONY.—In public-use investigations the public, the Patent Office, and all parties concerned have a common interest in seeing to it that an invalid patent shall not issue. In such cases the same degree of diligence is not required to be shown in the discovery of evidence in order to reopen the proceedings for the taking of further testimony. *Abercrombie v. Ringel v. Angier v. Taylor and Hepp*, 80.
2. ORAL INTER PARTES HEARING.—In public-use proceedings ordinarily an oral *inter partes* hearing will not be given, but briefs may be filed, (*in re Townsend*, C. D., 1913, 55; 188 O. G., 513;) but where the interested parties are involved in an interference proceeding, suspended for the purpose of investigating public use, so that all parties have access to the applications of all other parties, an oral *inter partes* hearing will be permitted. *Abercrombie v. Ringel v. Angier v. Taylor and Hepp*, 82.

PUBLICATIONS. See *Anticipation*, 3; *Construction of Statutes*, 4; *Construction of Specifications and Patents*, 6; *Jurisdiction of the Court of Appeals*; *Patentability*, 2; *Suits for Infringement*, 7; *Validity of Patents*, 2.

RECORD OF CASE. See *Suits for Infringement*, 2.

RECORDS OF THE PATENT OFFICE. See *Final Fees*.

REDUCTION TO PRACTICE. See *Abandoned Experiments*; *Abandonment of Applications*, 2, 3; *Abandonment of Invention*, 1; *Construction of Statutes*, 3; *Diligence*; *Divisional Applications*, 2; *Priority of Invention*, 2, 5, 7, 10, 14, 15, 17, 19, 20; *Renewal of Forfeited Applications*.

1. **NECESSITY OF TEST.**—Where the invention in issue constituted an important step in the art of hog-cholera treatment, covering both a process and a product, nothing short of a successful test could meet the legal requirements of a reduction to practice. * *Reichel v. Dorset*, 123.
2. **DELAY IN—EXCUSE INSUFFICIENT.**—A delay of a year in making a test of a product designed to prevent hog cholera after it was alleged to have been obtained may not be excused on the ground that the inventor was working under orders as a Government official and was not at liberty to lay aside his assigned work, where all that was necessary and all that he did to make the test was to send it to an experiment station, particularly where other circumstances indicated that the real cause of delay was that he did not think his process was patentable until the activity of his adversary was brought to his attention. * *Id.*
3. **INTERFERENCE—APPLICATION FOR APPARATUS CONSTRUCTIVE REDUCTION TO PRACTICE OF PROCESS.**—An application for an apparatus clearly disclosing a process is a constructive reduction to practice of the process. *Bethke v. Scannell*, 11.
4. **SAME — PROCESS — NECESSITY OF TESTING PRODUCT PRODUCED.**—*Quære*: Whether the practice of a process for making a cord tire which involved "winding the cord spirally around a support to reduce a fabric web, and thereafter shifting said cord to change the angle of the cord element relative to the sides of said web," without embodying the web so formed into a tire, is a reduction to practice. * *Dickinson v. Swinehart*, 151.
5. **EXCUSE FOR FAILURE—POVERTY.**—A claim of financial inability to file an application for patent, *Held* not sustained where it appears that during the period of such alleged inability the inventor had no one dependent upon him, was employed most of the period, and purchased a motor cycle and was paying for the same in monthly instalments. * *Duncan v. Shelly*, 155.
6. **MACHINES SOLD, BUT NO DIRECT EVIDENCE OF SUCCESSFUL OPERATION.**—Where a party to an interference proves the construction of a device embodying the issue and the testimony is to the effect that a large number of machines of the same construction were made and sold prior to the reduction to practice of the opposing party, names and addresses of persons to whom they were shipped being given, *Held* that the testimony proves a prior reduction to practice in the absence of controverting evidence showing that the machines so alleged to have been sold were not reductions to practice. *Antoine and Travis v. Grover and Barber*, 18.
7. **INTERFERENCE—OPERATIVENESS.**—Where the counts of a three-party interference originated in an application where automatic operation was not contemplated and related to a subordinate part of the entire ma-

REDUCTION TO PRACTICE—Continued.

chine, which application dropped out of the interference after the decision of the Examiner of Interferences, judgment of priority in favor of one of the remaining parties should not be based on the theory that the other party's machine was not operative as a whole and was therefore not a reduction to practice because it would not perform its functions automatically. * *Cox v. Headley and Thompson*, 183.

8. SAME—SAME.—That the device disclosed by one of the parties increases the cost of manufacture and produces a product not readily salable is not sufficient to justify a holding that such device is inoperative. *Kitselman v. Reid, Reid, and Kelley*, 26.
9. PROCESS—EXPERIMENTAL MODEL.—The rules governing the reduction to practice of a process are similar to those for the reduction to practice of an apparatus. The process should be performed in a way that leaves no doubt as to its commercial practical working. *Held*, therefore, that a process carried out with an experimental model was not a reduction to practice. *Haley v. Du Rell*, 53.
10. INTERFERENCE—SIMPLE DEVICE.—A two-part insulation having means for holding the parts in assembled relationship is of such a simple nature that it needed no test to show that it would do what was claimed for it. * *Hoenig v. Parker*, 234.

REGISTRATION OF TRADE-MARKS. See *Trade-Marks*.

REISSUES. See *Construction of Specifications and Patents*, 4, 21; *Delay in Filing Applications for Reissue*, 1; *Particular Patents*, 29, 45 47.

REASONABLE TIME—INTERVENING RIGHTS.—A delay of about nine months in filing an application for reissue (Reissue No. 14,049, to Tufford) *Held* reasonable, no patents having been taken out or applied for and no manufacture or sale of a similar device having occurred in the interval. * *Fetzer & Spies Leather Co. v. I. T. S. Rubber Co.*, 274.

REJECTION OF CLAIMS. See *Affidavits under Rule 75; Amendment of Claims; Claim*, 6, 9, 10; *Construction of Claims*, 9.

RENEWAL OF FORFEITED APPLICATIONS. See *Abandonment of Invention* 2; *Estoppel*, 2.

ENTITLED TO BENEFIT OF DATE OF ORIGINAL.

A renewal application, although filed twenty-three months after the allowance of the original application, is entitled to the benefit of the filing date of the original as a constructive reduction to practice, notwithstanding the fact that another had been granted a patent for the same invention during the period of forfeiture, in the absence of proof of facts showing an abandonment of the invention. * *Wells and Hunter v. Honigmann*, 242.

REOPENING OF INTERFERENCE. See *Interference*, 7, 8, 17, 18, 22.

REQUIREMENTS OF THE PATENT OFFICE. See *Trade-Marks*, 34.

RES ADJUDICATA. See *Interference*, 7, 13, 14.

RESULTS. See *Construction of Specifications and Patents*, 9; *Interference*, 15; *Invention*, 5; *Patentability*, 1; *Scope of Patent*.

RIGHT TO ASSERT PRIORITY. See *Priority of Invention*, 7.

RIGHT TO MAKE CLAIMS. See *Interference*, 3, 4, 7, 9, 11, 12, 24. *Priority of Invention*, 8.

RIGHT TO PATENT.

See *Abandonment of Applications*, 2, 8; *Priority of Invention*, 19.

RIGHTS OF APPLICANT. See *Divisional Applications*.

RIGHTS OF HOLDER OF LEGAL TITLE OF PATENT.

TO PROSECUTE APPEAL INDEPENDENT OF EXCLUSIVE LICENSEE.—Where suit was brought by the legal owner of a patent, joined with an exclusive licensee holding a license containing a provision that if the patent should be held invalid or should be held to infringe other patents the licensee should have the right to surrender the agreement and should not thereafter be obliged to pay royalties, and the district court held the patent invalid, upon refusal of the licensee to appeal the legal owners have sufficient interest in maintaining the validity of the patents to entitle them to prosecute an appeal, although the patent had expired and no injunction could be granted. *4 Bellows and Slack v. New York Central Railroad Company; Same v. Pressed Steel Car Company, 362.*

ROYALTIES. See *Construction of Statutes, 1; Rights of Holder of Legal Title of Patent.*

RULES OF THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA. See *Appeal to the Court of the District of Columbia.*

SCOPE OF CLAIMS. See *Claims, 10.*

SCOPE OF PATENT.

EFFECT OF FAILURE TO STATE MODE OF OPERATION OF DEVICE.—A patentee's failure to state in the patent the new mode of operation which his device in fact contains and which produces a new and beneficial result does not prohibit the court from taking these merits into consideration in determining the scope of the invention or the validity of the patent.

6 I. T. S. Rubber Co. v. Panther Rubber Mfg. Co., 283.

SECOND APPLICATION. See *Continuation of Applications.*

SEPARATE PATENTS. See *Method and Product, 2; Particular Patents, 9.*

SIMILARITY OF TRADE-MARKS. See *Trade-Marks, 1, 2, 17, 18, 40, 49, 50, 51, 54.*

SOLE APPLICANT. See *Joint Application, One Applicant Not Inventor.*

SPECIFICATIONS. See *Abandonment of Applications, 1; Anticipation, 3; Claims, 2; Construction of Claims, 1, 4, 19; Construction of Specifications and Patents, 1, 4; Delay in Filing Application for Reissue, 1, 2; Disclosure of Invention, 1; Expert Testimony; Particular Patents, 10; Suits for Infringement, 9.*

CRITICISM OF ENGLISH CONSTRUCTION.—It is not deemed necessary for the Examiner to specifically point out all inaccuracies in the use of the English language, such as the use of or the omission of indefinite or definite articles, unless confusion would arise from leaving the specification as written. *Ex parte Humphrys, 70.*

STATE OF THE ART. See *Amendment of Claims; Construction of Claims, 3, 8; Construction of Specifications and Patents, 7, 10, 11; Copending Applications; Double Patenting, 1; Earlier and Later Patents; Equivalents, 2; Expert Testimony, 2; Invention, 1, 2, 4, 7, 11, 14, 15, 16, 22, 26; Particular Patents, 2, 6, 14, 28, 42, 46, 50, 52; Priority of Invention, 3; Validity of Patents, 2, 3.*

STATUTORY BAR. See *Interference, 16; Jurisdiction of the Court of Appeals of the District of Columbia.*

SUBSTITUTE APPLICATIONS. See *Continuation of Applications.*

SUBSTITUTION OF EQUIVALENTS. See *Invention, 15.*

SUBSTITUTION OF MATERIAL. See *Invention, 8, 9, 10, 11; Patentability, 8.*

SUBSTITUTION OF MEANS. See *Invention, 1, 26.*

SUFFICIENCY OF DISCLOSURE. See *Disclosure of Invention; Particular Patents*, 1.

SUFFICIENCY OF EXCUSE. See *Amendment to Preliminary Statement*, 2; *Delay in Filing Applications for Reissue; Reduction to Practice*, 2.

SUFFICIENCY OF DESCRIPTION. See *Construction of Specifications and Patents*, 1.

SUFFICIENCY OF RESPONSE. See *Abandonment of Applications*, 1.

SUITS FOR INFRINGEMENT. See *Certiorari*, 3; *Expert Testimony*, 2; *Infringement*, 6, 7; *Laches; Rights of Holder of Legal Title of Patent*.

1. DEFENDANT.—In a suit against a corporation for infringement of patent the president and general manager, in active control of the corporate affairs, may be made defendant, so that he may be personally bound and enjoined. ^d *D'Arcy Spring Co. et al. v. Marshall Ventilated Mattress Co.*, 246.

2. LATE INTRODUCTION OF EVIDENCE—CONDITIONS OF PERMISSION.—In suit for infringement of patent where, after direction of the usual interlocutory decree on finding of infringement, defendants present foreign patents said to anticipate plaintiff's product and ask leave to apply to reopen the case and put them into the record on account of the public interest and the interest of the courts the proposed evidence will be permitted to be brought into the record on defendants' meeting additional expenses of another trial, their showing to excuse failure to put in the evidence in due time not being satisfactory. ^d *Dunn Wire-Out Lug Brick Co. v. Toronto Fire Clay Co. et al.*, 259.

3. NOT BARRED BY LACHES.—A delay of four or five years after defendant's device was placed on the market *Held* not such laches as barred a suit for infringement. ^d *Eolian Co. v. Schubert Piano Co.*, 304.

4. PATENTS—MOTION FOR FINAL DECISION ON MERITS.—Where plaintiff obtained a decree from a district court of Ohio affirming the validity and restraining infringement of its patent for mechanical toys, also restraining unfair competition in making and selling such toys, and infringement of copyright on its trade catalogue, and, pending appeal by defendant, brought suit against defendant's customer in New York for like infringement, wherein an interlocutory decree was given in plaintiff's favor, based upon affidavits, from which defendant in that suit appealed to the Circuit Court of Appeals of the Second Circuit, pending which the Circuit Court of Appeals of the Sixth Circuit reversed the final decree as to infringement of the patent, but otherwise affirmed the decree, whereupon plaintiff withdrew the patent from the New York suit, upon denial of a motion brought after argument, but before determination of the appeal from the preliminary order for final decision on the merits on the ground that the decree in the sixth circuit was final and conclusive, *Held* that the denial of the motion was proper, as the defendant was entitled to his day in court, with opportunity to set up and establish his defenses. ^{**} *Meccano Limited v. John Wanamaker, New York*, 478.

5. JUDGMENT—PATENTS.—A corporation employing counsel appearing for defendant in a patent infringement suit and conducting the defense at its own cost and expense is a privy to any judgment rendered and bound thereby, but was not required to become a party to the record. ^b *Van Kannel Revolving Door Co. v. Winton Hotel Co.*, 99.

6. PRELIMINARY INJUNCTION.—While an application for preliminary injunction in a suit for infringement is addressed to the discretion of

SUITS FOR INFRINGEMENT—Continued.

the court, where the validity of the patent has been sustained by many prior adjudications and infringement is clear its refusal would be error. *Imperial Machine & Foundry Corporation v. G. S. Blakeslee & Co.*, 368.

7. ANSWER HELD TO SUFFICIENTLY ALLEGE PRIOR PATENT AS ANTICIPATION.—An allegation in the answer in a patent infringement suit that all the substantial and material parts of plaintiff's structure were, prior to the date of the alleged discovery or invention thereof, or more than two years prior to the date of the applications, invented, patented, described, and shown in numerous patents and printed publications, and more particularly in certain patents mentioned, including one to B., sufficiently pleaded the patent to B. as an anticipation. *Higgin.Mfg. Co. v. Watson et al.*, 403.
8. OMISSION OF INVENTOR'S ADDRESS.—In a patent infringement suit notice of the defense of prior invention by G. was not insufficient, though G.'s address was omitted, where the notice identified him as the president of one of the defendants, a corporation which bore his name. *J. H. Day Co. v. Mountain City Mill Co. et al.*, 421.
9. ANTICIPATION AND PRIORITY OF INVENTION NOT INCONSISTENT.—In a patent infringement suit the finding that plaintiff's invention was anticipated by a machine manufactured by G. and a finding of priority of invention as disclosed by G.'s patent specification and claims were not inconsistent. *Id.*

SUITS UNDER SECTION 4915, REVISED STATUTES. See *Trade-Marks*, 21.

1. TIME FOR FILING.—Where a patent on an application is refused by the Court of Appeals of the District of Columbia and the applicant files a bill in equity under section 4915, Revised Statutes, the year within which the bill must be filed begins to run from the date of the decision of the court, and this time is not extended by a motion for rehearing. *Mattullath Aeroplane Company v. Newton, Commissioner of Patents*, 97.
2. NATURE OF ACTION—NOT AN APPEAL.—An action taken under the provisions of section 4915 is not an appeal from the Commissioner of Patents, but is one of original equity jurisdiction. *Id.*

SUPREME COURT OF THE UNITED STATES. See *Certiorari*; *Estoppel*, 1; *Interference*, 8.TEN-YEARS CLAUSE. See *Trade-Marks*, 25.TERMINOLOGY. See *Construction of Claims*, 1; *Construction of Specifications and Patents*, 15, 19, 20; *Construction of Statutes*, 3; *Equivalents*; *Trade-Marks*, 9, 29.

CLAIMS—"PROPELLING MEANS."—The objection that an air-draft is not a "propelling mechanism" Held to be not well taken, as an air-draft is a well-known propelling means and is recognized as an equivalent of a strictly structural propelling means. *Ex parte, Teale*, 45.

TEST. See *Abandoned Experiments*; *Infringement*, 10; *Invention*, 17, 19; *Patentability*, 1; *Priority of Invention*, 7, 18; *Reduction to Practice*, 1, 2, 4, 10; *Trade-Marks*, 18.

TESTIMONY. See *Abandoned Experiments*, 2, 8; *Interference*, 6, 7, 17, 18, 23; *Priority of Invention*, 3; *Public Use Proceedings*, 1; *Reduction to Practice*, 6; *Trade-Marks*, 10, 53.

PRIOR INTERFERENCE.—The testimony taken in a prior interference of witnesses called in behalf of one of the parties cannot be admitted in a

TESTIMONY—Continued.

pending interference between the same parties for the purpose of impeaching them where proper foundation was not laid therefor by confronting them with the previous testimony. *Moyer v. Anglada*, 86.

TRADE-MARKS.

1. SIMILARITY—"BIG CHIEF" AND "ARAB."—A mark consisting of the words "Big Chief," associated with the representation of a man on horseback, inclosed within a circle, *Held* deceptively similar to a mark consisting of the word "Arab," associated with the representation of a man on horseback, inclosed within two circles. **American Feed Milling Co. v. M. C. Peters Mill Co.*, 113.
2. SAME—"FROM THE LAND OF SUNSHINE" AND "BLOSSOM AND SUNSHINE."—A mark consisting of the words "From the Land of Sunshine" *Held* not deceptively similar to a mark consisting of the words "Blossom and Sunshine," associated with the representation of blossoms and a sunburst. **L. Otzen & Co. v. The J. K. Armsby Co.*, 118.
3. DESCRIPTIVENESS—"SAFETSEAL," FOR ENVELOPS.—The mark "SafeTseal" as applied to envelopes *Held* descriptive, as indicating either safety-seal envelopes or safe-seal envelopes. **In re Alvah Bushnell Company*, 112.
4. SAME—"EVERLASTING," FOR VEHICLE-WHEELS.—The word "Everlasting" *Held* descriptive, and therefore not registrable as a trade-mark for vehicle-wheels. This word expresses aptly the idea that applicant's wheels will last a very long time, and therefore cannot be monopolized. *Ex parte Smith Wheel, Inc.*, 1.
5. ANTICIPATION—"EL GALLO" (THE ROOSTER) ANTICIPATED BY "OUR ROOSTER" AND PICTURE OF A ROOSTER.—The Spanish words "El Gallo," meaning "The Rooster," as a trade-mark for tobacco, refused registration in view of the prior registration by another concern of the words "Our Rooster" and a picture of a rooster. **In re Maclin-Zimmer-McGill Tobacco Company, Incorporated*, 133.
6. REGISTRABILITY—FOREIGN LANGUAGE.—A trade-mark otherwise not registrable is not made so because it is written in the Spanish language instead of English. **Id.*
7. CLASS OF MERCHANDISE—BREAKFAST FOODS AND CANDY.—The general and essential characteristics of breakfast foods and candy are different, and the first to adopt and use the mark "Krumbles" for a cereal breakfast food has no right to extend it to candy as against one who shows an intermediate adoption and use of "Golden Crumbles" for candy. **Paul F. Beich Company v. Kellogg Toasted Corn Flakes Company*, 119.
8. REGISTRABILITY—DESCRIPTIVE MARK—CANCELATION OF DESCRIPTIVE ELEMENT.—Where the words "Unit Carrier," for roller-brackets for belt conveyers, were refused registration because descriptive, the refusal by the Commissioner of an application for leave to strike out the word "Carrier" was error. (*In re Beckwith*, C. D., 1913, 179; 252 O. G., 245; 48 App. D. C., 110.) **In re Stephens-Adamson Manufacturing Company*, 147.
9. DESCRIPTIVENESS AND SUGGESTIVENESS—"UNIT" MERELY SUGGESTIVE.—Although a mark to be suggestive must contain some element of descriptiveness, this does not render it obnoxious to the law. The word "Unit," for roller-brackets for belt conveyers, *Held* merely suggestive, and therefore registrable. **Id.*

TRADE-MARKS—Continued.

10. **PRIORITY—EVIDENCE OF PRIORITY.**—Where appellant, The R. M. Hollingshead Co., proved use of the mark "Gear Life" for lubricating compounds not earlier than April, 1916, and a witness on behalf of appellee, the Area Manufacturing Co., testified that in August, 1915, packages of grease were shipped bearing this mark stenciled thereon, and way-bills of shipments were produced, though not referring to the mark, and a traveling salesman testified that he took orders for "Gear Life" compound between February 1, 1916, and the following May, and that during this time he stenciled the mark on packages containing the compound and gave the names of parties to whom the goods were sold, which evidence was corroborated by other witnesses, and appellant did not avail himself of the opportunity to call any of the parties referred to in the way-bills or to whom the goods were alleged to have been sold, *Held* that the evidence was sufficient to prove priority of use by appellee. * *The R. M. Hollingshead Co. v. Area Manufacturing Co.*, 154.
11. **ACQUISITION—EXTENT OF USE NECESSARY.**—The use of a mark on a few sample-boxes of toilet powder, three of which were consigned to dealers in different parts of the country without previous request by them, for which there was paid only five cents for a box intended to sell at fifty cents, does not constitute such a use of the mark as to establish any property rights therein. * *Phillips v. Hudnut and Mack*, 164.
12. **SAME—GENERAL RULES AS TO ACQUISITION.**—The common law, and not the trade-mark statutes, defines what constitutes a trade-mark. The trade-mark recognized by the common law is generally the outgrowth of a considerable period of use rather than a sudden invention. The exclusive right to it grows out of its use and not its mere adoption. (*Trade Mark Cases*, C. D., 1879, 619; 16 O. G., 999; 100 U. S., 82.) The trader must apply the mark to a vendible commodity and must actually put the commodity so marked on the market. * *Id.*
13. **APPEAL AND ERROR—QUESTIONS FOR REVIEW.**—In a trade-mark interference proceeding involving the three parties H., M., and P., where it is adjudged by the Patent Office that H. was the first to adopt and use the mark, on appeal by P. to the court of appeals he is not entitled to be heard on the question whether the decision properly awarded priority to H. over M. * *Id.*
14. **SAME—REVIEW OF QUESTION NOT APPEALED.**—In a three-party interference involving the application of H. and the registrations of M. and P., the Examiner of Interferences held that the marks were the same and awarded priority to H. After the decision was announced H. filed a motion requesting the Examiner of Interferences to adjudge that P. was not entitled to the use of the mark at the date of his application for registration, which was denied, from which H. failed to appeal. On P.'s appeal the Commissioner reviewed this action and reversed it, ordering the cancelation of P.'s registration. This was error, as H. did not appeal, and the question was therefore not before the Commissioner. * *Id.*
15. **DESCRIPTIVE WORDS—"LAVA," FOR SOAP.**—The word "Lava," for soap, *Held* not descriptive. It may suggest the function of soap, being derived from "lavare," to wash, and meaning, in English, fluid rock; but it does not describe its properties. (*In re Stephens-Adamson Mfg. Co.*, ante, 147; 272 O. G., 181; 49 App. D. C., 147.) * *William Walke & Company v. Geo. H. Schafer & Company*, 187.

TRADE-MARKS—Continued.

16. **GOODS OF THE SAME DESCRIPTIVE PROPERTIES—SOAP AND SHAVING-CREAM.**—The owner of a mark for toilet soap has a right to extend it to shaving-cream, since in the popular mind a shaving-cream is a soap. * *Id.*
17. **IDENTITY OF MARKS—"U-LAVO" SIMILAR TO "LAVA."**—The word "U-Lavo" conflicts with "Lava," the prefix "U-" being only an arguable distinction which is not sufficient. * *Id.*
18. **SAME—GENERAL TEST OF IDENTITY.**—The test of the identity of trade-marks is not whether the words mean the same thing, but whether they are so similar in sound and appearance as to lead the public to believe that the goods on which they appear had a common origin. Conflict exists where a purchaser seeing only one and relying upon his memory of the other would likely fail to recognize the distinction, although he would do so could he see the two together. * *Id.*
19. **OPPOSITION—NOT NECESSARY TO SHOW DAMAGE TO OPPOSER.**—In order to succeed in a trade-mark opposition proceeding, it is not necessary that opposer establish damages, it being sufficient to show likelihood of confusion or mistake in the mind of the public. * *Id.*
20. **REGISTRATION—DOUBTS RESOLVED AGAINST NEWCOMER.**—Where there is doubt as to the right to register a mark in view of rights previously acquired, it should be resolved against the newcomer, since there is no excuse for a later comer to impinge upon prior rights in view of the unlimited field from which a mark may be selected. * *Id.*
21. **SUIT UNDER SECTION 4915, REVISED STATUTES—JURISDICTION.**—In a suit brought under section 4915, Revised Statutes, against the Commissioner of Patents to obtain registration of a trade-mark, where there is diversity of citizenship of the parties, although neither is a resident of the district where suit is brought, jurisdiction exists where defendant consents to the suit. * *Hercules Powder Company v. Newton, Commissioner of Patents, 340.*
22. **REGISTRATION—RIGHT GOVERNED ALONE BY STATUTORY PROVISIONS.**—Upon application to register a trade-mark where the question presented is whether the mark is descriptive, and hence not registrable under the statutes, the value of the mark or the fact that dealers and buyers of the goods to which it has been applied do not associate it with the goods except as indicative of origin is immaterial and tends only to prove rights which should be protected from unfair competition. * *Id.*
23. **SAME—DESCRIPTIVENESS OF MARK QUESTION OF LAW.**—Upon application to register a trade-mark the question whether it is descriptive is a legal one where there are no contradictions of fact or contradictory inferences of fact. (*Gold v. Newton, C. D., 1918, 310; 256 O. G., 649; 254 Fed. Rep., 824, distinguished.*) * *Id.*
24. **WHAT IS A REGISTRABLE MARK NOT DEFINED BY STATUTE.**—The trade-mark statute (act of 1905, 33 Stat., 724), as amended, does not describe or define what constitutes either a good trade-mark or a registrable trade-mark. It assumes that the word has a meaning sufficiently well known to dispense with statutory definition. It does, however, lay down some rules for the guidance of the Commissioner, among which is the provision that "no mark which consists * * * merely in words * * * which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered." * *Id.*

TRADE-MARKS—Continued.

25. RIGHTS ACQUIRED BY TEN YEARS' EXCLUSIVE USE.—The Trade-Mark Act of 1905 (33 Stat., 724) in the so-called "ten-year clause" recognized, if it did not create, a property right previously doubtful, if not wholly nonexistent; but it does not give similar rights to one who has exclusively used a merely descriptive or geographical mark for ten years expiring after the passage of the act. *Id.*
26. WHAT MAY NOT BE APPROPRIATED.—"No sign or form of words can be appropriated as a valid trade-mark which from the nature of the fact conveyed by its primary meaning others may employ with equal truth, and with equal right, for the same purpose." (*Standard Paint Co. v. Trinidad Asphalt Co.*, C. D., 1911, 530; 165 O. G., 971; 220 U. S., 446.) *Id.*
27. DESCRIPTIVE MARKS—"MERELY" DESCRIPTIVE.—"Merely descriptive" (Trade-Mark Act of 1905, section 5 (b)) means *only* descriptive, or nothing more than descriptive. It may be that the force of the adverb is satisfied by the addition to the descriptive word of a picture or device, or by qualifying the description through the addition of another word. * * * But if the proposed trade-mark consists of a single word, then that word standing alone is merely descriptive, or it is not descriptive at all. *Id.*
28. "INFALLIBLE," FOR SMOKELESS POWDER, MERELY DESCRIPTIVE.—The word "Infallible," as applied to smokeless powder, *Held* merely descriptive. Perhaps, when accurately used, it refers always to mental processes, but in common acceptance it means "exempt from uncertainty" or "absolutely trustworthy." *Id.*
29. SUGGESTIVENESS AND DESCRIPTIVENESS DISTINGUISHED.—"The difference between suggestion and description is often hard to perceive. An explosive powder marked as 'Hercules' would be suggestive, and no person other than its maker could with equal right and equal truth call his powder by that name or any derivation therefrom; but 'Infallible' is merely descriptive because it has no association with the Hercules Company other than that acquired by a long course of business nomenclature." *Id.*
30. ACT OF 1905, SECTION 5 CONSTRUED—MARKS MERELY DESCRIPTIVE.—In the Trade-Mark Act of 1905 (33 Stat., 724) the proviso of section 5 that "no mark which consists * * * merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods * * * shall be registered" is simply an expression in statutory form of the prior general rule of law that words merely descriptive are not a proper subject for exclusive trade-mark appropriation. *** Beckwith v. Commissioner of Patents*, 471.
31. SAME.—The requirement of the act of 1905, section 5, that "no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless, etc.," is just as imperative as the prohibition of the proviso against registration in cases specified. *** Id.*
32. REGISTRATION—LIBERAL ATTITUDE SHOULD BE ADOPTED.—"Of course, refusal to register a mark does not prevent a former user from continuing its use, but it deprives him of the benefits of the statute, and this should not be done if it can be avoided by fair, even liberal, con-

TRADE-MARKS—Continued.

- struction of the act, designed as it is to promote the domestic and foreign trade of our country." ** *Id.*
33. COMPOSITE MARKS CONTAINING DESCRIPTIVE TERMS—REGISTRATION NOT PROHIBITED.—A composite mark, including arbitrary matter and a descriptive term forming a definitely positioned part of the mark, does not fall within the terms of the statute, since such a mark does not consist merely ("only") of descriptive words. ** *Id.*
34. SAME—REQUIREMENT TO DELETE DESCRIPTIVE WORDS IMPROPER.—The requirement that descriptive words constituting part of a composite mark be deleted as a prerequisite to registration *Held* improper, since such deletion would often result in so changing the mark sought to be registered from the form in which it had been used in actual trade that it would not be recognized as the same mark. ** *Id.*
35. SAME—PRACTICE OF ALLOWING DISCLAIMERS APPROVED.—"While there is no specific provision for disclaimers in the trade-mark statute, the practice of using them is commended to our judgment by the statement of the Commissioner of Patents that, so far as known, no harm came to the public from the practice of distinguishing, without deleting, non-registrable matter in the drawing of the mark as registered, when a statement, forming a part of the record, was required that the applicant was not making claim to an exclusive appropriation of such matter except in the precise relation and association in which it appeared in the drawing and description." ** *Id.*
36. DESCRIPTIVE WORDS—"MOISTAIR HEATING SYSTEM."—The words "Moist-air Heating System" applied to "hot air and combined hot air and hot water heaters and furnaces" are merely descriptive of a claimed property or quality of applicant's heating system, that by it moisture is imparted to the air in the process of heating. ** *Id.*
37. SAME—COMPOSITE MARK—REGISTRATION.—A trade-mark for heating systems consisting of certain arbitrary matter and the descriptive words "Moistair Heating System" *Held* registrable if an appropriate disclaimer of the descriptive words be made by the applicant. ** *Id.*
38. REGISTRATION.—A non-intoxicating cereal beverage containing no malt or alcohol, *Held* to constitute goods of the same descriptive properties as a "near beer" beverage. * *Christo Manufacturing Company v. The Christian Moerlein Brewing Company*, 189.
39. PUBLIC INSIGNIA—"U. S." NOT REGISTRABLE.—The meaning of "U. S." is too clearly established to permit of registration of any mark containing it as the most prominent feature in view of the provisions of section 5 of the Trade-Mark Act of 1905, denying registration to any mark which "consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof or of any State or municipality, or of any foreign nation." * *In re United States Rubber Company*, 39.
40. SIMILARITY—"WHITE LILY"—"LILY WHITE."—"White Lily" and "Lily White" are so similar as to be likely to lead to confusion. * *R. H. Macy & Company v. New York Grocery Company*, 201.
41. SAME—COFFEE AND TEA.—Registration of the words "White Lily" for coffee canceled in view of the prior use of "Lily White" on tea and other groceries, the goods, although different in themselves, being used for the same purpose. * *Id.*

TRADE-MARKS—Continued.

42. **DESCRIPTIVE.**—A mark for instep-support consisting of a representation of the outline of a shoe broken away at the bottom and disclosing at the portion broken away an arch-support supported by the thumb, index and middle fingers of a hand, *Held* merely descriptive; *Held* also that even if it were permissible to disclaim the representation of the arch-support it would still be descriptive. * *In re Scholl Manufacturing Company, Inc.*, 206.
43. **REGISTRATION.**—Registration of a mark for instep-supports consisting of a representation of the outline of a shoe broken away at the bottom and disclosing at the portion broken away an arch-support supported by the thumb, index and middle fingers of a hand, *Held* not registrable upon disclaimer of the representation of the arch-support, because what is left would not be the mark which had been used and because the remaining part of the mark is also descriptive. * *Id.*
44. **EVIDENCE OF EXTENSIVE USE.**—Evidence of extensive use of a mark or that several traders have not heard of its use by others does not tend to prove in the least that it is not descriptive. * *Id.*
45. **ACT OF MARCH 19, 1920, CONSTRUED—MARKS REGISTRABLE UNDER ACT OF 1905 NOT REGISTRABLE UNDER SECTION (b).**—Marks which are registrable under the Trade-Mark Act of February 20, 1905, are not registrable under section (b) of the act of March 19, 1920. ° *Opinion of the Solicitor of the Department of the Interior*, 89.
46. **SAME—MARKS NOT REGISTRABLE UNDER SECTION (b).**—In the act of March 19, 1920, providing that the Commissioner shall keep a register of "(b) all other marks not registrable under the act of February 20, 1905, as amended, except those specified in paragraphs (a) and (b) of section 5 of that act," etc., the provision "except those specified in paragraphs (a) and (b)" was intended to include those scheduled under (a) as consisting of or comprising immoral and scandalous matter and those scheduled under (b), consisting of or comprising the flag or coat-of-arms or other insignia of the United States, States, municipalities, or foreign nations, and designs, etc., adopted by fraternal and other societies. ° *Id.*
47. **SAME—PROVISO CLAUSE OF SECTION 1 (b) CONSTRUED.**—The proviso clause of section 1 (b) of the act of March 19, 1920, construed as if it read: "Provided, That trade-marks which are so nearly identical with a known trade-mark owned and used in interstate and foreign commerce, or commerce with the Indian tribes by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, shall not be placed on this register." ° *Id.*
48. **SAME—TRANSFER OF FILING FEE FROM ONE APPLICATION TO ANOTHER.**—The filing fee of ten dollars paid in connection with an application filed under the act of February 20, 1905, may be transferred to an application for registration under the act of March 19, 1920. ° *Id.*
49. **SAME—SIMILARITY**—"RAY-O-LITE" and "PREST-O-LITE."—The word "Ray-O-Lite," or storage batteries, *Held* not registrable in view of the prior use of "Prest-O-Lite" on the same goods. * *French Battery & Carbon Company v. The Prest-O-Lite Company, Inc.*, 214.
50. **SAME—SAME—REGISTRATION BY OTHERS OF SIMILAR MARKS.**—*Held* that "Ray-O-Lite" may be registered for electric lamps notwithstanding the prior use by the opposer of "Prest-O-Lite" on storage batteries

TRADE-MARKS—Continued.

where other marks about as near to "Prest-O-Lite" as is "Ray-O-Lite" had been registered by others for electric lamps prior to its use by the opposer for storage batteries. * *Id.*

51. **RIGHT TO PREVENT REGISTRATION OF "PLAY-O-LITE" IN FIELD OCCUPIED BY SIMILAR MARKS.**—Where opposer adopted the mark "Prest-O-Lite" in 1904 for use on gas-tanks, and did not extend its use to storage batteries until 1915, it is not entitled to successfully maintain opposition to the registration of "Play-O-Lite," adopted by applicant in 1917 for electric lamps, where others had adopted and used the words "Lino-lite," "Tubolite," "Portallite," and "Pract-El-Lite" prior to opposer's extension of its mark to storage batteries and had registered the same. * *The Prest-O-Lite Company, Inc., v. Play-O-Lite Company, Inc.*, 231.

52. **USE NECESSARY TO ESTABLISH RIGHT TO REGISTRATION.**—Use of a trade-mark in interstate commerce or in commerce with foreign nations or with Indian tribes is a prerequisite to its registration, and the use contemplated is use by the applicant himself or by some one for him and not an independent or incidental use by a third party. Hence where persons outside the State of California, where appellee was doing business, procured appellee's goods in California and had them sent outside that State appellee could take no benefit from such transaction, and the business being otherwise local appellee failed to show the requisite use. * *H. Kuhn & Sons (Inc.) v. Letts*, 232.

53. **EVIDENCE OF INTERSTATE USE—SUFFICIENCY—TAKING ADDITIONAL TESTIMONY.**—Where in a trade-mark interference proceeding, an applicant is refused permission by the Commissioner to take further testimony to prove interstate commerce on the ground that the testimony in the case shows such use, and on appeal the court concluded that the testimony is insufficient for this purpose, although such use is alleged in the declaration, *Held* that the denial of the request to take further testimony was error, and the case reversed and remanded with directions to permit the introduction of the same. * *Id.*

54. **SIMILARITY—"ESCO" AND "CRISCO."**—The mark "Esco" is so similar to "Crisco" as to be likely to cause confusion when used on substantially identical goods. * *The Procter and Gamble Company v. Eney Shortening Company*, 239.

55. **SAME—ORIGIN HAS NO BEARING ON QUESTION OF IDENTITY.**—That a mark is made up of the initials of the corporation applying for registration with the termination "Co." has no bearing on the question of its identity with another mark. * *Id.*

56. **GOODS OF SAME DESCRIPTIVE PROPERTIES.**—Beer and a beverage composed in part of malt and containing less than one-half of one per cent. of alcohol were considered of the same descriptive properties prior to the enactment of the prohibition laws (C. D., 1912, 559, *Independent Breweries Co.*, 182 O. G., 251; 39 App. D. C., 118), and the enactment of such laws does not furnish any basis for a different ruling. *Popel-Güller Co., Inc. v. Berghoff Brewing Ass'n*, 84.

TRADE-MARK RIGHTS. See *Trade-Marks*, 12, 16, 20, 25, 26.

TRADE-MARK USE. See *Trade-Marks*, 11, 12, 14, 32, 44, 51, 52.

TRANSFER OF FEES. See *Trade-Marks*, 48.

TRIBUNALS OF THE PATENT OFFICE. See *Concurrent Decisions of the Tribunals of the Patent Office; Court of Appeals of the District of Columbia*, 1.

UNFAIR COMPETITION IN TRADE. See *Certiorari*, 3; *Suits for Infringement*, 4; *Trade-Marks*, 22.

USE OF INVENTION. See *Construction of Specifications and Patents*, 1, 3; *Particular Patents*, 9.

UTILITY. See *Validity of Patents*.

VALID PATENTS. See *Construction of Specification*, 8, 11; *Disclaimers; Method and Products*, 2; *Particular Patents*, 4, 5, 7, 8, 13, 15, 18, 19, 23, 24, 25, 26, 27, 30, 32, 40, 41, 42, 44, 51, 52.

VALIDITY OF PATENTS. See *Construction of Specifications and Patents*, 21; *Disclosure of Inventions*, 2; *Licenses; Rights of Holder of Legal Title of Patent; Scope of Patent; Suits for Infringement*, 4, 6.

NOT AFFECTED BY NON-USER.—The validity of a patent is not affected by non-user of the patented device if it has utility in the sense of being capable of successful mechanical operation. ⁴ *Reed v. Hughes Tool Co.*, 288.

2. **AFFECTED BY PRIOR APPLICATION FOR ANOTHER PATENT.**—A patent applied for after filing of application for but before issue of another patent in the same art should, as to anticipation and the presence of invention, be judged upon the basis of which the earlier application is a part, though it was not a part of the prior art in the sense in which that phrase is used with reference only to publication. ⁴ *Concrete Appliances Co. et al. v. Meinken et al.*, 378.

3. **ENTIRE PRIOR ART CONSIDERED ON APPEAL.**—Although appellant assigned as error that the court below erred in holding the patent in suit anticipated by a particular patent and lower court stated that no device except that particular patent embodied plaintiff's device, nevertheless the court on appeal will consider the entire prior art as disclosed by the whole record. ⁴ *Backstay Machine & Leather Co. v. Hamilton*, 397.

VOID PATENTS. See *Certiorari*, 3; *Construction of Specifications and Patents*, 5, 13, 14; *Invention*, 27; *Particular Patents*, 1, 2, 3, 6, 9, 16, 17, 20, 21, 22, 28, 35, 36, 37, 38, 39, 45, 47, 49, 50; *Public Use Proceedings*, 1; *Rights of Holder of Legal Title of Patent*.

WITNESSES. See *Interference*, 1; *Testimony; Trade-Marks*, 10.

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